SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1894.

No. 444

THE UNITED STATES EX REL. ALFRED L. BRECKINRIDGE,
PLAINTIFF IN ERROR,

vs.

CHARLES H. DUELL, COMMISSIONER OF PATENTS.

IN ERROR TO THE COURT OF APPEALS OF THE DISTRICT OF COLUMBIA.

FILED DEC 28 1894

(17029)

( )

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1898.

No. .....

THE UNITED STATES EX REL. ALFRED L. BERNARDIN, PLAINTIFF IN ERROR,

vs.

CHARLES H. DUELL, COMMISSIONER OF PATENTS.

IN ERROR TO THE COURT OF APPEALS OF THE DISTRICT OF COLUMBIA.

INDEX.

JUDD & DETWEILER, PRINTERS, WASHINGTON, D. C., OCTOBER 14, 1898.

a & b Court of Appeals of the District of Columbia, October Term, 1898.

No. 2, Special Calendar.

UNITED STATES *ex Rel.* ALFRED L. BERNARDIN, Appellant,
vs.
CHARLES H. DUELL, Commissioner of Patents. } No. 810.

Appeal from the supreme court of the District of Columbia.

c Supreme Court of the District of Columbia.

UNITED STATES *ex Rel.* ALFRED L. BERNARDIN
vs.
CHARLES H. DUELL, Commissioner of Patents. } No. 42089. At Law.

UNITED STATES OF AMERICA,
District of Columbia, } *ss:*

Be it remembered that in the supreme court of the District of Columbia, at the city of Washington, in said District, at the times hereinafter mentioned, the following papers were filed and proceedings had in the above-entitled cause, to wit:

1 Filed April 25, 1898. J. R. Young, Clerk.

In the Supreme Court of the District of Columbia.

UNITED STATES *ex Rel.* ALFRED L. BERNARDIN
v.
CHARLES H. DUELL, Commissioner of Patents. } At Law. No. 42089

Petition for Mandamus.

The relator, Alfred L. Bernardin, says he is a citizen of the United States, residing in Evansville, Indiana, and that during the latter part of February, 1892, to wit, about the 25th day of February, he invented a new and useful improvement in metallic bottle-sealing devices, which was not known or used by others in this country, nor patented nor described in any printed publication in this or any foreign country before his invention or discovery thereof nor in public use or on sale for more than two years prior to his application; that upon July 21st, 1892, he filed his application—serial No., 440,790—in the U. S. Patent Office for letters patent for the aforesaid device, of which your relator believes himself to be the first and original inventor; that the said application was made in writing in due form, as required by statute, in every particular, and that your relator, Alfred L. Bernardin, filed therewith in the Patent Office of the United States a certain written description of the same and of the manner of making and using it in such full, clear, concise, and exact terms as to enable any person skilled in the art or

science to which it appertains or with which it is most nearly connected to make, construct, and use the same, and did explain the principle thereof and the best mode in which he has contemplated applying that principle so as to distinguish it from all other
2 inventions, and did particularly point out and distinctly claim the particular improvement and combination which he claims as his invention as follows:

1st. A metallic bottle-sealing cap having its lower edge adapted to be pressed into contact with a locking shoulder and provided above the said edge with a circumferential outwardly projecting rib or bead for engagement by the removing tool.

2nd. The improved bottle-sealing cap herein described provided on its depending flange with an outwardly projecting rib or bead having its sections 1 and 2 approximately flat whereby to afford a firm bearing for engagement by the removing tool and having said sections joined at their outer edges by an acute bend, whereby such joint and the proximity of the sections 1 and 2 of the bead will tend to strengthen and give rigidity to said bead.

3rd. The combination substantially as described of the bottle having its neck provided with a locking shoulder and the cap fitted on said bottle pressed into continuous contact with the locking shoulder and provided with a circumferential outwardly projected bead arranged for engagement by the removing tool.

4th. The improvement in bottle closures substantially as herein described and shown consisting of the bottle provided near its lip with a locking shoulder, the cap fitted on said bottle and having its lower edge pressed into continuous contact with the locking shoulder and provided above said contact with an outwardly projecting bead having flat sections 1 and 2 and arranged for engagement by the removing tool.

3 5th. The combination substantially as herein described of the bottle provided with a locking shoulder, the cap fitted to said bottle and having the lower edge of its depending flange pressed into contact with the locking shoulder and provided above said lower edge with an outwardly projected portion having its upper side arranged below the top of the cap and adapted to form a bearing for engagement by the cap-removing tool.

6th. The metallic bottle-sealing cap having its lower edge adapted to be pressed into contact with a locking shoulder and provided above the said edge with a circumferential outwardly projecting rib or bead for engagement by the removing tool, said rib or bead having its upper side arranged below the plane of the top of the cap.

That said specification and claims were duly signed by your relator, Alfred L. Bernardin, as such inventor, and were duly attested by two witnesses.

That your relator, Alfred L. Bernardin, did further furnish drawings of said invention, signed by the attorneys of your relator, Alfred F. Bernardin, and attested by two witnesses.

That your relator, Alfred L. Bernardin, did further make oath that he verily believed himself to be the original and first and sole

inventor and discoverer of the same, for which he solicited a patent; that he did not know and did not believe that the same was ever before known or used, and did state the country whereof he was a citizen.

That your relator, Alfred L. Bernardin, did further, at the time of making such application, pay to John S. Seymour, the then Commissioner of Patents, all fees required by law.

That upon the filing of such application and the payment of the fees required therefor by law the said John S. Seymour, then Commissioner of Patents, did cause an examination to be made of
4 the new invention set forth, contained, and described in said application, description, and drawings; that upon the said examination it was the opinion of the said John S. Seymour, then Commissioner of Patents, that the invention was new and useful; that your relator was the first and original inventor, and that your relator was entitled to letters patent for his invention; and thereupon, on October 15, 1892, his application was allowed.

That on or about February 10, 1893, this application was withdrawn from issue for the purpose of interference, and on February 24th, 1893, upon due proceedings, an interference was declared with the application of William Painter—serial No., 458,549—filed January 16, 1893; that on March 31st, 1893, William H. Northall filed an application—serial No., 468,524—for letters patent for the same invention, which application was on April 7, 1893, added to said interference between Bernardin and Painter; that, the case of this interference duly coming on to be heard before the examiner of interferences, according to statutes, rules, and regulations of the Patent Office in that case made and provided, upon the respective statements, testimony, and proofs of your relator, said Northall, and said Painter, prepared and presented according to the rules and regulations of the Patent Office, the examiner of interferences did decide that said William H. Northall was the original and first inventor of the said improvement in bottle-sealing devices, and that he was entitled to letters patent therefor.

That your relator, Alfred L. Bernardin, then appealed from this decision to the examiners-in-chief according to the provisions of the statute and the rules and regulations of the Patent Office, and on May 16, 1894, the decision of the examiner of interferences was affirmed by them.

That your relator, Alfred L. Bernardin, then appealed from
5 the decision of the examiners-in-chief to the said John S. Seymour, then Commissioner of Patents, according to the statute and the rules and regulations of the Patent Office, and that on March 23, 1895, the said John S. Seymour, then Commissioner of Patents, reversed the decision of the examiners-in-chief and decided that your relator, Alfred L. Bernardin, was the first and original inventor of the said invention and entitled to letters patent for his invention in accordance with the terms and claims of his application.

That said letters patent would have been issued in accordance with the said finding and decision of said John S. Seymour, then

Commissioner of Patents, but for that, under the statute of the United States in such case made and provided and in accordance therewith, the said William H. Northall prosecuted an appeal to the Court of Appeals of the District of Columbia, in which said appeal the testimony taken before the Commissioner and which was submitted for his consideration, and that alone, was, or could under the statute properly be, filed in said Court of Appeals, and the errors alleged to have been committed by the Commissioner in rendering said decision, which in said petition are called reasons of appeal, were assigned and the entire record filed as aforesaid with the Court of Appeals of the District of Columbia, and said court entertained and exercised jurisdiction in the matter of said appeal on error.

And subsequently, to wit, on the 12th day of November, 1895, the case was heard upon the record filed as aforesaid, and, upon consideration, on January 6, 1896, the court reversed the findings of the Commissioner, a copy of which said decision is hereto attached and marked "Exhibit A" and made a part hereof for reference; that a certified copy of said decision was filed with the Commissioner of Patents.

6 And your relator further presents that he, being advised by counsel learned in the law and believing that it was the duty of the said John S. Seymour, then Commissioner of Patents, as a result of his finding and decision that your relator was entitled to have granted and issued to him letters patent for said invention, which decision the said Commissioner never in any way modified or changed, to issue to him said letters, formally tendered to the said Commissioner of Patents the legal fee of twenty dollars, with the request that said letters patent be issued to him, which said request the said John S. Seymour, then Commissioner of Patents, refused. Whereupon your relator moved this honorable court for a writ of peremptory mandamus against the said John S. Seymour, then Commissioner of Patents, commanding him to issue said letters patent to your relator in conformity with his said decision, which cause coming on to be heard before his honor Judge McComas, he, on the 1st day of July, 1896, discharged the rule to show cause and dismissed the petition. Whereupon your relator appealed from the decision of this honorable court to the Court of Appeals, which said court affirmed the judgment of this honorable court, but that, before a writ of error could be sued out by your relator to the Supreme Court of the United States, to wit, on the 12th day of April, 1897, the term of office of the said John S. Seymour as Commissioner of Patents expired, in consequence whereof the said action of your relator against the said John S. Seymour, then Commissioner of Patents, abated.

Your relator further shows that on the 13th day of April, A. D. 1897, the Honorable Benjamin Butterworth became Commissioner of Patents in the place and stead of the said John S. Seymour; whereupon your relator, being advised by counsel learned in

7 the law and believing that it was the duty of the said Benjamin Butterworth, then Commissioner of Patents, to issue to your relator letters patent for his said invention, formally tendered

to the said Benjamin Butterworth, then Commissioner of Patents, the legal fee of twenty dollars, with the request that said patent should be issued to him.

And your relator shows that the said Benjamin Butterworth, then Commissioner, having examined the case and being familiar with the circumstances thereof, was of the opinion that your relator was entitled to have and receive letters patent for the said invention, and that the said William H. Northall was not entitled to have issued to him said letters patent as the first inventor; yet because of the decision of the Court of Appeals rendered in the proceeding, as hereinbefore mentioned, deciding that the said Northall was the first inventor, he, the said Commissioner, deemed himself concluded from taking any further or other action than to issue said letters patent to said William H. Northall and refused to issue said letters patent to your relator.

And your relator presents further that he, subsequently and upon the said refusal as aforesaid of the said Benjamin Butterworth, then Commissioner of Patents, to issue to your relator letters patent for his said invention, to wit, upon the 17th day of April, A. D. 1897, moved this honorable court for a writ of peremptory mandamus against the said Benjamin Butterworth, then Commissioner of Patents, commanding him to issue said letters patent to your relator in conformity with the said decision of the said John S. Seymour, former Commissioner of Patents, which cause coming on to be heard before his honor Judge McComas, he, on the 26th day of April, 1897, discharged the rule to show cause therein granted and dismissed said petition; whereupon your relator appealed from said decision of this honorable court to the Court of Appeals,
8 which court, upon the hearing of the appeal upon the transcript of record, on the 11th day of May, 1897, affirmed the said judgment of this honorable court; whereupon your relator duly prosecuted a writ of error to the Supreme Court of the United States, secured the record to be printed, and had prepared the case for hearing, when, upon the 16th day of January, 1898, said Benjamin Butterworth, then Commissioner of Patents, deceased, whereby the said action of your relator against the said Benjamin Butterworth, then Commissioner of Patents, abated.

Your relator shows further that on the 5th day of February, 1898, the Honorable Charles H. Duell became Commissioner of Patents in the place and stead of the said Benjamin Butterworth, deceased; whereupon your relator, under the advice of counsel learned in the law, filed a motion in the Supreme Court of the United States for leave to substitute the name of said Charles H. Duell upon the record of said case in the stead and place of that of said Benjamin Butterworth, which said motion, on the 21st day of March, 1898, was denied by said court.

Your relator says further that, being advised by counsel learned in the law and believing that is was and is the duty of the said Charles H. Duell, Commissioner of Patents, to issue to your relator letters patent for his said invention in accordance with the said decision of the said James S. Seymour, then Commissioner of Patents

he formally tendered to the said Charles H. Duell, Commissioner of Patents, the legal fee of twenty dollars, with the request that said patent should be issued to him, but that the said Charles H. Duell, Commissioner of Patents, because of said decision of the Court of Appeals rendered in the proceeding as hereinbefore mentioned, deciding that the said Northall was the first inventor, deemed himself concluded from taking any further or other action than
9 to issue said letters patent to said William H. Northall and refused and still refuses to issue said letters patent to your relator; all of which will more fully appear by a letter of your relator to the said Charles H. Duell, Commissioner of Patents, dated April 1, 1898, and by a letter from the said Charles H. Duell, Commissioner of Patents, to your relator, dated April 15, 1898, copies of which are filed herewith, marked Exhibits "B" and "C" respectively, and prayed to be taken and read as a part hereof.

And, further, your relator presents that, notwithstanding the act of Congress approved February the 9th, 1893, in form confers jurisdiction upon the Court of Appeals of the District of Columbia to hear an appeal on error prosecuted from the action of the Commissioner of Patents, an officer of the executive department of the Government, and to review the official action of said officer of the executive department and to revise and reverse or nullify said action, said statute is, to the extent that it attempts to confer jurisdiction upon the Court of Appeals of the District of Columbia to review, reverse, or nullify the action of the executive branch of the Government, unconstitutional, inoperative, and void, and that the said decision rendered and certified in that behalf is *coram non judice* for want of constitutional authority to entertain, hear, and control by judicial action the official acts of the executive department.

And your relator presents further that the Honorable John S. Seymour, then Commissioner of Patents, having decided that your relator was entitled to said patent, and the said Honorable Charles H. Duell, the present Commissioner of Patents, having in no way impugned, denied, or attempted to overrule, and not now in any way impugning, denying, or attempting to overrule, the said decision, but having denied and now denying to issue to your relator
10 the said patent as prayed for, solely because of the decision of the said Court of Appeals aforesaid, it is the duty of the said Charles H. Duell, Commissioner of Patents, to grant and issue to your relator letters patent, as aforesaid, for his said invention.

Wherefore your relator comes and respectfully asks—

That a writ of peremptory mandamus may issue from this honorable court to the said Charles H. Duell, Commissioner of Patents, commanding him to issue said letters patent to your relator in conformity with the said decision of the said John S. Seymour, late Commissioner of Patents, and in accordance with the claims of your relator's application as above stated.

(Signed) ALFRED L. BERNARDIN.

JULIAN C. DOWELL,
Att'y for Bernardin.
JAMES I. RICE, *Of Counsel.*

11 STATE OF INDIANA, }
County of Vanderburgh, } ss:

Alfred L. Bernardin, being first duly sworn, deposes and says that he is the relator named in the foregoing petition by him subscribed; that he has read said petition and knows the contents thereof; that the statements therein contained are true of his own knowledge and belief except as to matters therein stated on information and belief, and that as to such matters he believes them to be true.

ALFRED L. BERNARDIN.

Subscribed and sworn to before me this 18th day of April, A. D. 1898.

GEO. P. STOCKER,
[SEAL.] *Notary Public.*

12 EXHIBIT "A."

This is an appeal from the decision of the Commissioner of Patents in an interference proceeding involving the following issue:

"A metallic bottle-sealing cap having its lower edge adapted to be pressed into contact with a locking shoulder, and provided above the said edge with a circumferential, outwardly projecting rib or bead for engagement by the removing tool."

There were three parties to the original proceeding, Alfred L. Bernardin, William H. Northall, and William Painter.

The primary examiner awarded priority of invention to Northall, and upon appeal to the examiners-in-chief the decision was affirmed. The appeal was then taken to the Commissioner, who reversed the examiners and awarded priority to Bernardin. Northall alone has appealed from that decision, and the claim of Painter is therefore no longer matter of consideration.

Applications for patents were filed by the parties in the following order of time: Bernardin, July 21, 1892; Painter, January 16, 1893; Northall, March 31, 1893.

The record contains a great mass of conflicting evidence, from which we are to determine who is entitled to priority, or rather, as between the two parties left to the controversy, who is the inventor, for one thing which is very plain from the record is that, as between Bernardin and Northall, this is not a case of two independent inventors who, working in ignorance of each other's discoveries,

13 have exploited the same idea.

Bernardin claims to have conceived the idea in February, 1892. He was then and had for some years been the president of the Bernardin Bottle Cap Co.

In and before 1891 this corporation, whose place of business was Evansville, Indiana, had been engaged in the manufacture of bottle-sealing devices, the leading one of which consisted of a tin cap for the mouth of the bottle, with a collar, which fastened about its neck and was connected by strips with the cap. In February, 1892, Bernardin learned of a cap manufactured in Baltimore that was made in a single piece and was much simpler than the one made by his company.

This was made to press down about the shoulder or rim of the bottle neck, and its edges were corrugated, so as to make a projecting edge or flange for its easy removal.

This discovery alarmed Bernardin, and he began to consider improvements that might be made in such devices. There is no doubt that he considered two of these seriously and went to Washington to apply for patents about April 16, 1892. One was a cap with corrugated edges, which were to fit similar corrugations in a bottle made for the purpose, and the other was made with perforations in which a tool could be inserted for removal. He was informed by his attorneys that these devices were probably not patentable.

They were also expensive to make and did not sufficiently
14 overcome the difficulty of removal. He was very much discouraged and returned home. The great object in view was a cap, inexpensive to make, that would be a perfect seal and at the same time easily removable without injury to the bottle.

Bernardin claims that he had also conceived the idea of the cap in issue, with the band or rim at the top, in February, 1892, and had discussed it, as well as the others, with Northall, who was the superintendent of the machine shop of the bottle cap company. He says that he made a rough sketch of the one with the bead, and that Northall preferred it to the others, but he (Bernardin) thought it would be too expensive to make. When he returned discouraged the matter was taken up again, and he suggested to Northall a simpler way of pressing on the bead or rim, and directed him to make tools for the experiment. Proving satisfactory, he had some of the caps made and went to Washington in July, 1892, and filed his application for a patent.

Northall was a skilled mechanic, and had been in the service of the bottle cap company for about eight years.

He claims that the idea of making a cap with a bead was suggested to him by the rim found on metallic cartridges and was matured on December 19, 1891, on which day he made a drawing of the same, with a tool to be used in removing it, and disclosed it to a number of persons.

15 He admits that he knew of the two devices of Bernardin before referred to and of his trip to Washington concerning patents for them, and says that before Bernardin's return he, having no confidence in the efficacy of those inventions, mentioned his own invention of the cap in issue to a fellow-workman and to the treasurer of the Bernardin Company. These persons say that he did so, but that he referred to his invention as having been made the night before. He also says that he showed his drawing to Bernardin on his return, who was pleased with it and ordered the caps to be made and tested, but afterwards informed him it was not patentable. In part explanation of his conduct in taking no steps himself to apply for a patent, he claims to have been too poor to undertake it and to have been willing for the Bernardin Company to do so, expecting, however, to have an interest in it. He says that he was dependent upon his position with the company, which paid him $100 per month, and let the matter proceed until some

time in August, 1892, when he saw from copies of papers in the Patent Office, shown him by Bernardin, that the application was made in the latter's name. He undertakes to explain his subsequent inaction by the fear he had of losing his place, by his ignorance of the law in such matters, which caused him to think that he was too late, and to some slight extent by hopes that he would be given an interest in the new corporation forming and formed to exploit the invention.

There are, too, some other circumstances growing out of his connection with the Crown Cork and Seal Co. of Baltimore,
16 assignee of Painter, and also holder of an option upon his (Northall's) claim herein, in the event of his success, that tend in some degree to affect the integrity of his claim.

On the other hand, Bernardin's conduct is surrounded by some circumstances that tend to impair the strength and weight of his claim, notwithstanding the diligence with which he has prosecuted it since April, 1892.

According to his own statement, he made no disclosure of his invention of the disputed cap to any one except Northall until his return from Washington, about the last of April, 1892. It seems clear that he did not mention it to his Washington attorneys, Munn & Co., when they discouraged him as regards the patentability of the first two devices on which he filed applications. He has produced no sketch or drawing made prior to the application for patent.

He undertakes to account for the neglect of this invention by saying that he had deemed it impracticable because of the difficulty and expense that he apprehended in making the bead or rim.

There is an irreconcilable conflict between the statements of Bernardin on one side and Northall on the other. Fortunately it is not necessary to analyze these, weighing circumstance against circumstance and setting off inference against inference, in order to determine which of them is most entitled to belief.

17 In our opinion the case must turn upon the truth or falsity of Northall's statement that he made the drawing, which fully discloses this invention, on December 19, 1891.

If he made the drawing on that date he is the inventor. He has produced a piece of paper with the drawing on it with that date written upon it with pencil.

He says that, having been at work on the invention for some time, he completed his plan and made the drawing on that day, which was Saturday; that he went to the saloon of Frank Haas after supper and engaged with several acquaintances in a game of cards, as he had often done before; that he lost each game, and his companions began to make sport of him, saying that he had lost his skill through having neglected the game so long; that he said he had been working at a thing that would make him rich, and asked for a piece of paper to show them what he had been doing while absent. There was no paper, but some one handed him a cardboard "oyster sign" which Haas had over his lunch counter, and,

turning it over, he made a rough sketch on the back of his bottle cap and tool for removing it.

This statement is corroborated by Frank Haas, the saloon-keeper; McDowell and Ziegler, draymen; Heidt, a school janitor; Oslage, a grocer, and Wagner, a horseshoer, who were all present. These witnesses are all positive that it occurred on Saturday night
18 before Christmas, December 19, 1891, and account reasonably for their ability to fix the precise date. Haas said that he put the sign away at the end of the oyster season and found and produced it after the controversy arose.

These witnesses appear to be intelligent laboring and business men and to have no pecuniary interest in the result of the controversy. They had lived long in Evansville, were well known, and no witness was offered to impeach their credibility.

They have either spoken the truth or been guilty of wilful falsehood. There is no room for mistake.

Again, Northall is corroborated by two other intelligent, disinterested, and apparently truthful witnesses. Henry B. Polsdorfer, who is a manufacturer of washboards, woodenware, etc., and a trained mechanic, says that he knew Northall well, and that they and their wives were intimate friends. Being interested in machinery and inventions, he frequently conversed with Northall upon such subjects.

He says that Northall showed him his drawing of the bottle cap in issue at his house, in Evansville, and explained it fully "between the middle and latter part of December, 1891." He recognized the drawing when produced and remembered that it had December on it, but did not remember the day of the month. Mary E. Polsdorfer testified to hearing the conversation and seeing the drawing also.
She remembered that it was just before Christmas, because
19 she had gone to Mrs. Northall's to join her in making some slipper cases for presents, and her husband had gone with her. We find no reasonable ground for supposing that any of the foregoing witnesses have confounded the Christmas of 1892 with that of 1891, as suggested.

The only direct attempt to break the force of all this corroborating evidence is by the charge that the date of this important drawing has been changed. It is charged that the date, as it now appears, has been written over an erasure, and both the original and an enlarged photographic copy have been offered for inspection in support of the charge.

If it could be shown that this date has been tampered with, the fact would discredit Northall's whole case, and for that reason and because the decision of the Commissioner is founded largely in that belief we have given the original and copy as close and careful scrutiny as possible with the aid of simple microscopes of considerable magnifying power.

No witnesses were called to inspect the writing and testify as to the results of the observation.

With the greatest distrust of our own capacity in the matter, we are nevertheless compelled to rely upon our own inspection and to form our own opinion unaided.

That the drawing and the date both may have been traced over erasures of other things is not at all improbable. There was
20 some conflict between Bernardin and Northall in regard to the time and place that the drawing paper itself had been obtained. Northall testified, without reference to this charge, which had not then been made or intimated, that the drawing was made on a piece cut from a sheet of old paper that he had brought with him to Evansville from his eastern home and had had sketches on it which he "rubbed out" before putting this one on.

A pencil-mark is pointed out just beneath (that is, a little lower down the page) a letter in the word December, which the Commissioner thought was "the lower loop of a letter." This loop is plainly visible to the naked eye; in fact, it appears even fresher than the writing above it and shows no sign of attempt at erasure. If it be part of an erasure made for the purpose of falsifying the date, it seems strange that it should have been left when such great care was had in the complete erasure of the remainder.

Conjecture founded on a circumstance of that kind is not sufficient to discredit the testimony of positive witnesses.

Our attention was called on the argument to another alleged indication of fraudulent alteration of the date which seems not to have been suggested to the examiners or the Commissioner. It is claimed that the photographic copy discloses the figure 3 in proximity
21 to the 1 in 1891 of the date. Our conclusion is after examination that this also is a mistaken conjecture. What would be the result, however, if it be conceded that there is the tracing of the figure 3 as claimed? The conjecture that the original date was 1893 instead of 1891 is inconsistent with all the established facts of the case and unreasonable in any view that may be taken of Northall's conduct.

If Northall did not invent the cap, as claimed, he must have conceived the idea of claiming Bernardin's invention as his own as early as April, 1892. The caps were first made soon after that date, and Northall had notice of Bernardin's application for the patent as early as the summer of 1892 The invention was subject of local newspaper comment in September, 1892.

Now, if he prepared the drawing as part of his plan to defraud Bernardin, he surely would not have given it a date in the year 1893, or any other later than February, 1892, when, according to Bernardin, the knowledge of the invention was first communicated to him. Preparing it to antedate Bernardin, he would naturally have assigned his pretended invention to the year 1891. A change in the month of that year might have became important, but not so with the year. After much consideration we can come to no other conclusion than that the appellant Northall is entitled to priority.

22 The decision appealed from will therefore be reversed and the proceedings and decision certified to the Commissioner of the Patent Office, as provided by law. It is so ordered.

SETH SHEPARD,
Associate Justice.

23 EXHIBIT "B."

Filed April 25, 1898.

WASHINGTON, D. C., *April* 1, 1898.

Hon. Charles H. Duell, Commissioner of Patents, Washington, D. C.

SIR: On July 21st, 1892, I filed my application in writing in the United States Patent Office—serial No., 440,790—for letters patent for a new and useful improvement in metallic bottle-sealing devices. This application was in due form, as required by statute, and was accompanied by all descriptions, specifications, oaths, drawings, and claims, as required by law and in the form and of the substance required by law. At the same time I paid to the Hon. John S. Seymour, at that time Commissioner of Patents, all fees required by law, upon which Commissioner Seymour caused an examination to be made of my invention, as set forth in my application, and on October 15, 1892, decided that I was entitled to a patent therefor. On February 10, 1893, my application was withdrawn from issue for the purpose of interference, and on February 24, 1893, an interference was declared with the application of William Painter—serial No., 458,519. On March 31, 1893, William H. Northall filed an application—serial No., 468,524—for letters patent for the same invention; which application was, on April 7, 1893, added to the interference between Painter and myself.

This interference duly coming on to be heard, the Commissioner of Patents, the Honorable John S. Seymour, on March 23, 1895, decided that I was the first and original inventor of said invention and entitled to letters patent for the same, in accordance with the terms and claims of my application.

The letters patent would have issued in accordance with the finding and decision of the said Commission of Patents but for the fact that the said William H. Northall prosecuted an appeal from the decision of the Commissioner of Patents to the Court of Appeals of the District of Columbia; which court, on January 6, 1896, rendered a decision in terms reversing and overruling the decision of the said Commissioner of Patents and finding and deciding that the said William H. Northall and not myself was entitled to letters patent for the said invention.

This decision, I present, was and is entirely null and void and was in no way binding upon the former Commissioner, Mr. Seymour, nor is it binding upon you. The decision, I submit, is *coram non judice*, the matter not being one properly determinable by the said Court of Appeals on appeal from the Commissioner of Patents, an officer of the executive branch of the Government. The act of Congress in terms conferring upon the Court of Appeals the jurisdiction it has sought to exercise in this case, I submit, is unconstitutional and void.

24 And thus believing that the whole proceedings of appeal from the decision of the Commissioner of Patents were void, I made demand, accompanied by a tender of the final fee as required

by law, upon the said John S. Seymour, the Commissioner of Patents, for letters patent to be issued to me in accordance with his decision that I was entitled to the same, which demand the said Commissioner of Patents refused and so continued to refuse until April 13th, 1897, when his term of office expired and the Hon. Benjamin Butterworth became Commissioner of Patents in his place and stead.

Then, still believing that the whole proceedings of appeal from the decision of said John S. Seymour, the Commissioner of Patents, were void, I made demand, accompanied by a tender of the final fee as required by law, upon the said Benjamin Butterworth, the Commissioner of Patents, for letters patent to be issued to me in accordance with the said decision of the said John S. Seymour, which demand the said Benjamin Butterworth, the Commissioner of Patents—though he believed that the said patent should be issued to me in accordance with the decision of the said John S. Seymour, but declining to so issue it because, and because only, of the said decision of the said Court of Appeals—refused and so continued to refuse until January 16, 1898, when the said Benjamin Butterworth deceased.

I herewith tender to you the sum of twenty dollars, the same being the amount of the final fee required by law, and respectfully request that letters patent be issued to me in accordance with my application heretofore made as above set out and in accordance with the decision of the said John S. Seymour that I was entitled to have issued to me said letters patent.

Very respectfully, ALFRED L. BERNARDIN,
By JULIAN C. DOWELL,
His Attorney.

Dictated.

25 EXHIBIT "C."

Filed April 25, 1898.

DEPARTMENT OF THE INTERIOR,
UNITED STATES PATENT OFFICE,
WASHINGTON, D. C., *April* 15, 1898.

Mr. Alfred L. Bernardin, care of J. C. Dowell, Esq., Washington, D. C.

SIR: I have your letter of the first instant, in which you request that letters patent be issued to Alfred L. Bernardin on application—serial No, 440,790—filed July 21, 1892, in accordance with the decision of the Commissioner of Patents, rendered March 23, 1895, in an interference proceeding between Bernardin and Northall, in which it was held that Bernardin was the first inventor.

As the records show that on appeal to the Court of Appeals of the District of Columbia by Northall the said decision of the Commissioner was reversed and priority of invention awarded to Northall, I must decline to grant your request, out of deference to the decision of the said court, notwithstanding your contention that the Court of Appeals is without jurisdiction to review or reverse the decision of the Commissioner.

The sum of twenty dollars, tendered as the final fee, will not be accepted, and is herewith returned.

Very respectfully yours,

(Signed) C. H. DUELL,
Commissioner.

26 *Answer of Respondent.*

Filed April 26, 1898.

In the Supreme Court of the District of Columbia.

UNITED STATES *ex Rel.* ALFRED L. BERNARDIN
v.
CHARLES H. DUELL, Commissioner of Patents. } At Law. No. 42089.

The respondent, Charles H. Duell, Commissioner of Patents, respectfully makes return to the order of the Honorable L. E. McComas, associate justice of the supreme court of the District of Columbia, made on the 25th day of April, 1898, in the above-entitled action to show cause why a writ of mandamus should not issue commanding the said Charles H. Duell, Commissioner of Patents, to issue letters patent to the relator, as prayed for in the petition upon which said order was granted, and says:

That the facts set forth in the relator's petition as to the respondent's refusing to issue a patent to the relator are true.

It is further stated that your respondent based his refusal to grant a patent to the relator on the ground that Congress has provided for an appeal to the Court of Appeals of the District of Columbia from the decision of the Commissioner of Patents, and said court is authorized by statute in the exercise of that jurisdiction to revise, modify, review, or annul the decision of the Commis-
27 sioner of Patents in any appealable case, and that as the Court of Appeals has reversed the decision of the Commissioner of Patents, holding that Bernardin is entitled to an appeal, your respondent feels bound by this ruling.

It is further stated that whether or not the act approved February 9, 1893, conferring jurisdiction upon the Court of Appeals of the District of Columbia to hear and decide appeals on error prosecuted from the decisions of the Commissioner of Patents, an officer of the executive department of the Government, is constitutional, the Commissioner is not advised.

It is further stated that if the decision of the Commissioner of Patents, which is that Alfred L. Bernardin, the relator, is the first and original inventor of the invention in controversy and is entitled to receive a patent as prayed for, is final, and if, upon such decision, it is the lawful duty of the Commissioner of Patents to accept the final fee and issue a patent to Bernardin as prayed, then the Commissioner of Patents has improperly refused to accept the fee and to prepare said patent for issue; but if the decision of the Commissioner of Patents is subject to revision and reversal on appeal to the Court of Appeals of the District of Columbia, then such refusal on

the part of the Commissioner of Patents to accept the final fee and issue the patent to Bernardin, the relator, is right and proper.

And, having fully answered, he prays judgment.

(Signed.) CHARLES H. DUELL,
Commissioner.

April 26, 1898.

28 Filed April 28, 1898.

In the Supreme Court of the District of Columbia.

UNITED STATES *ex Rel.* ALFRED L. BERNARDIN
vs.
CHARLES H. DUELL, Commissioner of Patents. } At Law. No. 42089.

It is hereby stipulated and agreed by and between counsel for the parties that the annexed printed copy of "transcript of record" in the Supreme Court of the United States, October term, 1897, No. 404, *In re* The United States *ex rel.* Alfred L. Bernardin *vs.* Benjamin Butterworth, Commissioner of Patents, contains a true copy of the transcript of record of the case of United States *ex rel.* Alfred L. Bernardin *v.* John S. Seymour, Commissioner of Patents, in the supreme court of the District of Columbia, No. 40029, and of the transcript of record of the case of United States *ex rel.* Alfred L. Bernardin *vs.* Benjamin Butterworth, Commissioner of Patents, in the supreme court of the District of Columbia, No. 40946, and that the same, together with the exhibits printed therein, may be filed and used as a part of the record in the above-entitled case, omitting the following portions of said transcript of record to avoid unnecessary repetition of parts of the record of papers filed in this case, to wit, "index" on the title and next following page; the "petition for mandamus," pages 1 to 6, inclusive; "Exhibit A," pages 17 to 22; "Exhibit C," pages 32 to 37; "Exhibit F," page 41, and "Exhibit G," page 42, and issue and citation are hereby waived.

JULIAN C. DOWELL,
Attorney for Alfred L. Bernardin.
W. A. MEGRATH,
Attorney for Commissioner of Patents.

April 28, 1898.

28½ (16617.)

Supreme Court of the United States, October Term, 1897.

THE UNITED STATES *ex Rel.* ALFRED L. BERNARDIN, Plaintiff in Error, *vs.* BENJAMIN BUTTERWORTH, Commissioner of Patents. } No. 404.

In error to the Court of Appeals of the District of Columbia.

Court of Appeals of the District of Columbia, April Term, 1897.

UNITED STATES *ex Rel.* ALFRED L. BERNARDIN, Appellant, *vs.* BENJAMIN BUTTERWORTH, Commissioner of Patents. } No. 682. Special Calender, No. 6.

Appeal from the supreme court of the District of Columbia.

Supreme Court of the District of Columbia.

UNITED STATES *ex Rel.* ALFRED L. BERNARDIN *vs.* BENJAMIN BUTTERWORTH, Commissioner of Patents. } At Law. No. 40946.

UNITED STATES OF AMERICA, *District of Columbia,* } *ss:*

Be it remembered that in the supreme court of the District of Columbia, at the city of Washington, in said District, at the times hereinafter mentioned, the following papers were filed and proceedings had in the above-entitled cause, to wit:

29 EXHIBIT B.

APRIL 13TH, 1897.

Hon. Benjamin Butterworth, Commissioner of Patents, Washington, D. C.

SIR: On July 21st, 1892, I filed my application in writing in the United States Patent Office—serial No., 440,790—for letters patent for a new and useful improvement in metallic bottle-sealing devices. This application was in due form, as required by statute, and was accompanied by all descriptions, specifications, oaths, drawings, and claims, as required by law and in the form and of the substance required by law. At the same time I paid to the Hon. John S. Seymour, at that time Commissioner of Patents, all fees required by law, upon which Commissioner Seymour caused an examination to be made of my invention as set out in my application, and on October 15, 1892, decided that I was entitled to a patent therefor. On February 10, 1893, my application was withdrawn from issue for the purpose of interference, and on February 24, 1893, an

interference was declared with the application of William Painter—serial No., 458,549. On March 31, 1893, William H. Northall filed an application—serial No., 468,524—for letters patent for the same invention, which application was on April 7, 1893, added to the interference between Painter and myself.

The case of this interference duly coming on to be heard the Commissioner of Patents, the Honorable John S. Seymour, on March 23, 1895, decided that I was the first and original inventor of said invention and entitled to letters patent for the same in accordance with the terms and claims of my application.

The letters patent would have issued in accordance with the finding and decision of the said Commissioner of Patents, but for the fact that the said William H. Northall prosecuted an appeal from the decision of the Commissioner of Patents to the Court of Appeals of the District of Columbia, which court on November 12, 1895, rendered a decision, in terms, reversing and overruling the decision of the said Commissioner of Patents, and finding and deciding that the said William H. Northall and not myself was entitled to letters patent for the said invention.

This decision, I present, was and is entirely null and void, and was in no way binding upon the former Commissioner, Mr. Seymour, nor is it binding upon you. The decision is *coram non judice*, the matter not being one properly determinable by the said Court of Appeals on appeal from the Commissioner of Patents, an officer of the executive branch of the Government. The act of Congress in terms conferring upon the Court of Appeals the jurisdiction it has sought to exercise in this case is unconstitutional and void.

Believing that the whole proceedings of appeal from the decision of the Commissioner of Patents were void I made demand, accompanied by a tender of the final fee as required by law, upon the said John S. Seymour, the Commissioner of Patents, for letters patent to be issued to me in accordance with his decision that I was entitled to the same, which demand the said Commissioner of Patents refused and so continued to refuse until April 13th, 1897, when his term of office expired and you were inducted in the office of Commissioner of Patents in his place and stead.

I herewith tender to you the sum of twenty dollars, the same being the amount of the final fee required by law, and respectfully request that letters patent be issued to me in accordance with my application heretofore made as above set out and in accordance with the decision of your predecessor in office, the Honorable John S. Seymour, that I was entitled to have issued to me said letters patent.

Very respectfully,

ALFRED L. BERNARDIN,
By JULIAN C. DOWELL,
His Attorney.

(Dictated.)

DEPARTMENT OF THE INTERIOR,
UNITED STATES PATENT OFFICE,
WASHINGTON, D. C., *April* 16, 1897.

Julian C. Dowell, Esq., attorney-at-law, Loan & Trust building, Washington, D. C.

SIR: I have your letter of April 13, 1897, tendering the final fee and requesting that patent be issued to Al ed L. Bernardin on application filed July 21, 1892, No. 440,790, in accordance with the decision of the Commissioner of Patents, notwithstanding the reversal of that decision by the Court of Appeals of the District of Columbia. Your request cannot be granted, for the reason
31 that Congress has provided for an appeal from the decision of the Commissioner of Patents to the Court of Appeals, and the court is authorized by statute, in the exercise of that jurisdiction, to revise, modify, reverse, or annul the decision of the Commissioner of Patents in any appealable case.

Until it is settled by proper adjudication that the act conferring such appellate jurisdiction is unconstitutional, the Commissioner will obey the mandate of the Court of Appeals and issue patents in accordance therewith. In this particular case, with which I am thoroughly familiar, the decision of the Commissioner of Patents, my predecessor, was in favor of Bernardin, he having been adjudged to be the sole and first inventor of the device in controversy, and there remained nothing to be done except to issue the patent. An appeal, however, was prosecuted to the Court of Appeals, as hereinbefore stated, and the judgment of the Commissioner was reversed. Thereafter, in order to test the constitutionality of the law and to determine whether jurisdiction could be conferred upon the court to entertain appeals from and on such appeal revise, modify, reverse, or annul the official acts of the Commissioner of Patents, an officer of an executive department of the Government, a petition was filed in the supreme court of the District of Columbia for a writ of mandamus to compel Commissioner Seymour to issue a patent to Bernardin, notwithstanding the decision of the circuit court of appeals. An alternate writ was allowed and proper return made in accordance with the facts. The petition was dismissed, and an appeal was taken to the Court of Appeals of the District of Columbia. The case was heard and, upon consideration, the court sustained the jurisdiction, though entertaining a doubt as to the constitutionality of the law.

It was understood that the case would be taken to the Supreme Court, that the question might be fully and finally determined, but there was not time before the expiration of the term of Commissioner Seymour to do this. That the question should be settled is clear. I will do everything in my power as Commissioner to facilitate this.

If the Court of Appeals can properly exercise jurisdiction to entertain an appeal and revise, modify, or annul on appeal and practically and in effect review on petition in error on the record

the official acts of an officer of an executive department, acting within the scope of his departmental jurisdiction, then the patent should not issue to Bernardin. On the other hand, if the law conferring this jurisdiction is, as is contended by you, and as I have urged before I was Commissioner, unconstitutional because it confuses and obliterates the lines which mark the boundary between the several departments of the Government and makes one subordinate to another, then and in that case the patent should issue to Bernardin, as there remains nothing to be done except the administrative act of preparing and issuing the patent. But because of the decision of the Court of Appeals I decline to comply with your request.

32 I trust if any step is to be taken it may be done immediately, in order that no time be lost in having this question finally settled.

Very respectfully yours,

BENJ. BUTTERWORTH,
Commissioner.

In the Supreme Court of the District of Columbia.

UNITED STATES *ex Rel.* ALFRED L. BERNARDIN
vs.
BENJAMIN BUTTERWORTH, Commissioner of Patents. } At Law. No. 40946.

Upon consideration of the petition for mandamus in the above-entitled cause, it it ordered, on this 20th day of April, A. D. 1897, that the respondent herein show cause, on the 26th day of April, A. D. 1897, at 10 o'clock a. m., before me at the special term of this court, why an alternate writ of mandamus, as prayed for, should not issue, provided a copy of this order and of the petition filed in this cause be served upon the respondent on or before the 21st day of April, A. D. 1897.

L. E. McCOMAS,
Associate Justice Supreme Court of the District of Columbia.

Marshal's Return.

Served copy of within order, also copy of the petition filed in this cause, on within-named respondent April 20, 1897.

ALBERT A. WILSON, *Marshal.*

In the Supreme Court of the District of Columbia.

UNITED STATES *ex Rel.* ALFRED L. Bernardin
v.
BENJAMIN BUTTERWORTH, Commissioner of Patents, Respondent. } Filed April 24, 1897. At Law. No. 40946.

Answer of Respondent.

The respondent, Benjamin Butterworth, Commissioner of Patents' respectfully makes return to the order of the Honorable L. E. Mc-

Comas, associate justice of the supreme court of the District of Columbia, made on the 20th day of April, 1897, in the above-entitled matter, to show cause why a writ of mandamus should not issue commanding him to issue letters patent to the relator as prayed for in the petition upon which said order was granted, and says:

That the facts set forth in the relator's petition as to the respondent's refusing to issue a patent to your relator are true.

It is further stated that your respondent based his refusal to grant a patent to Bernardin wholly on the ground that Congress has provided for an appeal from the decision of the Commissioner
33 of Patents to the Court of Appeals of the District of Columbia, and the court is authorized by said statute, in the exercise of that jurisdiction, to revise, modify, review, or annul the decision of the Commissioner of Patents in any appealable case.

It is further stated that whether or not the act approved February 9, 1893, conferring jurisdiction upon the Court of Appeals of the District of Columbia to hear and decide appeals on error prosecuted from the decisions of the Commissioner of Patents, an officer of the executive department of the Government, is constitutional, the Commissioner is not advised.

It is further stated that if the decision of the Commissioner of Patents, which is that Alfred L. Bernardin, the relator, is the first and original inventor of the invention in controversy and is entitled to receive a patent as prayed for is final, and if, upon such decision, it is the lawful duty of the Commissioner of Patents to accept the final fee and issue a patent to Bernardin as prayed, then the Commissioner of Patents has improperly refused to accept the fee and to prepare said patent for issue; but if the decision of the Commissioner of Patents is subject to revision and reversal on appeal to the Court of Appeals of the District of Columbia, then such refusal on the part of the Commissioner of Patents to accept the final fee and issue the patent to Bernardin, the relator, is right and proper.

Your respondent states that it — his desire to have the jurisdiction of the Court of Appeals of the District of Columbia speedily and finally determined for the future guidance of the Patent Office and in the interest of the applicants appearing before it.

And, having fully answered, he prays judgment.

BENJ. BUTTERWORTH,
Commissioner.

April 23, 1897.

In the Supreme Court of the District of Columbia.

UNITED STATES *ex Rel.* ALFRED L. BERNARDIN
vs.
BENJAMIN BUTTERWORTH, Commissioner of Patents. } At Law. No. 40946.

This cause coming on to be heard upon the relator's petition for a writ of mandamus against the respondent and counsel having been heard thereon, it is thereupon, on due consideration thereof,

this 26th day of April, 1897, by the court ordered and adjudged that the rule to show cause is hereby discharged and the petition be, and the same is hereby, dismissed at the costs of relator.

Petitioner in this cause having prayed an appeal to the Court of Appeals of the District of Columbia from the judgment of this court dismissing the petition, the same is allowed and bond is fixed in the penalty of two hundred dollars.

L. E. McCOMAS,
Asso. Justice.

34 In the Supreme Court of the District of Columbia.

UNITED STATES *ex Rel.* ALFRED L. BERNARDIN *vs.* BENJAMIN BUTTERWORTH, Commissioner of Patents. } At Law. No. 40946.

In accordance with the consent of counsel on both sides and upon motion of relator's attorney in the above-entitled case, leave is hereby given the relator to file a transcript of the record of the case of United States *ex rel.* Alfred L. Bernardin *vs.* John S. Seymour, Commissioner of Patents, No. 40029, and to use the exhibits in the said transcript as exhibits in this case.

L. E. McCOMAS,
Asso. Justice.

In the Supreme Court of the District of Columbia.

UNITED STATES *ex Rel.* ALFRED L. BERNARDIN *vs.* BENJAMIN BUTTERWORTH, Commissioner of Patents. } Filed April 28, 1897. At Law. No. 40946.

The clerk will please note an appeal in the above-entitled cause to the Court of Appeals of the District of Columbia from the order of the court entered April 26, 1897, dismissing the petition for mandamus and issue citation to the appellee.

JULIAN C. DOWELL,
Att'y for Alfred L. Bernardin.

April 27, 1897.

(Endorsed:) At law. No. 40946. In the supreme court of the District of Columbia. United States *ex rel.* Alfred L. Bernardin *vs.* Benjamin Butterworth, Commissioner of Patents.

In the Supreme Court of the District of Columbia.

UNITED STATES *ex Rel.* ALFRED L. BERNARDIN
vs.
BENJAMIN BUTTERWORTH, Commissioner of Patents.

Filed April 28, 1897.
At Law. No. 40946.

It is hereby stipulated and agreed by and between counsel for the parties that a transcript of the record of the case of United States *ex rel.* Alfred L. Bernardin *vs.* John S. Seymour, Commissioner of Patents, No. 40029, may be filed and used as a part of the record in this case and that the exhibits in said transcript may be used as exhibits in this case, and issue and citation are hereby waived.

JULIAN C. DOWELL,
Att'y for Alfred L. Bernardin.
W. A. MEGRATH,
Att'y for Comm'r of Patents.

April 26, 1897.

35 (Endorsed:) At law. No. 40946. In the supreme court of the District of Columbia. United States *ex rel.* Alfred L. Bernardin *vs.* Benjamin Butterworth, Commissioner of Patents. Stipulation.

Memorandum.

Apr. 30, '97.—Appeal bond filed.

Supreme Court of the District of Columbia.

UNITED STATES OF AMERICA, *District of Columbia,* } *ss:*

I, John R. Young, clerk of the supreme court of the District of Columbia, do hereby certify that the foregoing pages, numbered from 1 to 21, inclusive, are true copies of originals in cause No. 40946, at law, wherein United States *ex rel.* Alfred L. Bernardin is plaintiff and Benjamin Butterworth, Commissioner of Patents, is defendant, as the same remains upon the files and records of said court.

Seal of the Supreme Court of the District of Columbia.

In testimony whereof I hereunto subscribe my name and affix the seal of said court, at the city of Washington, in said District, this 3rd day of May, A. D. 1897.

JOHN R. YOUNG, *Clerk.*

Transcript of Record.

Court of Appeals, District of Columbia, October Term, 1896.

THE UNITED STATES *ex Rel.* ALFRED L. BERNARDIN, Appellant, *vs.* JOHN S. SEYMOUR, Commissioner of Patents. } No. 603. No. 7, Special Calendar.

Appeal from the supreme court of the District of Columbia.

Filed July 22, 1896.

In the Court of Appeals of the District of Columbia.

THE UNITED STATES *ex Rel.* ALFRED L. BERNARDIN, Appellant, *vs.* JOHN S. SEYMOUR, Commissioner of Patents. } No. 603.

Supreme Court of the District of Columbia.

UNITED STATES *ex Rel.* ALFRED L. BERNARDIN *vs.* JOHN S. SEYMOUR, Commissioner of Patents. } At Law. No. 40029.

UNITED STATES OF AMERICA, *District of Columbia,* } *ss:*

Be it remembered that in the supreme court of the District of Columbia, at the city of Washington, in said District, at the
36 times hereinafter mentioned, the following papers were filed and proceedings had in the above-entitled cause, to wit:

Petition for Mandamus.

Filed June 15, 1896.

In the Supreme Court of the District of Columbia.

UNITED STATES *ex Rel.* ALFRED L. BERNARDIN *vs.* JOHN S. SEYMOUR, Commissioner of Patents. } At Law. 40029.

Motion for mandamus.

The relator, Alfred, L. Bernardin, says he is a citizen of the United States and residing in Evansville, Indiana, and that during the latter part of February, 1892, to wit, about the 25th day of February, he invented a new and useful improvement in metallic bottle-sealing devices, which was not known or used by others in this country, nor patented nor described in any printed publication in this or any foreign country before his invention or discovery thereof, nor in public use or on sale for more than two years prior to his

application; that upon July 21, 1892, he filed his application—serial No., 440,790—in the U. S. Patent Office for letters patent for the aforesaid device, of which your relator believes himself to be the first and original inventor; that the said application was made in writing in due form as required by statute in every particular, and that your relator, Alfred L. Bernardin, filed therewith in the Patent Office of the United States a certain written description of the same and the manner of making and using it in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which it appertains or with which it is most nearly connected to make, construct, and use the same, and did explain the principle thereof and the best mode in which he has contemplated applying that principle so as to distinguish it from all other inventions, and did particularly point out and distinctly claim the particular improvement and combination which he claims as his invention, as follows:

1st. A metallic bottle-sealing cap having its lower edge adapted to be pressed into contact with a locking shoulder, and provided above the said edge with a circumferential outwardly projecting rib or bead for engagement by the removing tool.

2nd. The improved bottle-sealing cap herein described, provided on its depending flange with an outwardly projecting rib or bead, having its sections 1 and 2 approximately flat, whereby to afford a firm bearing for engagement by the removing tool, and having said sections joined at their outer edges by an acute bend, whereby such joint and the proximity of the sections 1 and 2 of the bead will tend to strengthen and give rigidity to said bead.

3rd. The combination substantially as described of the bottle having its neck provided with a locking shoulder, and the cap
37 fitted on said bottle, pressed into continuous contact with the locking shoulder, and provided with a circumferential outwardly projected bead arranged for engagement by the removing tool.

4th. The improvement in bottle closures substantially as herein described and shown, consisting of the bottle provided near its lip with a locking shoulder, the cap fitted on said bottle and having its lower edge pressed into continuous contact with the locking shoulder, and provided above said contact with an outwardly projecting bead, having flat sections 1 and 2, and arranged for engagement by the removing tool.

5th. The combination substantially as herein described of the bottle provided with a locking shoulder, the cap fitted to said bottle and having the lower edge of its depending flange pressed into contact with the locking shoulder and provided above said lower edge with an outwardly projected portion, having its upper side arranged below the *the* top of the cap and adopted to form a bearing for engagement by the cap-removing tool.

6th. The metallic bottle-sealing cap having its lower edge adapted to be pressed into contact with a locking shoulder and provided above the said edge with a circumferential outwardly projecting rib

or bead for engagement by the removing tool, said rib or bead having its upper side arranged below the plane of the top of the cap.

That said specification and claims were duly signed by your relator, Alfred L. Bernardin, as such inventor, and were duly attested by two witnesses.

That your relator, Alfred L. Bernardin, did further furnish drawings of the said invention, signed by the attorneys of your relator, Alfred L. Bernardin, and attested by two witnesses.

That your relator, Alfred L. Bernardin, did further make oath that he verily believed himself to be the original and first and sole inventor and descoverer of the same, for which he solicited a patent; that he did not know and did not believe that the same was ever before known or used, and did state the country whereof he was a citizen.

That your relator, Alfred L. Bernardin, did further at the time of making such application pay to the said Commissioner of Patents all fees required by law.

That upon the filing of such application and the payment of the fees required therefor by law the said Commissioner of Patents did cause an examination to be made of the new invention set forth, contained, and described in said application, description, and drawings; that upon the said examination it was the opinion of the Commissioner of Patents that the invention was new and useful; that your relator was the first and original inventor, and that your relator was entitled to letters patent for his invention, and thereupon, on October 15, 1892, his application was allowed.

That on or about February 10, 1893, this application was withdrawn from issue for the purpose of interference, and on February 24th, 1893, upon due proceedings and interference was declared with the application of William Painter—serial No., 458,549—
38 filed January 16, 1893; that on March 31st, 1893, William H. Northall filed an application—serial No., 468,524—for letters patent for the same invention, which application was on April 7, 1893, added to said interference between Bernardin and Painter; that the case of this interference duly coming on to be heard before the examiner of interferences according to statute, rules, and regulations of the Patent Office in that case made and provided, upon the respective statements, testimony, and proofs of your relator said Northall and said Painter prepared and presented according to the rules and regulations of the Patent Office, the examiner of interferences did decide that said William H. Northall was the original and first inventor of the said improvement in bottle-sealing devices, and that he was entitled to letters patent therefor.

That your relator, Alfred L. Bernardin, then appealed from this decision to the examiners-in-chief, according to the provisions of the statute and the rules and regulations of the Patent Office, and on May 16, 1894, the decision of the examiner of interferences was affirmed by them.

That your relator, Alfred L. Bernardin, then appealed from the decision of the examiners-in-chief to the Commissioner of Patents according to the statute and the rules and regulations of the Patent

Office, and that on March 23, 1895, the Commissioner of Patents reversed the decision of the examiners-in-chief and decided that your relator, Alfred L. Bernardin, was the first and original inventor of the said invention, and entitled to letters patent for his invention in accordance with the terms and claims of his application.

That said letters patent would have been issued in accordance with the said finding and decision of said Commissioner of Patents but for that, under the statute of the United States in such case made and provided and in accordance therewith, the said William H. Northall prosecuted an appeal to the Court of Appeals of the District of Columbia, in which said appeal the testimony taken before the Commissioner and which was submitted for his consideration, and that alone, was or could under the statute properly be filed in said Court of Appeals, and the errors alleged to have been committed by the Commissioner in rendering said decision, which in said petition are called reasons of appeal, were assigned and the entire record filed as aforesaid with the Court of Appeals of the District of Columbia, and said court entertained and exercised jurisdiction in the matter of said appeal on error.

And subsequently, to wit, on the 12th day of November, 1895, the case was heard upon the record filed as aforesaid, and upon consideration the court reversed the findings of the Commissioner, a copy of which said decision is hereto attached and marked "Exhibit A" and made a part hereof for reference; that a certified copy of said decision was filed with the Commissioner of Patents.

And your relator further presents that being advised by counsel learned in the law and believing that it was the duty of the Commissioner, as a result of his finding and decision, that your relator was and is entitled to have granted and issued to him letters
39 patent for said invention, and which said opinion and decision he has in nowise changed or modified, that it was and is his duty, in conformity with said decision—he, the said Commissioner, not desiring to inquire further, but being satisfied that your relator is entitled to have said patent issued to him—to issue said letters patent to your relator.

And further your relator presents that notwithstanding the act of Congress approved February 9th, 1893, in form confers jurisdiction upon the Court of Appeals for the District of Columbia to hear the appeal on error prosecuted from the action of the Commissioner of Patents, an officer of the executive department of the Government, and to review the official action of said officer of the executive department and to revise and reverse or nullify said action, that said statute is to the extent that it attempts to confer jurisdiction upon the Court of Appeals of the District of Columbia to review, reverse, or nullify the action of the executive branch of the Government unconstitutional, inoperative, and void, and the decision rendered and certified in that behalf is *coram non judice* for want of constitutional authority to entertain, hear, and control by judicial action the official acts of the executive department.

And your relator further presents that the honorable Commis-

sioner of Patents having decided that your relator is entitled to said patent, and when said Commissioner would have issued said patent to your relator, but for the decision aforesaid of the said Court of Appeals for the District of Columbia, your relator formally tendered the final fee due to the Government upon the allowance of the application for a patent upon the decision of said Commissioner that your relator was and is entitled to have and receive said patent, and the honorable Commissioner being fully satisfied in that behalf, and having so found and adjudged and not desiring to make further inquiry in any behalf, your relator did tender the legal fee of $20, with the request that said patent should be issued to him; and thereupon said Commissioner, although he had in nowise changed his mind, and although he had decided and had in nowise changed his mind, that the said William H. Northall was not entitled to have or receive a patent and was not the first inventor, yet because of the decision of the Court of Appeals for the District of Columbia rendered in the proceeding in error as hereinbefore mentioned, he deemed himself concluded from taking any further or other action than to issue said patent to said William H. Northall, and for that reason only he refused to issue said patent to your relator.

Wherefore your relator comes and respectfully asks—

That a writ of peremptory mandamus may issue from this honorable court to the said Commissioner of Patents, commanding him to issue said letters patent to your relator in conformity with his said decision and in accordance with the claims of your relator's application as above stated.

ALFRED L. BERNARDIN.

40 STATE OF INDIANA, }
County of Vanderburgh, } ss:

Alfred L. Bernardin, being duly sworn, deposes and says that he is the relator named in the foregoing petition; that he has read said petition and knows the contents thereof; that the statements therein contained are true of his own knowledge and belief, except as to those matters therein stated on information and belief, and as to such matters he believes them to be true.

ALFRED L. BERNARDIN.

Subscribed and sworn to before me this 11th day of June, A. D. 1896.

[SEAL.] H. I. BENNETT,
Notary Public, D. C.

Answer to Petition for Writ of Mandamus.

Filed June 25, 1896.

U. S. Patent Office.

In the Supreme Court of the District of Columbia.

U. S. *ex Rel.* ALFRED L. BERNARDIN
v.
JOHN S. SEYMOUR, Commissioner of Patents, Respondent. } At Law. No. 40029.

Answer for respondent.

And now comes S. T. Fisher, acting Commissioner of Patents, and makes return officially to the order of the Honorable Louis E. McComas, justice of the supreme court of the District of Columbia, made on the 11th day of June, 1896, in the above-entitled action against John S. Seymour, Commissioner of Patents, to show cause why a writ of mandamus shall not issue, commanding the said John S. Seymour, Commissioner of Patents, to issue letters patent to the relator, as prayed for in the petition upon which said order was granted, and says—

That it is true, as stated by the petition, that the relator did file in the U. S. Patent Office on July 21, 1892, an application for a patent—serial No., 440,790—for improvement in metal bottle-sealing devices; that after examination the relator was adjudged entitled to letters patent for his invention, and his application was allowed and passed to issue October 15, 1892; that on February 10, 1893, said application was withdrawn from issue, and on February 24, 1893, an interference was declared with an application of one William Painter; that on March 31, 1893, William H. Northall filed an application—serial No., 468,524—for letters patent for the same invention, which application was added to the interference between Bernardin and Painter; that this interference was duly tried before the examiner of interferences, as provided by the statutes and the rules of practice of the Patent Office; that the examiner of interferences decided that the said William H. Northall was the original and first inventor of the improvement in controversy, and that the said Northall was entitled to a patent; that the relator then appealed to the examiners-in-chief of the Patent Office, and that the decision of the examiner of interferences was affirmed by them; that the relator then appealed to the Commissioner
41 of Patents, who, on March 23, 1895, reversed the decision of the examiners-in-chief and decided that Alfred L. Bernardin was the first and original inventor of the invention in controversy and was entitled to letters patent therefor, as appears by the copy of the decision annexed and marked "A."

It is further stated that it is true that on April 9, 1895, the said William H. Northall prosecuted an appeal to the Court of Appeals of the District of Columbia, according to the provisions of the acts

approved February 9, 1893, and July 30, 1894, and the rules and regulations of said court; a copy of this appeal is annexed and marked "B;" that after the appeal was duly heard by the Court of Appeals the said court found that the said William H. Northall was the first and original inventor of the improvement in controversy, and by the decision dated January 6, 1896, reversed the decision of the Commissioner of Patents; that a certified copy of said decision of the said court was filed with the Commissioner of Patents, a copy of which decision is annexed and marked "C."

It is further stated that on January 22, 1896, Alfred L. Bernardin, the relator, did make a motion before the Commissioner of Patents to reopen the case for the admission of newly discovered evidence, as shown by a copy of said motion hereto attached and marked "D;" that on May 25, 1896, the Commissioner of Patents rendered a decision denying said motion; a copy of this decision is attached to this answer and marked "E."

It is further stated that on May 28, 1896, Alfred L. Bernardin, the relator, filed in the Patent Office a motion to stay the issue of a patent to Northall, pending proceedings by bill in equity to be filed in the circuit court of the United States for the district of Indiana; that a copy of this motion is attached and marked "F;" that this motion was heard by the acting Commissioner of Patents, and that the said acting Commissioner rendered a decision on June 12, 1896, denying said motion; a copy of this decision is attached to this answer and marked "G."

It is further stated that on May 28, 1896, the relator, as authorized by section 4915 of the Revised Statutes, filed in the circuit court of the United States for the district of Indiana a bill in equity against William H. Northall and John S. Seymour, Commissioner of Patents, to authorize the Commissioner to issue a patent to Alfred L. Bernardin, and that a copy of this bill is hereto attached and marked "H."

It is further stated that it is true that on June 11, 1896, the relator did tender the final Government fee of twenty dollars, with a request that said patent should issue to him, as shown by a copy of the request annexed and marked "I;" that the acting Commissioner of Patents did, on June 15, 1896, refuse the tender of the fee and did deny the request to issue the patent to the relator, as shown by the annexed copy of the decision, marked "J."

It is further stated that the decision of the Commissioner of Patents on the question of priority has not been reversed by him or any one acting for him; that the acting Commissioner
42 refused the fee and refused to issue the patent to the relator, not because he desired to make inquiry as to whether Alfred L. Bernardin is entitled to a patent or to be advised in that matter, but that he based his refusal to accept the fee and issue the patent, and does so still, solely upon the ground that the Court of Appeals of the District of Columbia has entertained the appeal taken to it from the decision of the Commissioner of Patents and found that William H. Northall was the first and original inventor and had

entered a decision reversing the decision of the Commissioner of Patents in favor of Bernardin.

It is further stated that whether or not the act approved February 9, 1893, conferring jurisdiction upon the Court of Appeals of the District of Columbia to hear and decide appeals on error prosecuted from the decisions of the Commissioner of Patents, an officer of the executive department of the Government, is constitutional, the Commissioner or acting Commissioner is not advised.

It is further stated that if the decision of the Commissioner of Patents, which is that Alfred L. Bernardin, the relator, is the first and original inventor of the invention in controversy and is entitled to receive a patent as prayed for, is final, and if upon such decision it is the lawful duty of the Commissioner or the acting Commissioner of Patents to accept the final fee and issue a patent to Bernadin as prayed, then the acting Commissioner of Patents has improperly refused to accept the fee and to prepare said patent for issue, but if the decision of the Commissioner of Patents is subject to revision and reversal on appeal to the Court of Appeals of the District of Columbia, then such refusal on the part of the acting Commissioner of Patents to accept the final fee and issue the patent to Bernadin, the relator, is right and proper.

And, having fully answered, he prays judgment.

S. T. FISHER,
Acting Commissioner of Patents.

W. A. MAGRATH, *Of Counsel.*

43 EXHIBIT "A."

Filed June 25, 1896.

No. 15992. U. S. Patent Office. M. H.

NORTHALL
v.
PAINTER
v.
BERNARDIN. } Bottle-sealing Device.

Appeal from examiners-in-chief.

Application of Wm. H. Northall filed March 31, 1893, No. 468,524.

Application of Wm. Painter filed January 16, 1893, No. 458,549.

Application of Alfred L. Bernardin filed July 21, 1892, No. 440,790.

Mr. Wm. H. Gudgel for Northall.

Mr. Wm. C. Wood for Painter.

Messrs. Butterworth & Dowell for Bernardin.

In this case Painter and Bernardin appeal from the decision of the examiners-in-chief awarding priority of invention to Northall on the following issue:

"A metallic bottle-sealing cap, having its lower edge adapted to be pressed into contact with a locking shoulder, and provided above the said edge with a circumferential outwardly projecting rib or head for engagement by the removing tool."

In 1891 the Bernardin Bottle Cap Company was engaged in the manufacture of bottle-sealing devices of tin, differing from that of this issue, one form consisting of a collar about the neck of the bottle and a tin cap covering the top, the tin top and the collar being connected by tin strips. Bernardin was the principle owner and managing officer of the company, and Northall was foreman of the tool-room and worked under Bernardin's direction.

Painter has no connection with this company, but was connected with the Crown Cork & Seal Company of Baltimore, Maryland. In the view I take of this case he cannot prevail, by reason of his delays and inactivity for a year, between his alleged conception and his application, and his appeal is therefore dismissed.

The cap which the Bernardin Company was then manufacturing was unsatisfactory, and in the latter part of February Bernardin learned that a better and simpler device had been put on the market by the Crown Cork & Seal Company. This was regarded as a matter of great business consequence to the Bernardin Company. Early in the year the company talked about going into the tinware business, and Charles Hart, of Brooklyn, was engaged to inform the company what kind of presses and tools were required for that purpose. Northall thought that this might lead to his separation
44 from the company, for he knew little about the tinware business, and the new Baltimore device tended to the same thing.

Bernardin at that time was closely considering a corrugated bottle head and also a perforated bottle cap, and on April 16, 1892, he filed an application in the Patent Office covering such a device of his own invention. On that day he was in Washington upon the business of his application. While there he ascertained from his attorneys that the application for the corrugated bottle head and for the perforated cap was not allowable. Moreover, it was too hard to get the bottle cap off and too expensive to make. He was very much discouraged. Upon his return to Evansville it became apparent that a new and better cap would have to be found or the bottle-sealing business of the company would have to be abandoned.

Soon afterward the construction of the bottle cap, which is the subject-matter of this interference, was begun by the Bernardin Company, and the question is whether Bernardin or Northall originated it. The facts derived from undisputed testimony will be considered first. After a conference between Bernardin and Northall, Bernardin directed Northall to make a roll and a tool for beading the caps, and this Northall did. About April 25, 1892, a few caps were made with these tools, a specimen like those of the first lot being Northall's Exhibit No. 7, and this cap embodies the issue and is a full reduction to practice, which inures to the benefit of Bernardin or Northall according as the question of originality is de-

cided for the one or the other. Northall made the tools under the direction of Bernardin in the same manner as he made other tools under Bernardin's direction, without any suggestion from Northall that the tolls would be the means for manufacturing an article which the company would not have the right to make, or that the bottle cap when made would embody the invention of Northall.

In the latter part of April, 1892, some of the new caps were made by the use of the arbor and grooved wheel, Bernardin's Exhibits 8 and 11, with no arrangement suggested by either Northall or Bernardin that the invention so reduced to practice was one for which the company would be obliged to treat with one of its subordinates. Better tools, the combination die for pressing the bead on the caps, another method of manufacture, were made by Bernardin's direction, still without any treaty as to the right to make the article. Soon afterward Northall came to understand that Bernardin was preparing to apply for a patent upon this invention.

On July 21, 1892, Bernardin was in Washington again and there made application for a patent upon this article as an invention of his own. In August he received papers from his attorneys in Washington concerning his application in the Patent Office, including a black-print copy of his drawings, showing Bernardin's name signed as inventor, and these he showed to Northall. In October he received a letter from his attorneys in Washington, stating that his application had been allowed. This Northall saw.

In February, 1893, Northall for the first time consulted an
45 attorney about his interests. In the same month his counsel opened correspondence with the attorney for the Crown Cork & Seal Company and indirectly with Painter.

Between the first and fourth of March, 1893, Bernardin was informed that an interference had been declared between himself and Painter, and on the tenth of March this was mentioned by Bernardin to Northall.

March 17, 1893, Bernardin, Haas, and others formed a company for exploiting the new invention. Soon afterwards Bernardin learned that Northall was in correspondence, through attorneys, with his opponent, Painter. On March 29, 1893, Bernardin discharged Northall, stating to him that it was for that reason. On the same day Northall and his attorney started for Washington and immediately prepared and filed in the Patent Office his application.

From these undisputed facts I am strongly impelled toward the conclusion that Bernardin is the real inventor, because it is difficult to believe that events progressed, under the daily observation of Northall, to the point of commercial manufacture of this article in a factory in which Northall had no proprietary interest without an attempt at least to exact an agreement giving him recompense if he so much as thought himself the inventor and without an attempt to apply for a patent in his own name.

It is now necessary to weigh the conflicting testimony, and first on the question whether Northall ever said to Bernardin, "I ought to get a patent on this." I doubt it. Had he said so much he would have said more or done more. That did not protect his sup-

posed rights nor meet the exigency of another manufacturing the device before his eyes, as though it were not his. My conclusion is that at no prior time to his discharge did Northall make to Bernardin any claim to — the originator of this invention.

Northall claims that he has shown that he was in possession of the mental conception of this device as early as December 19, 1891, and that on that day he made two sketches of the device, one upon drawing paper at his house, Northall's Exhibit No. 1, and the other upon a card-board oyster sign in Haas's saloon that evening. Exhibit No. 1 is dated December 19, 1891. Since throughout the period from December to April the bottle-sealing branch of the Bernardin Company's business was at a crisis in its affairs by reason of the impending competition of the company in Baltimore with a superior cap, as they believed, it is a striking circumstance, if true, that Northall was in possession of the complete remedy. The evidence upon this point is challenged, and accordingly it has been closely scrutinized. The drawings were made at some time and one of them was exhibited on some occasion in Haas's saloon. Northall, McDowall, F-ank Haas, Oslage, Heidt, Zeigler, and Wagner all saw it at one time, and that in Haas's saloon. But at what time? Singularly enough, each remembers that it was on the 19th of December, 1891; McDowell because he had a dispute with Haas and for a time did not go there; Frank Haas because he attended a funeral the next day; Oslage because Haas said he was
46 going to a funeral the next day; Heidt because it was the Saturday before Christmas; Zeigler states it to be just before Christmas, 1891, but does not show how he fixes the date, and Wagner does not state how he fixes the time. It appears that all of these persons were at this saloon on other Saturday nights before and after this occasion, and the particular meeting at which Northall drew the sketch is not connected with any event the date of which is fixed by anything more than arbitrary association of ideas. At best it is entitled to but little weight.

It is indisputable that the first caps were made in the latter part of April, 1892. The caps were not made from either of these drawings. There are indications that these drawings whenever exhibited, either in the saloon or on the occasion of the visit to Northall of Mr. and Mrs. Polsdorfer, were exhibited not earlier than the time of making of the first caps. Mary Polsdorfer, while stating that it was shown to her on a visit of herself and Henry Polsdorfer to Northall in the latter part of 1891, attempts to fix the date by the making of slipper cases for Christmas and before the birth of her child on February 23, 1892; but the families were intimate; she made many visits before and after that time, and the casual exhibition of the drawing by Northall to her husband might have been on the same evening the slipper cases were spoken of or equally well on any other. On cross-examination she states that Northall showed her a cap at the same time that he showed the drawing, though she afterward says it was only the drawing of the cap. If the drawing and the cap were shown her together, the visit could

not have been in December, 1891, nor earlier than the latter part of April, 1892, for the caps were not made until April.

Heidt was at the meeting in Haas's saloon when Northall drew the sketch on the back of an oyster sign, and states that the meeting was on Saturday before Christmas, 1891, but also says that Northall had a cap in his pocket, and that the rest of the party were handling it, although he did not. If Northall had the cap at the meeting in the saloon the meeting was as late as April. Comparing critically Frank Haas's testimony and Oslage's, it would appear that the meeting at the saloon was much later than December. Finally the drawing, Northall's Exhibit No. 1, upon its face raises doubts, in that the date appears to be written over an erased word, the lower loop of a letter remaining between the parallel lines of the handle of the decapper.

The conflict of testimony upon the first conversation at the factory between Bernardin and Northall after Bernandin's return from Washington in April, 1892, separately considered, leaves the mind in great doubt as to exactly what was said. It is examined in vain for substance upon which to base a conclusion either that Northall communicated the idea to Bernardin or Bernardin to Northall. But reconciling the testimony where possible and constructing language and circumstance into a consistent whole, it is thought that Northall did not have the invention as claimed in December, 1891; that it was first referred to in a later conversation between Northall and Bernardin when Bernardin was con-
47 sidering the corrugated and the perforated sealing cap; that the conception originated with Bernardin and was not original with Northall, but was communicated by Bernardin to Northall, although Northall was the first to communicate the idea to Thuman, probably during Bernardin's absence in April.

Weight must be given to the facts of manufacture without seeking the consent of Northall; the orderly application by Bernardin for a patent, not with undue haste nor with unusual delays, but conformably with the common experience; the absence of Northall's assertion of title for many months and until after his discharge, and the long delay in his application for a patent; these all concur in showing Bernardin to be the inventor and the first, and accordingly the judgment of priority is awarded to him and the decision of the examiners-in-chief is reversed.

The record in this case abounds in improper remarks, long statements touching the conduct of counsel and witnesses, imputations of fraud, perjury, bribery, and finally, by the introduction of Inkenbrandt's testimony, implication in the violent death of Ives, which are not proof and are not proper parts of the record. Most of the matter alluded to should have been expunged before printing and would have been excluded upon motion. Smith *v.* Elliott, 9 Blatch., 400, 407. The record in this case is very voluminous at best, unnecessarily so, from the method of examination adopted, but that the office should be burdened with the reading of additional and wholly irrelevant discussion of other matter of the kind alluded to

is intolerable, and the insertion of such things in the record cannot be too strongly condemned.

Decision reversed.

JOHN S. SEYMOUR,
Commissioner.

March 23, 1895.

EXHIBIT "B."

Filed June 25, 1896.

$25 applied.

United States Patent Office.

W. H. NORTHALL
vs.
WILLIAM PAINTER
vs.
ALFRED L. BERNARDIN.

Interference No. 15992. Bottle-sealing Device.

To the Hon. the Commissioner of Patents.

SIR: In matter above named I, William H. Northall, hereby pray an appeal to the United States Court of Appeals for the District of Columbia from your honor's decision of March 23rd, 1895, awarding priority of invention to Alfred L. Bernardin.

The following reasons for appealing are assigned:

48 That the Hon. Commissioner erred:

First. In finding said Bernardin to be the inventor of the improvement in bottle-sealing devices which is the subject of said interference, and in awarding priority to said Bernardin.

Second. In failing to find that said Northall was the original and first inventor of said improvement and entitled to the patent therefor, and to award priority to said Northall.

Third. In failing to find that said invention was made, exhibited, and described by said Northall prior to any alleged conception or invention thereof by said Bernardin.

Fourth. In failing to find that said invention was exhibited and described by said Northall to the witnesses Henry Polsdorfer, Mary Polsdorfer, Frank Haas, McDowell, Wagner, Zeigler, Heidt, and Oslage prior to any alleged conception thereof by said Bernardin, and also described by said Northall to the officers and employees of the Bernardin Bottle Cap Co. prior to any mention or suggestion thereof by said Bernardin, and also that the same was communicated to said Bernardin by said Northall, and that the evidence indicated that said Bernardin had no conception thereof until after it was so communicated to him by said Northall.

Fifth. In failing to find that said invention, having been first made and described by said Northall, was unjustly and fraudulently appropriated by said Bernardin, who was not the inventor thereof, and in failing to adjudge priority in favor of said Northall and to award him the patent for said invention.

Sixth. In finding that at no time prior to his discharge did Northall make to Bernardin any claim to be the originator of the said invention, whereas he should have found that Northall communicated the invention to Bernardin and to others connected with and representing the company as original with himself, and thereafter constantly treated and referred to it as his, and that neither Bernardin nor others disputed the fact that it originated with Northall until after the interference was declared and after his consultation with counsel revealed to Bernardin the necessity of making such claim.

Seventh. In finding that Northall made the tools for forming the bottle-sealing devices or caps under Bernardin's direction without any suggestion from Northall that the tools would be the means for manufacturing an article which the company would not have the right to make, or that the bottle-sealing devices when made would embody the invention of Northall, whereas he should have found that said invention was disclosed to said Bernardin as the invention of said Northall; that Bernardin was fully informed of Northall's claim of invention, and that he desired and expected to obtain a patent therefor.

Eighth. In finding that there was no suggestion by said Northall that the invention was one for which the company would be obliged to treat with its subordinate, whereas he should have found that Northall repeatedly asserted his right as inventor and his desire and intention to obtain a patent therefor, and, among others, to said Bernardin and other officers and agents of said Bernardin Bottle Cap Co.

49 Ninth. In failing to find that the patent that Northall understood Bernardin was preparing to apply for was to be, as it should have been, in the name of Northall as inventor.

Tenth. In finding that said Northall made no attempt to exact an agreement for recompense or to obtain a patent in his own name while the invention was advancing to the point of commercial manufacture.

Eleventh. In failing to find that said Bernardin represented to said Northall, prior to the allowance of said Bernardin application, that said improvement was not patentable, and that he had ascertained that no patent could be obtained for said invention and discouraged Northall from applying therefor.

Twelfth. In finding that said Bernardin was the principal owner of the Bernardin Bottle Cap Co., and that Northall worked under his direction, whereas he should have found that said company was a corporation, in which said Bernardin was only a stockholder and an officer.

Thirteenth. In finding that all the persons who saw the making of the drawing at the Haas saloon were there on other Saturday nights after the occasion described.

Fourteenth. In finding that the time of the meeting at which Northall made said drawing in said saloon is not fixed by anything more than arbitrary association of ideas, and that it is entitled to little weight.

Fifteenth. In finding that there are indications that the Northall drawings in evidence were exhibited not earlier than the time of making the first caps, whereas he should have found that they were unmistakably shown to have been exhibited in December, 1891.

Sixteenth. In finding that said Northall did not have the invention as claimed in December, 1891, whereas he should have found that the said invention was made and disclosed by said Northall in December, 1891, and thereafter disclosed by said Northall to said Bernardin, as well as to others, prior to any conception or mention thereof by said Bernardin.

This appeal is taken under the act of Congress approved February 9th, 1893, section 9, providing for appeals to the United States Court of Appeals of the District of Columbia.

I pray that this appeal may act as a supersedeas, and that it shall stay the issue of letters patent to A. L. Bernardin, covering the subject-matter in controversy.

I further pray that a certified transcript of the record in this case will be furnished, and that the same may be certified to the Court of Appeals. I herewith tender the sum of twenty-five dollars on account of the costs of said transcript, and I will promptly respond to call for further funds should said amount be insufficient.

Very respectfully, WILLIAM H. NORTHALL,
By WM. H. GUDGEL, *Attorney.*

(Local address, care Mr. Howell Bartle, 639 F street N. W., Washington, D. C.)
April 6th, 1895.

50 Court of Appeals of the District of Columbia, Patent Appeal Docket, January Term, 1896.

WILLIAM H. NORTHALL, Appellant,
vs.
WILLIAM PAINTER and ALFRED L. BERNARDIN. } No. 31.

Subject-matter: Bottle-sealing devices. No. 15992.

Appeal from the Commissioner of Patents.

This cause came on to be heard on the transcript of record from the Commissioner of Patents and was argued by counsel.

On consideration whereof it is now here ordered and adjudged by this court that the decision of the said Commissioner of Patents in this cause be, and the same is hereby, reversed.

Per Mr. JUSTICE SHEPARD.

January 6, 1896.

(A true copy.)
(Test:)
[COURT SEAL.] ROBERT WILLETT, *Clerk.*

EXHIBIT "D."

Filed June 25, 1896.

In the United States Patent Office.

NORTHALL
vs.
PAINTER
vs.
BERNARDIN.
} Interference No. 15992. Bottle-sealing Device.

To the Commissioner of Patents.

SIR: And now comes Alfred L. Bernardin, by his attorneys, Butterworth & Dowell, and moves:

First. That the above-entitled interference be reopened for the admission of newly discovered evidence which could not with reasonable diligence have been produced at the hearing, and that a reasonable time be assigned within which the contestant, A. L. Bernardin, may introduce the testimony of the several per-
51 sons whose affidavits are filed in support of this motion and of others for the purpose of establishing the facts recited in said affidavits, and such other evidence as may be competent to make clear the facts in that behalf and to show:

(1.) That the drawing introduced in evidence in this cause on behalf of William H. Northall as "Northall's first drawing, Exhibit No. 1," in support of his alleged claim to priority of invention, was not made at the date alleged in the testimony of said Northall and his witnesses, to wit, December 19, 1891, but at a date long subsequent thereto, and that the true date originally placed upon said drawing was erased by the said Northall and a fictitious date written over the erased date prior to offering the same in evidence, and for the purpose of concealing the date when said exhibit was actually made, and thereby misleading the Commissioner of Patents and the court.

(2.) That the alleged date of the making and exhibition at the saloon of Frank Haas of the drawing offered in evidence on behalf of the said Northall as "Northall's Exhibit No. 3, card-board drawing," is erroneous, and that such exhibition occurred, if at all, and such drawing was made long subsequent to December, 1891, and subsequent to the making of the bottle caps embodying the invention in issue, at the works of the Bernardin Bottle Cap Company, in April, 1892.

Second. That an order be entered authorizing the use as evidence in this cause of so much of the testimony of William H. Northall and his witness Henry B. Polsdorfer, taken in the pending interference No. 17284, between said Northall and Bernardin, for bottle-capping machines, as may be competent to show the relations existing between the said Northall and Polsdorfer and the interest of the latter in the result of the pending interferences.

Third. That the issuance of a patent to the said William H. Northall, in whose favor decision has been rendered by the Court of Appeals, overruling the decision of the Commissioner of Patents, be stayed, and further action upon the application of the said Northall involved in this interference be suspended pending the final determination of this motion.

In support of this motion are herewith filed affidavits of Joseph B. Church, Edwin B. Hay, Millard F. Hatton, John J. Nolan, Ernest D. McAvoy, R. C. Rice.

Reference will also be made at the hearing upon this motion and in support thereof to such parts of the evidence comprised in the record of testimony and exhibits filed in this cause in behalf of the parties thereto as may be deemed competent and proper.

A. L. BERNARDIN,
By BUTTERWORTH AND DOWELL,
His Attorneys.

January 22nd, 1896.

52 EXHIBIT "E."

Filed June 25, 1896.

No. 15992. M. H.

U. S. Patent Office.

NORTHALL
v.
BERNARDIN. } Bottle-sealing Device.

Motion to reopen.

Application of William H. Northall filed March 31, 1893, No. 468,524.

Application of Alfred L. Bernardin filed July 21, 1892, No. 440,790.

Mr. Wm. H. Gudgel for Northall.

Messrs. Butterworth & Dowell for Bernardin.

After a decision in his favor by the office and a reversal of that decision by the Court of Appeals of the District of Columbia, Bernardin moves to reopen this case for the purpose of introducing newly discovered evidence which he claims will probably change the result. The most significant part of the alleged newly discovered evidence is that of a partly erased writing, over which the date December 19, 1891, was written upon Northall's drawing Exhibit No. 1. Upon this point the affidavit of Mr. Joseph B. Church is presented to the effect that he deciphers the partly erased writing to be February, 1893. A photograph taken about the time the exhibit was put in evidence shows that there had been an erasure, and enlarged photographs taken later show parts of letters which cannot be deciphered from the drawing itself.

In answer to the affidavits of Bernardin upon this motion Northall makes an affidavit upon this point as follows:

"The paper upon which my original drawing was made was some

that remained of what I was using for making sketches during the last two years I lived at Bridgeport, Connecticut. It had been used, and I erased what was on it before making this drawing.

" When I testified last fall in the machine interference about the 'loop' shown in the photograph of my drawing I thought it must be the upper part of a '*b*,' as I knew I wrote December twice the night I made the drawings. I could not account for any kind of a loop in any other way. I am sure that I never wrote any word on that paper having a letter with a lower loop after I made the drawing, unless I accidentally made a lower loop when I intended an upper one. I write but little and sometimes get letters wrong and have to change them, but I have no distinct recollection of having done so when dating this drawing, though it might have happened. I sometimes wrote dates and other words on the sketches which I made in Bridgeport."

The question is whether this evidence was discovered since
53 the former trial. The general principles regarding new trials for newly discovered evidence are that an application therefor is looked upon by the courts with disfavor; that the evidence must have been discovered since the former trial; that the party must have used due diligence in procuring it on the former trial; that it must be material to the issue; that it must go to the merits of the cause and not merely to impeach the character of a witness; that it must not be merely cumulative; that it must be such as ought to produce on another trial an opposite result on the merits.

The bearing of this evidence of something imperfectly erased is important. A working drawing of a bottle-capping device in the hands of either of these parties as early as December 19, 1891, is extremely significant; a working drawing in the hands of Northall as late as February, 1893, would be of no special significance.

It was claimed by Northall that the evidence was cumulative. It is true that there was evidence tending to show that Northall did not make a working drawing of this invention as early as December 19, 1891, in the record, strictly so called. That evidence is circumstantial. In the trial upon appeal before the circuit court of appeals of this District it appears that enlarged photographs were exhibited to the court for the purpose of showing that there had been an erasure, and the argument appears to have been made that December 19, 1891, was not the true date of the paper. It does not appear that any testimony was presented to that court or that there is any in the record to the point of what the erased word or figures are, unless the exhibit itself may be considered such testimony. There is presented before me an account of this matter by Northall himself which is in the nature of an admission that what was erased was a date, and that he erased it, and that he wrote the words and figures above it—December 19, 1891.

It has been held that the admission of a party is not evidence of the same kind as the testimony of other witnesses, and therefore is not cumulative, although relating to the same controverted fact. Wayt *v.* Burlington, etc., R. Co., 45 Iowa, 217; Humphreys *v.* Klick,

49 Ind., 189; Rains *v.* Ballow, 54 Ind., 82; Fletcher *v.* People, 117 Ill., 190.

But the evidence tends to establish a fact that was not before in the case, to wit, that the drawing bore another date, and that the date it first bore was February, 1893. If this testimony is to be believed, and if it turn out to be, on more critical examination, of the tenor indicated, it appears to me to be destructive of Northall's case.

While impressed with this evidence, I deem it my duty, in view of the doubt whether the Commissioner has power to open a case after it has been considered and decided by the circuit court of appeals in this District on appeal, to disregard it and deny the motion. Were the petitioner without other remedy, I might take a different view of this case, but under section 4915 of the Revised Statutes he has a remedy by bill in equity, where, upon a record hereafter to be made, with a fuller knowledge of all the facts,
54 it will be adjudged whether he be entitled to the patent which must now be refused.

Without passing upon the other matters urged by Northall against this motion, the motion must be dismissed, and it is so ordered.

JOHN S. SEYMOUR,
Commissioner.

May 25, 1896.

Filed June 25, 1896. M. H.

DEPARTMENT OF THE INTERIOR,
UNITED STATES PATENT OFFICE,
WASHINGTON, D. C., *June* 23, 1896.

In the Supreme Court of the District of Columbia.

U. S. *ex Rel.* ALFRED L. BERNARDIN
v.
JOHN S. SEYMOUR, Commissioner of Patents, Respondent. } At Law. No. 40029.

It is stipulated by and between counsel that the annexed copy of the bill of complaint is a true copy of the bill in equity, No. 9358, filed in the circuit court of the United States for the district of Indiana, entitled Alfred L. Bernardin, complainant, *v.* William H. Northall and John S. Seymour, Commissioner of Patents, defendants, and that said copy may be used in the present suit of mandamus against John S. Seymour, Commissioner of Patents, in lieu of a certified copy, subject to correction if found incorrect.

W. A. MEGRATH,
Counsel for Commissioner of Patents.
BUTTERWORTH & DOWELL,
Counsel for Alfred L. Bernardin.

EXHIBIT "H."

Filed June 25, 1896.

In the Circuit Court of the United States for the District of Indiana.

ALFRED L. BERNARDIN, Complainant,
vs.
WILLIAM H. NORTHALL and JOHN S. SEYMOUR, Commissioner of Patents, Defendants. } In Equity.

To the honorable the judges of the circuit court of the United States for the district of Indiana:

Alfred L. Bernardin, a citizen of the State of Indiana and residing at Evansville, in the county of Vanderburgh and State of Indiana, brings this his bill of complaint against William H. Northall, a citizen of said State, residing at Evansville aforesaid, and John S. Seymour, Commissioner of Patents, having his official residence at the city of Washington, in the District of Columbia.

1. And thereupon your orator complains and says that he, being the true, original, and sole inventor of a new and useful improvement in bottle-sealing devices known as the "beaded sealing cap" or beaded cap, which invention or improvement was not know- or used by others in this country and not patented or described in any printed publication in this or any foreign country before his invention or discovery thereof and which had not been in public
55 use or on sale in the United States for more than two years prior to his application for a patent therefor, on the 21st day of July, A. D. 1892, made application in due form of law to the Commissioner of Patents for letters patent for said invention and filed in the United States Patent Office a written description of the said invention and of the manner and process of making, constructing, and using the same in such full, clear, concise, and exact terms as to enable any persons skilled in the art or science to which it appertains or with which it it most nearly connected to make, construct, and use the same, explaining the principle thereof and the best mode in which he has contemplated applying that principle, so as to distinguish it from other inventions, and particularly pointing out and distinctly claiming the part or improvement which he claims as his invention or discovery, as upon reference to said application or a duly authenticated copy thereof, here in court ready to be produced and shown unto your honors, will more fully appear, and to which your orator craves leave to refer.

II. And your orator further shows unto your honors that he conceived the aforesaid invention during the month of February, 1892, and disclosed it to the defendant William H. Northall a few days thereafter and during the month of March, 1892; that at and prior to the last-mentioned dates your orator was and still is the president, superintendent, and general manager of the Bernardin Bottle Cap Company of Evansville, Indiana, manufactures of bottle

caps constructed in accordance with patents theretofore issued to your orator as the inventor, and the said Northall was at that time and prior thereto and until the 29th of March, 1893, a trusted employé of said Bernardin Bottle Cap Company, working under the direction and supervision of your orator, and while so employed assisted as a mechanic in making the first beaded caps that were made embodying your orator's aforesaid invention, which caps were made during the month of April, 1892, under your orator's direction and supervision and as a reduction to practice of your orator's aforesaid invention.

III. And your orator further shows unto your honors that on due proceedings had in the Patent Office your orator was by an official letter dated October 15, 1892, notified by the Commissioner of Patents of the allowance of said application, reciting in said notice that six months from the date thereof would be allowed for the payment of the final Government fee, upon the payment of which the patent would issue to your orator; and the defendant, the said William H. Northall, was informed by your orator of the allowance of said application, the written notice of which he saw and read when it was received, on or about the 18th of October, 1892, but neither at that time nor at any other time in your orator's presence or to his knowledge until the doing of the acts hereinafter complained of did he make any claim that he, the said Northall, was the inventor, either in whole or in part, of said invention.

IV. And your orator further shows unto your honors that thereafter, to wit, on the 16th day of January, 1893, one William Painter, of Baltimore, Maryland, the secretary and business manager
56 of the Crown Cork & Seal Company of Baltimore, Maryland, having theretofore, through his agent, without your orator's knowledge or consent, surreptitiously obtained one of your orator's aforesaid beaded sealing caps from the works of the Bernardin Bottle Cap Company, where your orator's experiments were being conducted, during the absence of your orator and his employés and when the works were closed, and having thus obtained said cap the said William Painter filed in the United States Patent Office an application for a patent for the same invention as that described and claimed in your orator's aforesaid application; and thereafter, to wit, on the 24th day of February, 1893, an interference was declared between your orator's aforesaid application and the application so filed by said William Painter for the purpose of determining the question of priority of invention in accordance with the provisions of the Revised Statutes and the rules of practice of the Patent Office.

V. And your orator further says that the said William H. Northall, as a trusted employé, receiving and having the confidence of your orator, was charged with the duty of preparing and did prepare drawings for making the tools and assisted in making said tools for the purpose and in manufacturing said sealing cap, and was fully informed of each step taken by your orator from the first conception of the invention, in February, 1892, until the same was reduced to practice, and on until a patent was applied for by

your orator and *and* allowed by the honorable Commissioner of Patents.

VI. And your orator further says that after his said invention was completed and reduced to practice and he had applied for a patent therefor, which had been allowed, of all of which and with the details of which the said Northall had, as aforesaid, full knowledge, he, the said Northall, did, as your orator is informed and believes, and hence avers and charges, on or about the month of February, 1893, corruptly and with the intent and purpose of defrauding your orator and preventing him from obtaining his patent on said invention which he, the said Northall, knew had been allowed by the Commissioner of Patents, and with the purpose and intent to appropriate said invention in whole or in part to his own use or derive some pecuniary benefit therefrom, and for the purpose of carrying out and accomplishing said object and to despoil your orator of his said property in said invention, the said Northall, while he was still a trusted employé of your orator and sustained toward him confidential business relations as such employé, personally and by his agent and attorney entered into a secret and clandestine correspondence with a competitor of your *prator*, revealing to said competitor or to his agent the secret and confidential business of your orator in reference to said invention, and, further, in carrying out said object and purpose said Northall on or about the first day of April, 1883, entered into an agreement with William C. Wood, of the city of Washington, District of Columbia, the agent of your orator's competitor, to wit, the Crown Cork & Seal Company of Baltimore, Maryland, by the terms of which agreement the said
57 competitor agreed and undertook to pay to the said Northall fifty ($50.00) dollars a month for each and every month during the whole period he should be engaged in performing the service in said contract stipulated to be performed by the said Northall. By the terms of said contract, a copy of which is hereto attached and marked "Exhibit A" and made a part hereof for reference, the said Northall agreed and undertook to prevent your orator from obtaining his said patent and to secure for your orator's competitor, to wit, the Crown Cork and Seal Company of Baltimore, Maryland, the ownership and control of said invention; that the said William C. Wood, as agent for said Crown Cork & Seal Company, by the terms of said contract reserved to himself the power and authority to withhold and altogether withdraw said monthly stipend from the said Northall at any time if he failed to perform to the satisfaction of said Wood the service exacted of him by said Wood under the terms of said contract.

VII. And your orator further shows unto your honors that on the 31st day of March, 1893, the said William H. Northall filed in the United States Patent Office an application for a patent for the said invention, and on the 7th day of April, 1893, the said Northall was made a party to the aforesaid interference between your orator's application and the application of the said Painter.

VIII. And your orator further says that he is informed and believes, and hence avers, that in pursuance of said agreement and in

promoting the object of said conspiracy the said Northall, in his aforesaid application, claimed that he was the original and first inventor of said beaded sealing cap, and thereupon he, the said Northall, did, as your orator is informed and believes, and hence avers and charges, fabricate testimony by erasing the date and inscription on a certain drawing which disclosed the invention and writing thereon another and different date so as to make it appear that said drawing was made at an earlier period than it actually was made, all of which was done to induce the belief that said drawing was made as of the date so fraudulently written on said drawing, when in truth and in fact it was made more than a year subsequent thereto.

IX. And your orator further says that he is informed and believes, and hence avers, that in promoting and carrying out the intent and purposes aforesaid the said William H. Northall prevailed upon certain witnesses to testify that certain drawings disclosing the said invention were made and exhibited to them and certain writing was placed thereon on a date earlier than the true one, the said Northall well knowing that the testimony of the said several witnesses in that behalf was incorrect and untrue.

X. And your orator further says that on the 23rd day of March, A. D. 1895, upon the pleadings and proofs taken and filed in the case, the Commissioner of Patents rendered a decision awarding priority of invention to your orator, Alfred L. Bernardin, as against the claims of both the said Painter and the said Northall, as by reference to said decision or a duly authenticated copy thereof
58 here in court ready to be produced and shown unto your honors will more fully appear and to which your orator craves leave to refer, and in view of the Commissioner's decision against his alleged claim to the invention the said Painter dropped out of the interference, but said Northall, in carrying out his said agreement, took an appeal to the Court of Appeals of the District of Columbia, your orator's said competitor paying all bills and defraying all expenses incurred in and about that behalf, and said cause came on to be heard before the Court of Appeals on the 12th day of November, 1895, on the evidence produced before the Commissioner, said false and fraudulent drawings so as aforesaid fabricated being a part of the record and accepted by the court as true and genuine, and on the 6th day of January, 1896, the said court rendered a decision reversing the decision of the Commissioner of Patents for reasons recited in said decision, as by reference thereto or to a duly authenticated copy thereof here in court ready to be produced and shown unto your honors will more fully appear.

XI. And your orator further says that so skillfully made were the aforesaid erasures, alterations, and changes in the date and inscription upon the drawing and paper that neither your orator nor his counsel suspected or detected the same, and only learned of it after all the testimony in said interference case had been taken and filed in the case set for hearing and about to be heard by the Court of Appeals of the District of Columbia on appeal by the said Northall

from the decision of the Commissioner of Patents awarding your orator to be the true and original inventor.

XII. And your orator further says that by reason of said false and fraudulent representations and skillful fabrication of testimony by the erasures and changes made upon said drawing and paper as aforesaid the said Court of Appeals of the District of Columbia was imposed upon and induced to believe that the dates so falsely fabricated were the original and correct dates, whereas they were and were well known to said Northall to be incorrect and untrue.

XIII. That by reason of such false and fraudulent testimony so as aforesaid fabricated the said Court of Appeals of the District of Columbia was imposed upon and misled and *were* induced to rely upon the genuineness and honesty of said false and fraudulent dates so as aforesaid fabricated and which were intended to indicate and induce the belief that said false and fraudulent date was that upon which said drawing was made, and therefore gave judgment reversing the decision of the Commissioner of Patents, who had awarded priority of invention to your orator.

XIV. And your orator further complains and says that he has invested and expended large sums of money in experimenting, developing, and reducing to practice his aforesaid invention and for the purpose of making the same commercially practicable and profitable to himself and of advantage to the public; that the invention is of great commercial utility and value; that its novelty, superiority, and value is generally recognized, yet the said Northall,

59 well knowing the premises and the rights of your orator as aforesaid, but contriving and conspiring to injure and deprive your orator of the profits, benefits, and advantages which might and otherwise would have accrued to him from said invention and the letters patent to be issued thereon, set up, as aforesaid, an alleged claim to the invention for the purpose of an interference in the interest of the said Crown Cork & Seal Company, and said interference has been prosecuted at the expense of the said Crown Cork & Seal Company, as your orator is informed and believes, and hence alleges.

XV. That the said William H. Northall, as an employé of the Bernardin Bottle Cap Company, working under the direction and supervision of your orator and assisting in the work of making the beaded caps embodying your orator's invention, continued to receive your orator's confidence and friendship, and affecting an earnest desire to aid your orator in preparing drawings and tools to produce said beaded caps, and had full knowledge of your orator's acts and doings in the matter of experimenting and developing your orator's aforesaid invention until the 29th day of March, 1893, about which time your orator was informed that his theretofore trusted employé had been and was then engaged in clandestine correspondence with the Crown Cork & Seal Company or the agent of said company, competitors in business of the Bernardin Bottle Cap Company, with reference to your orator's said invention for the purpose of setting up a claim thereto and negotiating for the transfer of said claim to

said company, whereupon the said Northall was discharged from the service of the company.

XVI. That the aforesaid acts and doings of the said defendant have caused and are causing your orator great injury and damage, and that notwithstanding the novelty and value and utility of your orator's invention he is wholly without protection and is being deprived of his rights in that behalf and is suffering irreparable loss and damage.

XVII. And your orator says that although the appeal hereinbefore mentioned, prosecuted by the said Northall from the decision of the Commissioner of Patents to the Court of Appeals of the District of Columbia, was in conformity to section 4915 of the Revised Statutes of the United States, authorizing and providing for such appeals, and the review and revision of the decision of the Commissioner of Patents in that behalf by the said Court of Appeals, yet your orator says that said court was without jurisdiction in that behalf to modify, reverse, revise, or annul the said decision of the Commissioner of Patents rendered in that behalf, the statute of the United States providing for such appeals and review to the contrary notwithstanding.

Your orator further says in that behalf that said court was wholly lacking in jurisdiction to hear and determine and revise or reverse the decision of the Commissioner of Patents, because all matters pertaining to the granting of patents by the United States to inventors and the determination of every question in that behalf is and at the same time and therefore was conferred upon and by law belongs to the executive department of the Government, and has been by law specially conferred upon the Bureau of Patents and the Commissioner of said bureau, which said bureau and the official head thereof form a part of the departmental organi-
60 zation and machinery of the executive department of the Government, and therefore an appeal from the official act in question being an official act of the executive department of the Government, acting within the jurisdiction properly conferred upon it under the Constitution of the United States, cannot be reviewed on appeal or writ of error prosecuted to the judicial department of the Government and reversed or nullified by a court of said judicial department.

And forasmuch as the said executive and judicial departments of the Government are separate, co-ordinate, coequal, and independent, said appeal for the purpose of review of said official action so, as aforesaid, prosecuted from the Commissioner of Patents to a judicial tribunal of the judicial department of the Government, to wit, to the Court of Appeals of the District of Columbia, is in contravention of policy of the Government and in violation of the Constitution of the United States, and hence the finding and decision of said court reversing the decision of the Commissioner of Patents rendered in that behalf *in coram non judice*, void, and of no effect; and your orator says that but for said action of the said Court of Appeals in form reversing the finding and decision of the honorable Commissioner of Patents letters patent for said invention, to which by the

decision of said Commissioner your orator was entitled, would long since have been issued to him.

Wherefore your orator prays your honors to determine whether said writ of error so as aforesaid prosecuted was operative in law to reverse or annul the decision of the said Commissioner of Patents, and that such order and decree may be made in that behalf as may be just.

XVIII. And your orator further prays that this honorable court, on notice to the defendants, the said William H. Northall and the Commissioner of Patents, John S. Seymour, and other due proceedings had, may adjudge that your orator is entitled, according to law, to receive a patent for his said invention, as set forth in his aforesaid application and specified in the claim thereof, so that the said Commissioner of Patents, John S. Seymour, or his successors in office may be authorized to issue letters patent to your orator for said invention, in accordance with the decision of your honors, and for such other and further relief in the premises as the facts in the case may require and to your honors may seem meet.

And to this end may it please your honors to grant unto your orator the writ of *subpœna ad respondendum* issuing out of and under the seal of this court, directed to the defendant, the said William H. Northall, commanding him on a certain day and under a certain penalty to be and appear in this honorable court, and then and there to answer the premises and to stand to and abide by such order and decree as may be made in this behalf, and also a
61 writ of *subpœna ad respondendum*, directed to the said John S. Seymour, Commissioner of Patents, commanding him on a day certain to appear and answer this bill of complaint.

And your orator will ever pray, &c.

(Signed) ALFRED L. BERNARDIN,
Complainant.

(Signed) BUTTERWORTH & DOWELL,
Solicitors and of Counsel.

U. S. OF AMERICA, }
State of Indiana, County of Vanderburgh, } *ss:*

On the 26th day of May, A. D. 1896, before me personally appeared Alfred L. Bernardin, the above-named complainant, who, being duly sworn, deposes and says that he has read the foregoing bill of complaint subscribed by him and knows the contents thereof, and that the same is true of his own knowledge except as to the matters therein stated on information and belief, and as to those matters he believes it to be true.

ALFRED L. BERNARDIN,
Complainant.

Subscribed and sworn to before me this 28th day of May, A. D. 1896.

[SEAL.] NOBLE C. BUTLER, *Clerk.*

UNITED STATES OF AMERICA, } ss:
District of Indiana, }

I, Noble C. Butler, clerk of the circuit court of the United States within and for the district aforesaid, do hereby certify that the above and foregoing is a full and true copy of the bill of complaint in the cause of Alfred L. Bernardin against William H. Northall *et al.*, filed in my office on the 28th day of May, 1896, as fully as the same remains upon the files now in my office.

Witness my hand and the seal of said court, at Indianapolis, in said district, this 28th day of May, A. D. 1896.

[Seal of the Court.]

NOBLE C. BUTLER, *Clerk.*

EXHIBIT "I."

Filed June 25, 1896.

WASHINGTON, D. C., *June 10th*, 1896.

Hon. Commissioner of Patents.

SIR: Herewith please find draft on New York for twenty ($20) dollars, payable to the order of the Commissioner of Patents, to be applied as the final Government fee upon my application for bottle-sealing devices, filed July 21, 1892—serial No., 470,790—and allowed October 15th, 1892. Said application having been withdrawn
62 from issue for the purpose of an interference with later applications filed by one William Painter and William H. Northall for the same invention, and said interference having been decided by the Commissioner of Patents on March 23rd, 1895, in my favor, and having in all things and in every behalf complied with the requirements of the statute, and your final decision being that I am entitled to have issued to me said letters patent, I herewith hand you the final fee and ask that the patent which you have decided I am entitled to have be issued to me.

Very respectfully,

ALFRED L. BERNARDIN,
By BUTTERWORTH AND DOWELL,
His Attorneys.

EXHIBIT "J."

The within-noted application of Bernardin having been withdrawn from issue for the purpose of interference, and said interference having been decided adversely to Bernardin on appeal to the Court of Appeals of the District of Columbia, the final fee of twenty dollars tendered will not be applied, and the request to issue a patent to Bernardin is denied.

It is true that the decision of the Commissioner was favorable to Bernardin on the question of priority; but said decision having been reversed on appeal to the Court of Appeals of the District of

Columbia and priority decided in favor of Northall, this office is bound by the decision of the court.

S. F. FISHER,
Acting Commissioner.

June 15, 1896.

Memorandum.

Exhibits A, B, C, D, E, F, G, I, and J are certified to as true copies of originals by the acting Commissioner of Patents.

Judgment.

In the Supreme Court of the District of Columbia.

THE UNITED STATES *ex Rel.* ALFRED L. BERNARDIN
v.
JOHN S. SEYMOUR, Commissioner of Patents. } At Law. No. 40029.

This cause coming on to be heard upon the relator's petition for a writ of mandamus against the respondent, and counsel having been heard thereon, it is thereupon, on due consideration thereof, this 1st day of July, 1896, by the court ordered and adjudged that the rule to show cause is hereby discharged and the petition be, and the same is hereby, dismissed at the costs of relator.

Petitioner in this cause having prayed an appeal to the Court of Appeals of the District of Columbia from the judgment of
63 this court dismissing the petition, the same is allowed, and bond is fixed in the penalty of two hundred dollars.

L. E. McCOMAS, *Justice.*

Memorandum.

July 2, 1896—Bond for appeal filed.

In the Supreme Court of the District of Columbia.

THE UNITED STATES *ex Rel.* ALFRED L. BERNARDIN
vs.
JOHN S. SEYMOUR, Commissioner of Patents. } At Law. No. 40029.

The President of the United States to John S. Seymour, Commissioner of Patents, Greeting:

You are hereby cited and admonished to be and appear at a Court of Appeals of the District of Columbia, upon the docketing the cause therein under and as directed by the rules of said court, pursuant to an appeal noted in the supreme court of the District of Columbia on the 1st day of July, 1896, wherein Alfred L. Bernardin, relator, is appellant and you are appellee, to show cause, if any there be, why the judgment rendered against the said appellant should not be corrected and why speedy justice should not be done to the parties in that behalf.

Seal Supreme Court of the District of Columbia.

Witness the Honorable Edward F. Bingham, chief justice of the supreme court of the District of Columbia, this 2d day of July, in the year of our Lord one thousand eight hundred and ninety-six.

JOHN R. YOUNG, *Clerk.*

Service of the above citation accepted this 2 day of July, 1896.

W. A. MEGRATH,
Attorney for Appellee.

S. T. FISHER,
Acting Com'r.

Supreme Court of the District of Columbia.

UNITED STATES OF AMERICA, *District of Columbia*, } *ss:*

I, John R. Young, clerk of the supreme court of the District of Columbia, do hereby certify the foregoing pages, numbered from 1 to 84, inclusive, to be true copies of originals in cause No. 40029, at law, wherein The United States *ex rel.* Alfred L. Bernardin is plaintiff and John S. Seymour, Commissioner of Patents, is defendant, as the same remain upon the files and records of said court.

Seal Supreme Court of the District of Columbia.

In testimony whereof I hereunto subscribe my name and affix the seal of said court, at the city of Washington, in said District, this 14th day of July, A. D. 1896.

JOHN R. YOUNG, *Clerk.*

64 Endorsed on cover: District of Columbia supreme court. No. 603. The United States *ex rel.* Alfred L. Bernardin, appellant, *vs.* John S. Seymour, Commissioner of Patents. Court of Appeals, District of Columbia. Filed Jul- 22, 1896. Robert Willett, clerk.

[Endorsed:] District of Columbia supreme court. No. 682. U. S. *ex rel.* Alfred L. Bernardin *vs.* Benjamin Butterworth, Commissioner of Patents. Court of Appeals, District of Columbia. Filed May 5, 1897. Robert Willett, clerk.

In the Court of Appeals of the District of Columbia.

UNITED STATES *ex Rel.* ALFRED L. BERNARDIN, Appellants, *vs.* BENJAMIN BUTTERWORTH, Commissioner of Patents, Appellee. } No. 682.

Now comes here the appellant and moves the court that the printing of the record in this case be dispensed with, and for cause thereof shows to the court the stipulation this day filed between counsel for the respective parties.

JULIAN C. DOWELL,
Attorney for Appellant.

Endorsed: Court of Appeals, D. C., April term, 1897. No. 682. United States *ex rel.* Alfred L. Bernardin, appellant, *vs.* Benjamin Butterworth, Commissioner of Patents. Motion to dispense with printing. Court of Appeals, District of Columbia. Filed May 7, 1897. Robert Willett, clerk.

In the Court of Appeals of the District of Columbia.

UNITED STATES *ex Rel.* ALFRED L. BERNARDIN. Appellant.
vs.
BENJAMIN BUTTERWORTH, Commissioner of Patents, Appellee.
} No. 682.

It is stipulated and agreed between counsel for the respective parties to the above cause that the petition of the appellant herein is based upon the same state of facts as the petition in the case of The United States *ex rel.* Alfred L. Bernardin *vs.* John S. Seymour, Commissioner of Patents, before the Court of Appeals, October term, 1896, No. 603, which latter case abated by reason of the resignation of John S. Seymour of the office of Commissioner of Patents, and that the issues in this case are the same as the issues in the aforesaid case No. 603, wherein it was adjudged by this court that the judgment of the supreme court dismissing the petition for a
65 writ of mandamus be affirmed. Wherefore it is agreed that with the consent of the court the record herein need not be printed.

JULIAN C. DOWELL,
Attorney for Appellant.
W. A. MEGRATH,
Attorney for Appellee.

Endorsed: Court of Appeals D. C., April term, 1897. No. 682. United States *ex rel.* Alfred L. Bernardin, appellant, *vs.* Benjamin Butterworth, Commissioner of Patents. Stipulation of counsel. Court of Appeals, District of Columbia. Filed May 7, 1897. Robert Willett, clerk.

MONDAY, *May 10th, A. D.* 1897.

UNITED STATES *ex Rel.* ALFRED L. BERNARDIN, Appellant,
vs.
BENJAMIN BUTTERWORTH, Commissioner of Patents.
} No. 682.

On motion of Mr. Julian C. Dowell, of counsel for the appellant, it is ordered by the court that the printing of the record in the above-entitled cause be dispensed with, as per stipulation of counsel. Whereupon this cause was submitted to the consideration of the court on the transcript of record filed herein.

UNITED STATES *ex Rel.* ALFRED L. BERNARDIN, Appellant,
vs.
BENJAMIN BUTTERWORTH, Commissioner of Patents. } No. 682.

Opinion.

The allegations of the petition for the writ of mandamus prayed for in this case to Benjamin Butterworth, Commissioner of Patents, are substantially the same as those contained in the former petition filed by the same plaintiff against John S. Seymour, as Commissioner, and the same may be said of the returns made by each defendant to the writ. There is one error in the petition concerning the ending of the former suit, however, that should be noted. The allegation is that the former suit abated in this court because of the retirement of Commissioner Seymour from the said office and the succession of Commissioner Butterworth. The change in the office did not occur until April 12, 1897, and the judgment in the former case affirmed the judgment appealed from on March 1, and the mandate was issued to the court below on April 10, after a motion for a reargument had been overruled.

The case has been submitted on the argument made in the former case and involves but the one question, namely, the constitutionality of the act of Congress conferring upon this court the
66 jurisdiction to entertain appeals from the decisions of the Commissioner of Patents in certain cases. For the reasons given in the opinion in that case the judgment must be affirmed, with costs; and it is so ordered.

SETH SHEPAPD,
Associate Justice.

TUESDAY, *May 11th, A. D.* 1897.

UNITED STATES *ex Rel.* ALFRED L. BERNARDIN, Appellant,
vs.
BENJAMIN BUTTERWORTH, Commissioner of Patents. } No. 682, April Term, 1897.

Appeal from the supreme court of the District of Columbia.

This cause came on to be heard on the transcript of record from the supreme court of the District of Columbia and was argued by counsel. On consideration whereof, it is now here ordered and adjudged by this court that the judgment of the said supreme court in this cause be, and the same is hereby, affirmed with costs.

Per MR. JUSTICE SHEPARD.

May 11, 1897.

TUESDAY, *May 25th, A. D.* 1897.

UNITED STATES *ex Rel.* ALFRED L. BERNARDIN, Appellant,
vs.
BENJAMIN BUTTERWORTH, Commissioner of Patents. } No. 682.

On motion of Mr. J. C. Dowell, attorney for the appellant in the above-entitled cause, it is ordered by the court that a writ of error to remove said cause to the Supreme Court of the United States be, and the same is hereby, allowed on giving bond in the sum of three hundred dollars.

Know all men by these presents that we, Alfred L. Bernardin, as principal, and Oscar C. Fox, as surety, are held and firmly bound unto Benjamin Butterworth, Commissioner of Patents, in the full and just sum of three hundred dollars, to be paid to the said Benjamin Butterworth, Commissioner of Patents, his certain attorney, executors, administrators, or assigns; to which payment, well and truly to be made, we bind ourselves, our heirs, executors, and administrators, jointly and severally, by these presents.

Sealed with our seals and dated this 28th day of May, in the year of our Lord one thousand eight hundred and ninety-seven.

Whereas lately, at a Court of Appeals of the District of Columbia, in a suit depending in said court between Alfred L. Bernardin and Benjamin Butterworth, a judgment was rendered against the said Alfred L. Bernardin, and the said Alfred L. Bernardin have come into court and prayed that a writ of error to the Supreme Court
67 of the United States be granted him, which was done, having obtained said writ and filed a copy thereof in the clerk's office of the said court to reverse the judgment in the aforesaid suit, and a citation directed to the said Benjamin Butterworth, Commissioner, citing and admonishing him to be and appear at a Supreme Court of the United States to be holden at Washington within 30 days from the date thereof:

Now, the condition of the above obligation is such that if the said Alfred L. Bernardin shall prosecute said writ to effect and answer all damages and costs if he fail to make his plea good, then the above obligation to be void; else to remain in full force and virtue.

ALFRED L. BERNARDIN. [SEAL.]
OSCAR C. FOX. [SEAL.]

Sealed and delivered in the presence of—
ALEXANDER GILCHRIST.
CURRAN A. D. BRUSH.
CHAS. E. RIORDAN.

Bond satisfactory.
W. E. MEGRATH,
Counsel for Com'r of Patents.

Approved by—
R. H. ALVEY, *Ch. Justice.*

STATE OF INDIANA, *Vanderburgh County,* } *ss:*

Before me, a notary public within and for the county and State aforesaid, this day personally came Alfred Bernardin and duly acknowledged the execution of the foregoing bond. Witness my hand and official seal this 28th day May, 1897.

E. M. BINGEL,
Notary Public, V. C.

(Endorsed:) No. 682. U. S. *ex rel.* Alfred L. Bernardin *vs.* Benjamin Butterworth, Commissioner of Patents. Bond on appeal to Supreme Court U. S. Court of Appeals, District of Columbia. Filed Jun- 7, 1897. Robert Willett, clerk.

UNITED STATES OF AMERICA, *ss:*

The President of the United States to the honorable the judges of the Court of Appeals of the District of Columbia, Greeting:

Because in the record and proceedings, as also in the rendition of the judgment of a plea which is in the said Court of Appeals, before you or some of you, between United States *ex rel.* Alfred L. Bernardin, appellant, and Benjamin Butterworth, Commissioner of Patents, appellee, a manifest error hath happened, to the great damage of the said appellant, as by his complaint appears, we, being willing that error, if any hath been, should be duly cor-
68 rected and full and speedy justice done to the parties aforesaid in this behalf, do command you, if judgment be therein given, that then, under your seal, distinctly and openly, you send the record and proceedings aforesaid, with all things concerning the same, to the Supreme Court of the United States, together with this writ, so that you have the same in the said Supreme Court, at Washington, within 30 days from the date hereof, that, the record and proceedings aforesaid being inspected, the said Supreme Court may cause further to be done therein to correct that error what of right and according to the laws and customs of the United States should be done.

Seal Court of Appeals, District of Columbia.

Witness the Honorable Melville W. Fuller, Chief Justice of the United States, the 7th day of June, in the year of our Lord one thousand eight hundred and ninety-seven.

ROBERT WILLETT,
Clerk of the Court of Appeals of the District of Columbia.

UNITED STATES OF AMERICA, *ss:*

To Benjamin Butterworth, Commissioner of Patents, Greeting:

You are hereby cited and admonished to be and appear at a Supreme Court of the United States, at Washington, within 30 days from the date hereof, pursuant to a writ of error filed in the clerk's office of the Court of Appeals of the District of Columbia, wherein

United States *ex rel.* Alfred L. Bernardin is plaintiff in error and you are defendant in error, to show cause, if any there be, why the judgment rendered against the said plaintiff in error, as in the said writ of error mentioned, should not be corrected and why speedy justice should not be done to the parties in that behalf.

Witness the Honorable R. H. Alvey, Chief Justice of the Court of Appeals of the District of Columbia, this 7 day of June, in the year of our Lord one thousand eight hundred and ninety-seven.

R. H. ALVEY,
Chief Justice of the Court of Appeals of the District of Columbia.

Service accepted June 7, 1897.

W. A. MEGRATH,
Counsel for Com. of Patents.

(Endorsed:) Court of Appeals, District of Columbia. Filed Jun-7, 1897. Robert Willett, clerk.

Court of Appeals of the District of Columbia.

I, Robert Willett, clerk of the Court of Appeals of the District of Columbia, do hereby certify that the foregoing is a true and complete transcript of the record and all proceedings in said Court of Appeals in the case of United States *ex rel.* Alfred L. Bernardin, appellant, *vs.* Benjamin Butterworth, Commissioner of Patents,
69 No. 682, April term, 1897, as the same remains upon the files and records of said Court of Appeals.

Seal Court of Appeals, District of Columbia.

In testimony whereof I hereunto subscribe my name and affix the seal of said Court of Appeals, at the city of Washington, this 15th day of June, A. D. 1897.

ROBERT WILLETT,
Clerk of the Court of Appeals of the District of Columbia.

Endorsed on cover: Case No. 16,617. District of Columbia Court of Appeals. Term No., 404. The United States *ex rel.* Alfred L. Bernardin, plaintiff in error, *vs.* Benjamin Butterworth, Commissioner of Patents. Filed June 28th, 1897.

70 Supreme Court of the District of Columbia.

THURSDAY, *April* 28, 1898.

The court resumes its session pursuant to adjournment, McComas, justice.

* * * * * * *

UNITED STATES *ex Rel.* ALFRED BERnardin, Plaintiff, *v.* CHARLES H. DUELL, Commissioner of Patents, Defendant.	At Law.	No. 42089.

This cause coming on to be heard upon the petition of the relator, Alfred L. Bernardin, for a writ of mandamus against the respond-

ent, Chas. H. Duell, Commissioner of Patents, and counsel having been heard thereon, it is thereupon, on due consideration thereof, this 28th day of April, 1898, by the court ordered and adjudged that the rule to show cause is hereby discharged, and the petition be, and the same is hereby, dismissed at the cost of relator.

The petitioner having prayed an appeal to the Court of Appeals from the judgment of this court dismissing the petition, the same is allowed, and bond is fixed in the penalty of two hundred dollars.

In accordance with the consent of counsel, and upon motion of relator's attorney, leave is hereby given the relator to file and use, as a part of the record in this cause, a printed copy of "transcript of record" in the Supreme Court of the United States, October term, 1897, No. 404, *In re* United States *ex rel.* Alfred L. Bernardin *v.* Benjamin Butterworth, Commissioner of Patents, containing a copy of the transcript of record of the case of United States *ex rel.* Alfred L. Bernardin *v.* John S. Seymour, Commissioner of Patents, in the supreme court of the District of Columbia, No. 40029, and of the transcript of record of the case of United States *ex rel.* Alfred L. Bernardin *v.* Benjamin Butterworth, Commissioner of Patents, in the supreme court of the District of Columbia, N-. 40946, and to use the exhibits therein as exhibits in the above-entitled cause, omitting the following portions thereof as being unnecessary repetition of parts of the record of papers filed in this cause, to wit: "Index," on the title and next following page; the "petition for mandamus," pages one to six, inclusive; "Exhibit A," pages seventeen to twenty-two; "Exhibit C," pages thirty-two to thirty-seven; "Exhibit F," page 41, and "Exhibit G," page forty-two.

71

Memorandum.

May 2.—Appeal bond filed.

72 Filed May 14, 1898.

In the Supreme Court of the District of Columbia.

UNITED STATES *ex Rel.* ALFRED L. BERNARDIN *vs.* CHARLES H. DUELL, Commissioner of Patents. } At Law. No. 42089.

Stipulation.

It is hereby stipulated and agreed by and between counsel for the parties that the copy of the decision of the Court of Appeals attached to the petition for mandamus filed herein and marked Exhibit "A" is a true copy of said court's decision on the appeal from the decision of the Commissioner of Patents in interference No. 15992, Northall *vs.* Bernardin, as shown by the records of the court, and that the copy of a letter of the petitioner to Charles H. Duell, Commissioner of Patents, and the copy of a letter from the said Charles H. Duell, Commissioner of Patents, to the petitioner,

also filed with said petition and marked respectively Exhibits "B" and "C," are true copies of said letters, as shown by the records of the Patent Office.

JULIAN C. DOWELL,
Attorney for Alfred L. Bernardin.
W. A. MEGRATH,
Attorney for Commissioner of Patents.

April 25, 1898.

[Endorsed:] Sup. court, District of Col. At law. No. 42089. U. S. *ex rel.* Alfred L. Bernardin *vs.* Charles H. Duell, Commissioner of Patents. Stipulation.

73 Supreme Court of the District of Columbia.

UNITED STATES OF AMERICA, *District of Columbia*, } *ss:*

I, John R. Young, clerk of the supreme court of the District of Columbia, do hereby certify that the foregoing pages numbered from 1 to 72, inclusive, are true *true* copies of originals in cause No. 42089, at law, wherein United States *ex rel.* Alfred L. Bernardin is plaintiff and Charles H. Duell, Commissioner of Patents, is defendant, as the same remains upon the files and records of said court.

Seal Supreme Court of the District of Columbia.

In testimony whereof I hereunto subscribe my name and affix the seal of said court, at the city of Washington, in said District, this 16th day of May, A. D. 1898.

JOHN R. YOUNG, *Clerk.*

73½ [Endorsed:] District of Columbia supreme court. No. 810. United States *ex rel.* Alfred L. Bernardin, appellant, *vs.* Charles H. Duell, Commissioner of Patents. Court of Appeals, District of Columbia. Filed May 20, 1898. Robert Willett, clerk.

74 In the Court of Appeals of the District of Columbia.

UNITED STATES *ex Rel.* ALFRED L. BERNARDIN, Appellant,
vs.
CHARLES H. DUELL, Commissioner of Patents, Appellee.
} No. 810. October Term, 1898.

Now comes here the appellant and moves the court that the printing of the record in this case be dispensed with, and that the cause be submitted without argument, and for cause thereof shows to the court the stipulation this day filed between counsel for the respective parties.

JULIAN C. DOWELL,
Attorney for Appellant.

Sept. 24th, 1898.

(Endorsed:) Court of Appeals, Dist. of Col. U. S. *ex rel.* Alfred L. Bernardin, appellant, *vs.* Charles H. Duell, Commissioner of Patents, appellee. No. 810. October term, 1898. Motion to dispense with printing. Court of Appeals, District of Columbia. Filed Sep. 24, 1898. Robert Willett, clerk.

75 In the Court of Appeals of the District of Columbia.

UNITED STATES *ex Rel.* ALFRED L. BERNARDIN, Appellant, *vs.* CHARLES H. DUELL, Commissioner of Patents, Appellee. } No. 810. October Term, 1898.

It is stipulated and agreed between counsel for the respective parties to the above cause that the petition of the appellant herein is based upon the same state of facts as the petition in the case of the United States *ex rel.* Alfred L. Bernardin *vs.* John S. Seymour, Commissioner of Patents, before the Court of Appeals, October term, 1896, No. 603, which latter case abated by reason of the resignation of John S. Seymour of the office of Commissioner of Patents, (also the case of the United States *ex rel.* Alfred L. Bernardin *vs.* Benjamin Butterworth, Commissioner of Patents, before the Court of Appeals, April term, 1897, No. 682, which latter case, while pending on writ of error to the Supreme Court of the United States, abated by reason of the death of Commissioner Butterworth), and that the issues in this case are the same as the issues in the aforesaid case No. 603, wherein it was adjudged by this court that the judgment of the Supreme Court dismissing the petition for a writ of mandamus be affirmed. Wherefore it is agreed that with the consent of the court the record herein need not be printed.

JULIAN C. DOWELL,
Attorney for Appellant.
W. A. MEGRATH,
Attorney for Appellee.

Sept. 24, 1898.

(Endorsed:) Court of Appeals, Dist. of Col. U. S. *ex rel.* Alfred L. Bernardin, appellant, *vs.* Charles H. Duell, Commissioner of Patents, appellee. No. 810. October term, 1898. Stipulation of counsel. Court of Appeals, District of Columbia. Filed Sep. 24, 1898. Robert Willett, clerk.

76 MONDAY, *October* 3*d*, *A. D.* 1898.

UNITED STATES *ex Rel.* ALFRED L. BERNARDIN, Appellant, *vs.* CHARLES H. DUELL, Commissioner of Patents. } No. 810.

On motion of Mr. Julian C. Dowell, of counsel for the appellant, it is ordered by the court that the printing of the record in the

above-entitled cause be dispensed with; whereupon this cause was submitted to the consideration of the court on the transcript of record filed herein.

77 UNITED STATES *ex Rel.* ALFRED L. BERNARDIN, Appellant, *vs.* CHARLES H. DUELL, Commissioner of Patents. } No. 810.

(Mr. Justice SHEPARD delivered the opinion of the court.)

In consideration of the peculiar circumstances of this case, the motion for leave to submit without first printing the record has been granted.

The sole question raised by the record is the constitutionality of the act of Congress conferring jurisdiction upon the Court of Appeals of the District of Columbia of appeals from the decisions of the Commissioner of Patents in interference cases.

This court having reversed a decision of Commissioner Seymour in such a case, the appellee therein demanded execution of the Commissioner's decision in his favor, notwithstanding that reversal, upon the contention that the court had no jurisdiction in the premises. Compliance having been refused by the Commissioner, a petition for mandamus was filed against him in the supreme court of the District of Columbia. That court dismissed the petition and its judgment was affirmed upon appeal to this court on March 1, 1897. U. S. *ex rel.* Bernardin *v.* Seymour, 10 App. D. C., 294.

Before a writ of error could be sued out from the Supreme Court of the United States the term of Commissioner Seymour expired, and the appellant began action anew against his successor, Hon. Benjamin Butterworth. His petition was again dismissed by the supreme court of the District and that dismissal was likewise affirmed upon the grounds stated in the decision of the former appeal. 11 App. Cas. D. C., 91.

The appellant then took the case by writ of error to the Supreme Court of the United States, but before it could be determined therein Commissioner Butterworth died. Plaintiff in error then
78 moved that court for leave to substitute for Commissioner Butterworth, deceased, his successor, Commissioner Duell, in order that the cause might not abate. This motion was denied and for want of a party the court ordered that the judgment of the Court of Appeals be reversed and the cause remanded, with direction to reverse the judgment of the supreme court of the District of Columbia and remand the cause to that court, with direction to dismiss the petition because of the death of Commissioner Butterworth. Bernardin *v.* Butterworth, 169 U. S., 600, 606.

The present suit is a renewal of the same cause of action by original petition against Commissioner Duell. The only change made in the petition, as originally filed, is the substitution of the name of Commissioner Duell as defendant, instead of Commissioner Seymour,, with the necessary statement of the intervening history of the succession in the office of Commissioner of Patents.

For the reasons given at length in the opinion delivered in Bernardin *v.* Seymour (10 App. Cas. D. C., 294) the judgment dismissing the petition must be affirmed with costs; and it is so ordered.

SETH SHEPARD,
Associate Justice.

79 FRIDAY, *October 7th, A. D.* 1898.

UNITED STATES *ex Rel.* ALFRED L. BERNARDIN, Appellant, *vs.* CHARLES H. DUELL, Commissioner of Patents. } No. 810, October Term, 1898.

Appeal from the supreme court of the District of Columbia.

This cause came on to be heard on the transcript of record from the supreme court of the District of Columbia, and was argued by counsel. On consideration whereof it is nor here ordered and adjudged by this court that the judgment of the said supreme court in this cause be, and the same is hereby, affirmed with costs.

Per MR. JUSTICE SHEPARD.

OCTOBER 7, 1898.

UNITED STATES *ex Rel.* ALFRED L. BERNARDIN, Appellant, *vs.* CHARLES H. DUELL, Commissioner of Patents. } No. 810.

On motion of Mr. Julian C. Dowell, attorney for the appellant in the above-entitled cause, it is ordered by the court that a writ of error to remove said cause to the Supreme Court of the United States be, and the same is hereby, allowed on giving bond in the sum of three hundred dollars.

80 UNITED STATES OF AMERICA, *ss:*

The President of the United States to the honorable the judges of the Court of Appeals of the District of Columbia, Greeting:

Because in the record and proceedings, as also in the rendition of the judgment of a plea which is in the said Court of Appeals, before you or some of you, between United States *ex rel.* Alfred L. Bernardin, appellant, and Charles H. Duell, Commissioner of Patents, appellee, a manifest error hath happened, to the great damage of the said appellant, as by his complaint appears, we, being willing that error, if any hath been, should be duly corrected and full and speedy justice done to the parties aforesaid in this behalf, do command you, if judgment be therein given, that then, under your seal, distinctly and openly, you send the record and proceedings aforesaid, with all things concerning the same, to the Supreme Court of the United States, together with this writ, so that you have the same in the said Supreme Court, at Washington, within 30 days from the date hereof, that, the record and proceedings aforesaid being inspected, the said Supreme Court may cause further to be done therein to

correct that error what of right and according to the laws and customs of the United States should be done.

Witness the Honorable Melville W. Fuller, Chief Justice of the United States, the 7th day of October, in the year of our Lord one thousand eight hundred and ninety-eight.

Seal Court of Appeals, District of Columbia.

ROBERT WILLETT,
Clerk of the Court of Appeals of the District of Columbia.

81 Know all men by these presents that we, Alfred L. Bernardin, as principal, and Oscar C. Fox, as surety, are held and firmly bound unto Charles H. Duell, Commissioner of Patents, in the full and just sum of three hundred dollars to be paid to the said Charles H. Duell, Commissioner of Patents, his certain attorney, executors, administrators, or assigns; to which payment, well and truly to be made, we bind ourselves, our heirs, executors, and administrators, jointly and severally, by these ptesents.

Sealed with our seals and dated this 7th day of October, in the year of our Lord eighteen hundred and ninety-eight.

Whereas lately, at the Court of Appeals in the District of Columbia, in a suit depending in said court between Alfred L. Bernardin and Charles H. Duell, Commissioner of Patents, a judgment was rendered against the said Alfred L. Bernardin, and the said Alfred L. Bernardin has come into court and prayed that a writ of error to remove said cause to the Supreme Court of the United States be granted him, which prayer was granted, having obtained said writ and filed a copy thereof in the clerk's office of the said court to reverse the judgment in the aforesaid suit, and a citation directed to the said Charles H. Duell, Commissioner of Patents, citing and admonishing him to be and appear at the Supreme Court of the United States, to be holden at Washington, within 30 days from the date thereof:

Now, the condition of this bond is such that if the said Alfred L. Bernardin shall prosecute said writ to effect and answer all damages and costs if he fail to make his plea good, then the above obligation is to be void; else to remain in full force and virtue.

ALFRED L. BERNARDIN. [SEAL.]
OSCAR C. FOX. [SEAL.]

Signed, sealed, and delivered in the presence of—
CHARLES E. RIORDON.

Bond satisfactory.

W. A. MEGRATH,
Counsel for Commissioner of Patents.

Approved by—
R. H. ALVEY,
Chief Justice.

81½ (Endorsed:) Court of Appeals, Dist. of Col. United States *ex rel.* Alfred L. Bernardin *v.* Charles H. Duell, Commissioner of Patents. No. 810. Bond on writ of error. Sup. ct. U. S. Court of Appeals, District of Columbia. Filed Oct. 14, 1898. Robert Willett, clerk.

82 UNITED STATES OF AMERICA, *ss:*

To Charles H. Duell, Commissioner of Patents, Greeting:

You are hereby cited and admonished to be and appear at a Supreme Court of the United States, at Washington, within 30 days from the date hereof, pursuant to a writ of error, filed in the clerk's office of the court of Appeals of the District of Columbia, wherein The United States *ex Rel.* Alfred L. Bernardin is plaintiff in error and you are defendant in error, to show cause, if any there be, why the judgment rendered against the said plaintiff in error, as in the said writ of error mentioned, should not be corrected and why speedy justice should not be done to the parties in that behalf.

Witness the Honorable Richard H. Alvey, chief justice of the Court of Appeals of the District of Columbia, this 14th day of October, in the year of our Lord one thousand eight hundred and ninety-eight.

R. H. ALVEY,
Chief Justice of the Court of Appeals of the District of Columbia.

Service accepted Octo. 14, 1898.

W. A. MEGRATH,
For C. H. DUELL,
Commissioner of Patents.

[Endorsed:] Court of Appeals, District of Columbia. Filed Oct. 14, 1898. Robert Willett, clerk.

83 Court of Appeals of the District of Columbia.

I, Robert Willett, clerk of the Court of Appeals of the District of Columbia, do hereby certify that the foregoing is a true and complete transcript of the record and all proceedings in said Court of Appeals in the case of The United States *ex rel.* Alfred L. Bernardin, appellant, *vs.* Charles H. Duell, Commissioner of Patents, No. 810, October term, 1898, as the same remains upon the files and records of said Court of Appeals.

Seal Court of Appeals, District of Columbia.

In testimony whereof I hereunto subscribe my name and affix the seal of said Court of Appeals, at the city of Washington, this 14th day of October, A. D. 1898.

ROBERT WILLETT,
Clerk of the Court of Appeals of the District of Columbia.

No. 444.

Motion Papers for U. S.

IN THE SUPREME COURT OF THE UNITED STATES.

Filed Oct. 24, 1898.

THE UNITED STATES *ex Rel.* ALFRED L. BERNARDIN, *Plaintiff in Error*, *vs.* CHARLES H. DUELL, Commissioner of Patents.

October Term, 1898. No. 444.

MOTION TO ADVANCE HEARING.

And now comes Alfred L. Bernardin, plaintiff in error, by his attorney, Julian C. Dowell, this 24th day of October, 1898, and moves that an order be made advancing the above-entitled cause on the calendar, and assigning the same for hearing at an early date, to be fixed by the Court.

THE QUESTION INVOLVED.

This case presents the question of the constitutionality of the Act of Congress approved February 9, 1893, conferring jurisdiction upon the Court of Appeals of the District of Columbia to entertain and determine appeals from the decision of the Commissioner of Patents in interference cases. Prior to said Act of Congress, establishing a Court of Appeals for the District of Columbia, no provision was made for appeals from decisions of the Commissioner of Patents in *interference cases*. Section 9 of that Act provided that the determination of appeals from the decision of the Commissioner of Patents, then vested in the general term of the Supreme Court of the District of Columbia, in pursuance of the provisions of the Revised Statutes of the

United States, relating to the District of Columbia, should thereafter be vested in the Court of Appeals created by said act;

> "and, in addition, any party aggrieved by a decision of the Commissioner of Patents in any interference case may appeal therefrom to said Court of Appeals."

The present case grows out of an interference in the Patent Office, under the provisions of Section 4904 of the Revised Statutes, between Alfred L. Bernardin, president and superintendent of the Bernardin Bottle Cap Company, of Evansville, Indiana, and William H. Northall, an employee of the Bernardin Company, acting in the interest of the Crown, Cork and Seal Company, a corporation of Baltimore, Md.; the subject of the controversy being a bottle-sealing device.

The Commissioner of Patents, Hon. John S. Seymour, decided that Bernardin was the prior inventor and entitled to the patent, but on appeal to the Court of Appeals of the District of Columbia the decision of the Commissioner of Patents was reversed, whereupon mandamus proceedings were instituted in the Supreme Court of the District of Columbia to compel the issue of a patent to Bernardin in accordance with the Commissioner's decision, on the ground that "notwithstanding the Act of Congress, approved February the 9th, 1893, *in form* confers jurisdiction upon the Court of Appeals of the District of Columbia, to hear an appeal on error prosecuted from the action of the Commissioner of Patents, an officer of the executive department of the Government, and to review the official action of said officer of the executive department, and to revise and reverse or nullify said action, said statute is, to the extent that it attempts to confer jurisdiction upon the Court of Appeals of the District of Columbia to review, reverse, or nullify the action of

the executive branch of the Government, unconstitutional, inoperative, and void, and that the said decision rendered and certified in that behalf is *coram non judice* for want of constitutional authority to entertain, hear, and control by judicial action the official acts of the executive department." (Transcript, p. 6.)

The petition for mandamus was dismissed by the Supreme Court of the District of Columbia, and the judgment of the lower court was affirmed upon appeal to the Court of Appeals of the District of Columbia, in a decision rendered March 1, 1897. (U. S. *ex rel.* Bernardin *vs.* Seymour, 10 App. D. C., 294). In the concluding clause of its aforesaid decision the Court of Appeals said:

> "Without further prolonging the discussion of this interesting question, and admitting that we are not without doubt in respect of the soundness of our judgment, we repeat that we have not been able to see our way to the conclusion urged upon us—namely—that the act conferring the right of appeal to this court from the decisions of the Commissioner of Patents is beyond the power of Congress to enact, for the reason that it oversteps the boundaries erected by the Constitution between the three great departments of the Government."

Reasons in Support of Motion.

This case presents the same questions and is based upon the same state of facts as the case of the United States *ex rel.* Alfred L. Bernardin *vs.* Benjamin Butterworth, Commissioner of Patents, pending before this Honorable Court at the October term, 1897, No. 404, and which abated by reason of the death of the defendant in error, the Honorable Benjamin Butterworth, Commissioner of Patents. (Bernardin *vs.* Butterworth, 169 U. S., 600.) A previous case, involving the same question and based upon the same state of facts also abated while pending

before the Court of Appeals of the District of Columbia, by reason of the resignation of Mr. Commissioner Seymour. (Transcript, p. 60.)

Should a vacancy again occur in the office of Commissioner of Patents, while this case remains pending and undetermined, the action would again abate, to the cost and injury of the plaintiff in error, who has already paid costs three times, in his endeavor to have the question presented finally determined by this Honorable Court, and thus the final determination of the important question involved might be indefinitely deferred.

I am authorized by the Honorable the Solicitor General to state that the Government joins in the request that the hearing of the case be advanced.

Respectfully submitted,

JULIAN C. DOWELL,

Of Counsel for Bernardin.

No. 444.

Brf. of Dowell & Hazelton for P.

In the Supreme Court of the United States.

Filed Nov. 21, 1898.

THE UNITED STATES *ex rel.* ALFRED L. BERNARDIN, *Plaintiff in Error,*

vs.

CHARLES H. DUELL, Commissioner of Patents.

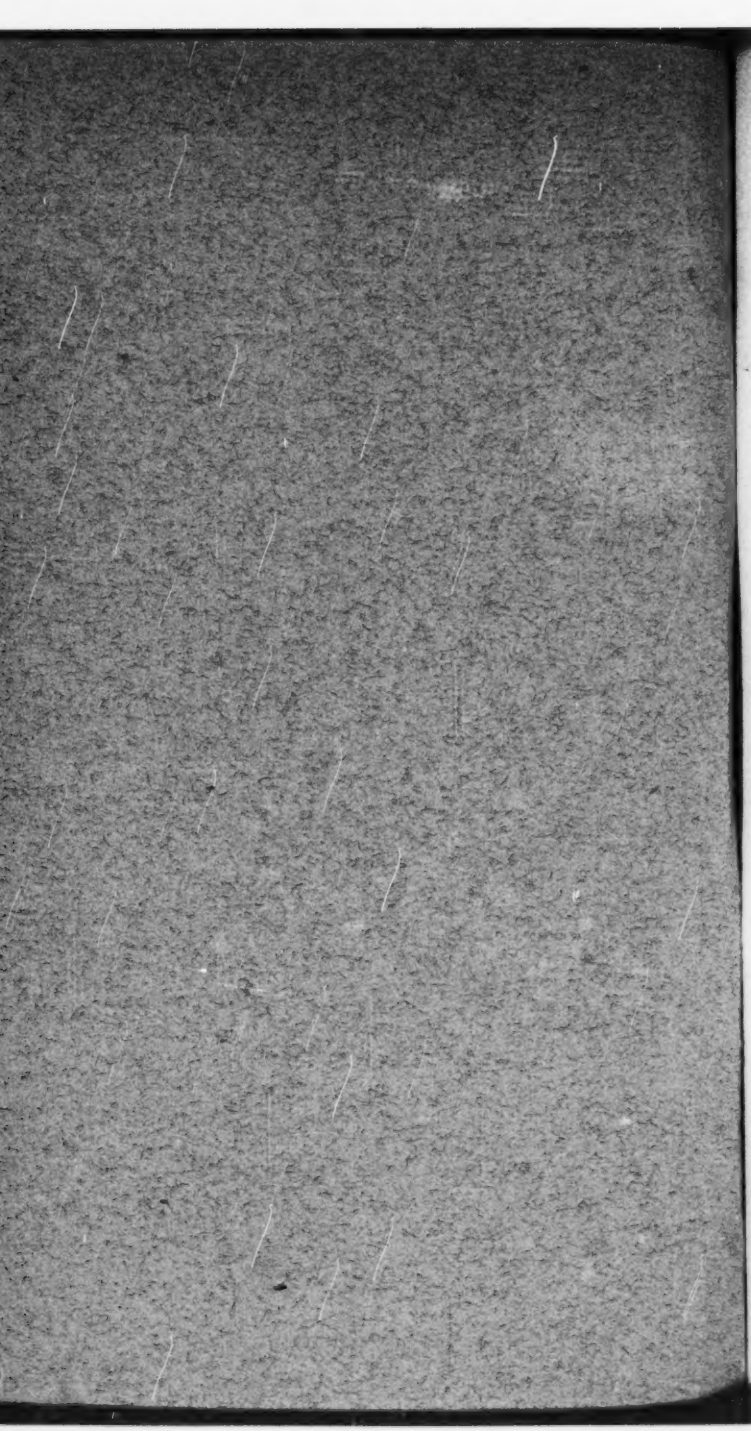
October Term, 1898.
No. 444.

IN ERROR TO THE COURT OF APPEALS OF THE DISTRICT OF COLUMBIA.

BRIEF FOR PLAINTIFF IN ERROR.

JULIAN C. DOWELL,
GEORGE C. HAZELTON,
Attorneys.

BYRON S. ADAMS, PRINTER.



In the Supreme Court of the United States.

THE UNITED STATES *ex rel.* ALFRED L. BERNARDIN, *Plaintiff in Error,*

vs.

CHARLES H. DUELL, Commissioner of Patents.

October Term, 1898.
No. 444.

STATEMENT OF THE CASE.

The case at bar grows out of an interference proceeding in the Patent Office (under the provisions of Section 4904 of the Revised Statutes) between Alfred L. Bernardin, president and superintendent of the Bernardin Bottle Cap Company, of Evansville, Indiana; William H. Northall, an employee of the Bernardin Company, acting in the interest of the Crown Cork and Seal Company, a corporation of Baltimore, Md., and William Painter, secretary of the latter company; the subject of the controversy being a bottle-sealing device. (Transcript, p. 30.)

The Commissioner of Patents, the Hon. John S. Seymour, decided in favor of Bernardin. (Transcript, pp. 15 and 30–35.) Northall took an appeal to the Court of Appeals of the District of Columbia, under the provisions of Section 9 of the "Act to establish a Court of Appeals for the District of Columbia, and for other purposes," approved

February 9, 1893, and a decision was rendered by that court reversing the decision of the Commissioner. (Transcript, pp. 7, 35 and 37.)

Bernardin being advised that the Court of Appeals had not and could not be clothed with jurisdiction to review on error or appeal the acts of the Commissioner of Patents, he applied to the Commissioner to have him issue the patent to him, said Bernardin, in accordance with his (the Commissioner's) decision, and tendered the final fee, and in all things fully complied with the law in that behalf (Transcript, p. 29), and being refused on the ground that the action of the Court of Appeals was binding on the Commissioner, the relator filed a petition in the Supreme Court of the District of Columbia for a peremptory writ of mandamus, directing the Commissioner of Patents to issue a patent to Bernardin in accordance with his own finding and award, notwithstanding the decision of the Court of Appeals rendered in the appeal from the Commissioner's award. (Transcript, p. 23).

The petition was filed upon the ground that the Court of Appeals was without jurisdiction to entertain the appeal from the Commissioner of Patents. (*Ibid.*, p. 26.)

On the hearing of the appeal in the Interference case from the Commissioner of Patents to the Court the question of the constitutionality of the statute authorizing such appeal was not raised or considered. The question is now presented for the first time.

An alternative writ was issued by the lower court and the answer of the respondent, the Commisssoner of Patents, sets forth the facts as they are recited in the petition, but more in detail, so the constitutional question could be squarely raised. (*Ibid.*, p. 28).

The cause coming on to be heard before His Honor, Judge McComas, he denied the petition, and the relator appealed to the Court of Appeals from that decision.

The Court of Appeals, in affirming the judgment of the lower court, said :

"The question, as presented, is one of importance and its rightful determination is a matter of grave doubt. If resolved against the exercise of the jurisdiction there will doubtless be some embarrassing, if not injurious, consequences; for it has been constantly exercised by the courts of this District since the year 1839, and, of late years especially, many decisions of the courts, upon appeal from the Commissioner of Patents, have been carried into effect and accepted as conclusive and final. **Notwithstanding the grave doubt that we entertain of the soundness of our judgment, we are not convinced that it is our duty to declare against the validity of the statute conferring the jurisdiction."** (U. S. *ex rel.* Bernardin *vs.* Seymour, 10 App. Cas. D. C., 294.)

Before a writ of error could be sued out from the Supreme Court of the United States, Mr. Commissioner Seymour resigned and his term of office expired, so that Bernardin began action anew against his successor, the Hon. Benjamin Butterworth. This latter case was pending before this honorable Court at the October Term, 1897 (No. 404), but abated before a hearing could be had, by reason of the death of the defendant in error. (Bernardin *vs.* Butterworth, 169 U. S., 600.) Bernardin then renewed the action against the successor of Commissioner Butterworth, the Hon. Charles H. Duell, Commissioner of Patents; the petition being based upon the same ground as the case of Bernardin *vs.* Seymour, to wit, "that notwithstanding the Act of Congress, approved February the 9th, 1893, *in form* confers jurisdiction upon the Court of Appeals of the District of Columbia to hear an appeal on error prosecuted from the action of the Commissioner of Patents, an officer of the Executive Department of the Government, and to review the official action of said officer of the Executive Department, and to revise and re-

verse or nullify said action, said Statute is, to the extent that it attempts to confer jurisdiction upon the Court of Appeals of the District of Columbia to review, reverse, or nullify the action of the executive branch of the Government, *unconstitutional*, *inoperative*, and *void*, and that the said decision rendered and certified in that behalf is *coram non judice*, for want of constitutional authority to entertain, hear, and control by judicial action the official acts of the executive department." (Transcript, pp. 1–6.)

The present case presents the same questions and is based upon the same state of facts as the aforesaid cases of Bernardin *vs.* Seymour and Bernardin *vs.* Butterworth, and by stipulation of counsel parts of the transcript of record in the last-mentioned case have been filed and used as a part of the record in this case. (Transcript, p. 15.)

In the renewed action the case has taken the same course before the Supreme Court of the District of Columbia and the Court of Appeals, as the preceding cases, the latter court having rendered a decision at the October Term, 1898, affirming the judgment of the court below, for the reasons given at length in the opinion of that court delivered in the case of Bernardin *vs.* Seymour, *supra*. (Transcript, p. 60.)

ASSIGNMENT OF ERRORS.

First. The court erred in holding that the Act of Congress conferring the right of appeal to said court, to wit, the Court of Appeals of the District of Columbia, from the decisions of the Commissioner of Patents, an officer of the executive department of the Government, is constitutional.

Second. The court erred in holding that the Act of Congress conferring the right of appeal to said court from the decisions of the Commissioner of Patents, an officer of the

executive department of the Government, does not overstep the boundaries erected by the Constitution between the three great departments of the Government.

Third. The court erred in holding that it has jurisdiction to hear and determine an appeal prosecuted from the action of the Commissioner of Patents, an officer of the executive department of the Government, and to review the official action of said officer of the executive department and to revise or reverse or nullify such action.

Fourth. The court erred in holding that the Act of Congress, approved February 9, 1893, conferring jurisdiction upon the Court of Appeals of the District of Columbia, to hear an appeal in an interference case, prosecuted from the action of the Commissioner of Patents, an officer of the executive department of the Government, and to review the official action of said officer of the executive department, and to revise and reverse or nullify said action, is constitutional.

Fifth. The court erred in holding that it has jurisdiction to entertain appeals from the decisions of an officer of an executive department of the Government, acting within the scope of his departmental jurisdiction, and to revise, modify or annul and practically and in effect review on petition in error on the record the official acts of such officer.

Sixth. The court erred in affirming the judgment of the Supreme Court of the District of Columbia dismissing the petition for a writ of mandamus.

Wherefore, the plaintiff in error, Alfred L. Bernardin, prays that the judgment of the Court of Appeals of the District of Columbia be reversed by this honorable Court, and that the said Court of Appeals be directed by the mandate

of this Court to enter a decree reversing the judgment of the Supreme Court of the District of Columbia and directing that court to issue the writ of mandamus in accordance with the petition.

The main question raised by the record of the case is the constitutionality of the Act of Congress, conferring jurisdiction upon the Court of Appeals of the District of Columbia to entertain and determine appeals from the decisions of the Commissioner of Patents in interference cases. Prior to the Act of Congress, approved February 9, 1893, establishing a Court of Appeals for the District of Columbia, no appeal was allowed from a decision of the Commissioner of Patents in an *interference case.* Section 9 of said Act provides as follows:

"Sec. 9. That the determination of appeals from the decision of the Commissioner of Patents, now vested in the general term of the Supreme Court of the District of Columbia, in pursuance of the provisions of section seven hundred and eighty of the Revised Statutes of the United States, relating to the District of Columbia, shall hereafter be, and the same is hereby, vested in the Court of Appeals created by this act; and, in addition, any party aggrieved by a decision of the Commissioner of Patents in any interference case may appeal therefrom to said Court of Appeals."

The Statutes Conferring the Right of Appeal to the Court.

The sections of the Revised Statutes conferring this jurisdiction upon the Supreme Court of the District of Columbia, *sitting in banc,* were part of the general act regarding the organization of the Patent Office, passed in 1870, and read as follows:

"Sec. 4911. If such party, except a party to an Interference, is dissatisfied with the decision of the Commissioner, he

may appeal to the Supreme Court of the District of Columbia, sitting in banc.

"Sec. 4912. When an appeal is taken to the Supreme Court of the District of Columbia, the appellant shall give notice thereof to the Commissioner, and file in the Patent Office, within such time as the Commissioner shall appoint, his reasons of appeal, specifically set forth in writing.

"Sec. 4913. The court shall, before hearing such appeal, give notice to the Commissioner of the time and place of the hearing, and on receiving such notice the Commissioner shall give notice of such time and place in such manner as the court may prescribe, to all parties who appear to be interested therein. The party appealing shall lay before the court certified copies of all the original papers and evidence in the case, and the Commissioner shall furnish the court with the grounds of his decision, fully set forth in writing, touching all the points involved by the reasons of appeal. And at the request of any party interested, or of the court, the Commissioner and the examiners may be examined under oath, in explanation of the principles of the thing for which a patent is demanded.

"Sec. 4914. The court, on petition, shall hear and determine such appeal, and revise the decision appealed from in a summary way, on the evidence produced before the Commissioner, at such early and convenient time as the court may appoint; and the revision shall be confined to the points set forth in the reasons of appeal. After hearing the case the court shall return to the Commissioner a certificate of its proceedings and decision, which shall be entered of record in the Patent Office, and shall govern the further proceedings in the case. But no opinion or decision of the court in any such case shall preclude any person interested from the right to contest the validity of such patent in any court wherein the same may be called in question.

"Sec. 4915. Whenever a patent on application is refused, either by the Commissioner of Patents or by the Supreme Court of the District of Columbia upon appeal from the

Commissioner, the applicant may have remedy by bill in equity; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim, or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the Commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication, and otherwise complying with the requirements of law. In all cases, where there is no opposing party, a copy of the bill shall be served on the Commissioner; and all the expenses of the proceeding shall be paid by the applicant, whether the final decision is in his favor or not."

* * * * * * *

"Sec. 780. The Supreme Court, sitting in banc, shall have jurisdiction of and shall hear and determine all appeals from the decisions of the Commissioner of Patents, in accordance with the provisions of section forty-nine hundred and eleven to section forty-nine hundred and fifteen, inclusive, of chapter one, Title LX, of the Revised Statutes, 'Patents, Trademarks, and Copyrights.'"

It appears from these sections that the jurisdiction now exercised by the Court of Appeals is the same as that formerly exercised by the Supreme Court of the District of Columbia, sitting in banc, except that the Act creating the Court of Appeals provides for an appeal in the case of *Interferences*, which did not exist before the passage of that Act.

The language of section 9, Court of Appeals Act, is that "the determination of appeals from the decision of the Commissioner of Patents *now vested* in the Supreme Court of the District of Columbia, shall be * * * vested in the Court of Appeals."

When, in 1893, the general term of the Supreme Court of the District of Columbia was abolished, and the Court of

Appeals established in its place, the jurisdiction formerly vested in the general term over appeals from the Commissioner of Patents was transferred to the Court of Appeals Interference cases were added to the appealable cases by a special clause in section 9.

THE QUESTION.

The question presented here is, will an appeal lie from the Commissioner of Patents to the Court of Appeals in an Interference case to determine the question of priority of invention?

The question is broader than that. It goes to the constitutionality of an Act of Congress providing for an appeal from the Executive Department of the Government to the Judicial; clothing the latter with plenary power on such appeals to review on petition in error the acts of the officials of the Executive Department, and annul them, and compel the official of the Executive Department to obey the direction of the court in that behalf.

The question is raised for the first time in the case at bar, in what is known in the Patent Office as an Interference case.

The patent law provides for Interference proceedings in the Bureau of Patents to determine which of two or more applicants for letters patent is the *first inventor*, and to issue letters patent to such applicant.

The proceeding is instituted in the Patent Office by the Primary Examiner, who declares an Interference, in case two or more parties claim the same invention, and the case is referred to an officer of the Bureau, designated as Examiner of Interferences.

That officer hears the evidence, which is always in the form of depositions, and renders a decision, called an award.

From that decision or award there is an appeal to the

Examiners-in-Chief, and from them to the Commissioner of Patents. The statute in question also provides for an appeal from the Commissioner of Patents to the Court of Appeals of the District of Columbia.

The record of the case is filed with the clerk of the court by the appellant, and the opposing parties are heard on that record.

The statute provides that the only evidence that shall be considered is that which was before the Commissioner of Patents, and that the court shall revise the decision "on the evidence produced before the Commissioner," and that "the revision shall be confined to the points set forth in the reasons of appeal;" in other words, the assignments of error, which must be set forth in the petition filed with the court, and none other.

So the proceeding is in fact and to all intents and purposes a review on petition in error of the finding and decision of the Cemmissioner of Patents by the Court of Appeals of the District of Columbia.

The proceeding is in no sense one known to the common law, or to any custom or usage which forms a part of our judicial system.

It is a statutory proceeding by which a court of the Judicial Department of the Government sits in judgment to review, revise, reverse or in their discretion nullify, the official acts of the Executive Department, and by the judgment of the reviewing court dominate and control the official action of the Executive Department in the behalf under consideration.

Is this a defensible exercise of jurisdiction by the Court of Appeals? If so, what is the limit to the authority that

may be conferred on the courts to review and annul the acts of the other Departments of the Government? If there is a limit, where is it?

It cannot be successfully contended that the Bureau of Patents, or the Commissioner of that Bureau, forms a part of the Judicial Department of the Government.

Nor can be it successfully contended that the proceeding authorized by the statute is in any sense an appeal from a court of inferior to a court of superior jurisdiction.

Nor will it be successfully urged that the fact that the question determined by the Commissioner of Patents involved the necessity of *hearing evidence and considering the law in deciding the case*, can perforce of that fact confer or tend to confer jurisdiction upon the courts to review that action on error. See *in re* Pacific R. Commission, 32 Fed. Rep., 242, cited hereinafter.

The Patent Office and the Officers of that Bureau are part of the Executive Department.

Possibly the issuance of patents might have been devolved upon any Department of the Government, and the Department clothed with jurisdiction in the premises would exercise that jurisdiction to the exclusion of any supervision by other Departments. But no duty not judicial can be imposed upon the Courts of the United States.

While jurisdiction may be determined by the duties imposed, as in the case of a proceeding against a person for murder; to accuse, try, pronounce sentence and execute the same is in character and quality a judicial proceeding; yet it by no means follows that the fact that *duties* are imposed by an Act of Congress upon the court, that such duties are, perforce of the Act itself, judicial. See *in re* Pacific R. Com., 32 Fed. Rep., 242.

And it is submitted that because jurisdiction of patent matters might have been conferred upon any one of the Departments of Government, possibly including the Judicial—though issuing a patent is an administrative act—it does not follow that Congress, after conferring jurisdiction upon *one Department*, may give to another Department supervisory jurisdiction over the acts of the Department upon which jurisdiction has been first conferred, so as to enable the former to annul, reverse, or modify the official acts of the latter.

If Congress could so confuse and confound the jurisdiction of the several Departments the independence of each might be wholly dominated by the others, or two by the third.

But the theory and practice of our governmental system was and is to keep and maintain the several Departments of the Government, *i. e.*, the Legislative, Executive, and Judicial, separate, co-equal and independent, each sovereign in its own sphere.

In the case under consideration the Executive Department, by its proper officer in the discharge of the duties cast upon him as an officer of said Department, took certain action. That is to say, the Commissioner of Patents, in the discharge of the duty cast upon him by the law, made suitable and proper investigation to determine who was entitled to have issued to him letters patent for an invention.

He read the evidence and made his award, and thereupon the party against whom the decision or award was rendered proceeded under the statute to prosecute an appeal to the Court of Appeals, as before stated, taking up the record—that is, the evidence introduced before and heard by the Commissioner. The Court reversed the decision of the Commissioner, awarded priority to the appellant, and a certificate under the seal of the Court was forwarded to the Com-

missioner, and it is urged that that decision is binding on the appellee, although it is obvious that the action of the Court, if controlling, ousts the Commissioner of Patents from the exercise of the jurisdiction cast upon him by the statute, and nullifies the law enacted to secure letters patent to those who may, in the judgment of the Commissioner of Patents, be entitled to receive them.

We may remark that in dicta of Mr. Justice Matthews, in the case of Hoe *vs.* Butterworth, Commissioner, hereinafter cited, this jurisdiction is referred to as being *in aid of* the administration of the Patent Office.

But that which controls absolutely and is supreme to order and direct can hardly be properly described as "*in aid of.*" And it is expressly decided in the cases of *in re* Pac. Ry. Comr., 32 Fed Rep., 242, that the courts of the United States will not act in aid of Executive Departments.

Obviously it is not the name of the proceeding, but the quality of the act done in the exercise of the jurisdiction, that will determine its limitation.

This is expressly held in U. S. *vs.* Ritchie, 17 How., page 525.

To call the proceeding one *in aid of* the Executive Department is in fact determining the quality of the act by the name applied to the act, and not by the effect and result of the act.

The consideration of the question we are discussing starts with the fundamental proposition that the three branches of the Government are equal, co-ordinate and independent, and that the maintenance of that equality and separate independence is of the highest concern to the Republic and to the people. And it must follow that one of the most important inquiries is, Does the jurisdiction exercised by the court in the behalf in question militate against that equality and independence? If it does, can it none the less be sustained? If yea, on what ground?

The point we make is:

That the Departments of the Government are co-equal, co-ordinate and independent.

It is the spirit and theory of our Government to keep and maintain them so. And this can only be done by keeping each within its own domain.

But obviously this cannot be so, if the acts of either are subject to review on appeal, and may be annulled by the reviewing authority.

Touching the spirit of the organic law which finds expression in the division of the Government into three co-equal and independent branches, it has been said the idea or policy is as old as Aristotle, who said in discussing the constitution of a State, there are three divisions, the deliberative—in other words, the legislative assembly; the magistracy, and the judiciary, and this disposition or repository of the powers of the Government was, at that early day, deemed essential to civil liberty.

The relation of the Departments to each other have been considered in several cases.

In the Sinking Fund cases, reported in 99 U. S., 718, Justice Waite said:

"One Department of the Government cannot encroach on the domain of another without danger. The safety of our institutions depends in no small degree on the strict observance of this salutary rule."

Sutherland, in his work on Statutory Construction, p. 1, puts the case quite as strong.

He says:

"In the Federal Constitution and in the State Constitutions the three fundamental powers—the legislative, executive and judicial—have been separated, organized in three

distinct departments. This separation is deemed to be of greatest importance, absolutely essential to the existence of a just and free government."

Other cases on this point will be cited later in this brief.

The law—the fundamental law—is emphasized in some of the States by the express language of the Constitution.

The Bill of Rights of New Hampshire, Part I, Article 37, reads as follows:

"In the government of this State the three essential powers thereof, to wit, the legislative, executive and judicial, ought to be kept as separate from and independent of each other as the nature of a free government will admit, or as is consistent with that chain of connection that binds the whole fabric of the Constitution in one indissoluble bond of union and amity."

The Constitution of Massachusetts of 1780, Part I, says:

"Art. XXX. In the government of this Commonwealth the legislative department shall never exercise the executive and judicial powers, or either of them; the executive shall never exercise the legislative and judicial powers, or either of them; the judicial shall never exercise the legislative and executive powers, or either of them; to the end it may be a government of laws and not of men."

The Constitution of Maryland as early as 1776, in its Declaration of Rights, says:

"Art. VI. That the legislative, executive, and judicial powers of the government ought to be forever separate and distinct from each other."

The Constitution of Maryland of 1851, Declaration of Rights, declares:

"Art. VI. That the legislative, executive, and judicial powers of government ought to be forever separate and

distinct from each other, and no person exercising the functions of one of said departments shall assume or discharge the duties of any other."

The Constitution of Virginia, 1776, Declaration of Rights, says:

"Sec. 5. That the legislative and executive powers of the State should be separate and distinct from the judiciary."

The Constitution of Virginia, 1830, expanded that principle in this way:

"Art. II. The legislative, executive, and judicial departments shall be separate and distinct, so that neither exercise the powers properly belonging to either of the others; nor shall any person exercise the powers of more than one of them at the same time, except that the justices of the county courts shall be eligible to either House of Assembly."

The Constitution of North Carolina, 1776, Declaration of Rights, says:

"Art. IV. The legislative, executive and supreme judicial powers of government ought to be forever separate and distinct from each other."

The Constitution of Georgia, 1798, Article I, says:

"Sec. 1. The legislative, executive and judicial departments of government shall be distinct, and each department shall be confided to a separate body of magistracy; and no person or collection of persons, being of one of these departments, shall exercise any power properly attached to either of the others, except in the instances herein expressly permitted."

The Constitution of South Carolina, 1868, Article I, says:

"Sec. 26. In the government of this Commonwealth, the legislative, executive, and judicial powers of the govern-

ment shall be forever separate and distinct from each other, and no person or persons exercising the functions of one of said departments shall assume or discharge the duties of any other."

The Constitution of New Jersey, 1844, says.

"Art. III. The powers of the government shall be divided into three distinct departments—the legislative, executive, and judicial—and no person or persons belonging to, or constituting one of these departments, shall exercise any of the powers properly belonging to either of the others, except as herein expressly provided."

The provisions of the several State constitutions in this behalf will be found in "Poore's Charters and Constitutions."

Washington, in his farewell address, dwells on the danger of a disregard of the obligation to observe these limitations of departmental jurisdiction.

As will be observed, in each State of the Union this idea of maintaining the three departments of government separate and independent has been controlling. We cite these numerous references to emphasize the importance of keeping each department within its own domain, and in order that any doubt may not be resolved in favor of sustaining a questionable jurisdiction in the utter absence of necessity therefor.

The supreme importance of keeping the three branches of Government, to wit, the legislative, executive and judicial, separate and distinct, and constraining each to remain within its own domain, was thoroughly discussed when the adoption of the Constitution of the United States was being considered. One of the objections made to the adoption of the Constitution was that sufficient provision was not made in that instrument for a complete and thorough separation of the Departments of Government.

In meeting that objection Madison, Hamilton and Jay, who wrote the several articles for "The Federalist," appreciated the force of the objection and the absolute necessity of keeping these several departments separate and forcing each one as far as may be to remain within it own jurisdiction.

In speaking of that matter in "The Federalist," Vol. I, p. 540, the writer quotes approvingly the language of Montesquieu as follows:

"There is no liberty if the power of judging be not separated from the legislative and executive power."

And further, on p. 334, Vol I:

"The accumulation of all powers—legislative, judicial, and executive—in the same hands, whether one, a few, or many, and whether hereditary, self-appointed or elected, may be justly pronounced the very definition of tyranny."

Reference has been made to the earnest testimony borne by the fathers, and later, law-writers, on the necessity of this utter and thorough separation in the Departments of Government and that neither one should exercise a jurisdiction that properly belongs to the other, nor in anywise needlessly enter its domain.

The difficult question is to determine when the act by one Department, or an officer of one Department, is an encroachment upon the domain of another Department, or is in its essentials the exercise of a jurisdiction which belongs to another Department.

It will be admitted that the functions that properly belong to the executive or administrative department should not be exercised by the judicial, and that those functions which properly belong to the judicial department should not be exercised by the executive or legislative; but the difficulty arises in fixing the boundary line between them,

and the disposition of each department to extend its domain.

It goes without saying that an administrative duty may demand action that is in a sense judicial; that is, the officer charged with the performance of certain duties may be compelled to exercise the judicial faculty and to hear and determine.

We quote from Field's Federal Courts, Garland's notes, Part I, Chapter I, p. 1:

"The wisdom of those concerned in framing the Constitution of our government," says the author, "is nowhere more conspicuous than in those provisions of it which relate to the judicial power. They were familiar with the theories of political philosophers as well as the experience of other nations in their efforts to establish free governments, and, with the knowledge derived from these sources they wisely resolved that our government should consist of three departments—legislative, judicial and executive—each having powers to be exercised independent of the other. These elements have been urged as essential to the success of a free government by patriots, statesmen, and speculative philosophers, and it is believed by them, if not generally regarded as a maxim, that these three departments of the Government should be kept separate, distinct and independent of each other."

The political writer Montesquieu had maintained this doctrine with great force and vigor in his Commentary on the English Constitution, and that writer is quoted at considerable length and reasons are given, if reasons were needed, why these powers should be kept separate and distinct, and why neither department should be permitted to encroach upon the domain of the other.

Among other things he says:

"There would be the end of everything were the same man or same body, whether of the nobles or of the people, to

exercise these three powers, that of enacting laws, and in executing the public resolutions, and of trying the causes of individuals."

1st Montesquieu, p. 11, Chap. 6.

Speaking of the exercise of judicial, the necessity of having it co-extensive with the legislative department, Judge Field said:

"If it were otherwise there would be no power to enforce the rights of persons; there would be no remedy for a violation of these rights."

And Story on the Constitution, Sec. 1574; also 1st Kent's Commentaries, 294, says:

"Where there is no judicial department to interpret, pronounce and execute the law, to decide controversies and to enforce rights, the government must either perish by its own imbecility, or the other departments of government must usurp powers for the purpose of commanding obedience to the destruction of liberty."

This subject is discussed in the case of Kilburn *vs.* Thompson, 103 U. S., 168, in which the line of demarkation between the great Departments of the Government is marked out by Justice Miller, speaking for the Court.

Also Cohens *vs.* Virginia, 6th Wheaton, 384.

These cases will be referred to later in this brief.

We deem it well and timely to review more at length the law and authorities bearing on the question raised by the pleadings.

Remedy by Bill in Equity.

It may be urged that the proceeding by bill in equity authorized by Section 4915 is on all fours with the proceeding by appeal from the Commissioner of Patents, but that is not so.

Section 4915 provides a remedy by bill in equity, where an applicant has been refused a patent. It is in no wise and in no sense an appeal from the action of an executive officer, but a separate and independent proceeding, which has nothing to do with the hearing before the Commisssoner, but is an independent suit, in which pleadings are filed and testimony taken as in any other suit in equity.

This point has been decided over and over again, so the proceeding by bill in equity furnishes no precedent for proceeding by appeal from the Commissioner of Patents to a court to have the action of the former reviewed by the latter.

By Section 4915 the Circuit Courts of the United States are given a statutory judicial jurisdiction over the class of legal controversies, and the statute conferring such jurisdiction also provides that the findings and decrees of the courts in those cases shall be accepted by the executive department and should authorize the Commissioner to issue a patent to the applicant.

The court decides whether upon the whole case presented complainant is or is not entitled to a patent.

It is not an appeal to a higher tribunal or officer for the review or reversal of the decision of an inferior, but provides an opportunity for an applicant to prove his case in a proceeding *de novo*. (Gandy *vs.* Marble, 122 U. S., 439; Whipple *vs.* Miner, 15 Fed. Rep., 117.)

The jurisdiction sought to be conferred upon the Court of Appeals by the statute in question is of a very different nature.

It takes the case as presented to the Commissioner of Patents, an executive officer, according to the regulations of the Patent Office, and provides for a review of the Commissioner's finding and award upon the same evidence and the reasons upon which he based his decision. It is strictly and expressly a review on petition in error of the Commissioner's decision. The bill in equity, however, is in no sense a review of that decision. Nor does it in law or in fact purport to be. (Butterworth *vs.* Hoe, 112 U. S., 61.)

The appeal to the Court of Appeals is analogous to an appeal from the Secretary of the Treasury to the Supreme Court of the United States upon a question of revenue law, while the provision for a remedy, in equity, is analogous to the payment of a claim by the Secretary of the Treasury after the validity of the claim has been determined by the Court of Claims.

The former would be a direct interference and control by the judiciary with and over the functions and acts of an officer of the Executive Department. The latter is a provision for invoking the assistance of the judicial power and machinery in the investigation and determination of a question judicial in its nature.

The appeal from the Commissioner to the court as provided for in the statute quoted is a plain case of the confusion of executive and judicial functions, and certainly of subordinating the former to the latter.

ARGUMENT.

The granting and issuance of a patent by Government, here and elsewhere is, and always has been, an executive act.

In harmony with the rest of the world the United States has vested this function in the Executive Department, by constituting and organizing the Patent Office, which is a branch of the Interior Department. It was once attached to the State Department, and later made a part of the Interior Department, but it has always been a part of an executive branch of the Government.

Vol. I, Robinson on Patents, p. 76, Section 48.

The Commissioner of Patents acts in an executive capacity in passing upon an application.

The Patent Office is a part of the Executive Department of the Government.

Vesting the Duty to Hear Evidence and Determine a Course of Action Thereon Does Not Constitute the Commissioner a Judicial Officer.

The fact that the discharge of the Commissioner's duties involves the exercise of discretion and of judgment, and even the determination of questions of law and fact upon testimony, does not change the administrative nature of his office and make the duties pertaining to it judicial. The principal function of the Commissioner and of the Patent Office is to determine whether an applicant for a patent is entitled thereto.

This question here presented is not new, though it has not before been raised in the case of an appeal from the Commissioner of Patents.

In U. S. *vs.* Ferreira, 13 Howard, 40, an Act of Congress of 1849 had conferred upon the United States District judge for Florida authority to revise and adjudicate the claims of certain inhabitants against the United States; and an Act of Congress of 1833, under which also they were to act, directed the judges to report their decisions, if in favor of the complainant, to the Secretary of the Treasury, who, being satisfied that the same was just, should pay the amount adjudged.

The court said:

"It is too evident for argument that such a tribunal is not a judicial one. The authority conferred on the respective judges was nothing more than that of a commissioner to adjust claims against the United States. The office of judges and their respective jurisdictions are referred to in the law, merely as designating the person to whom the authority is confided and the territorial limits to which it extends. The decision is not a judgment of a court of justice, it is the award of a Commissioner.

"The powers conferred by these Acts of Congress upon the Judge as well as the Secretary are, it is true, *judicial in their nature*, for judgment and discretion must be exercised by both of them. But it is nothing more than the power ordinarily given by law to a Commissioner appointed to adjust claims to lands or money under a treaty; or special powers to inquire into or decide any other particular class of controversies in which the public or individuals may be concerned. A power of this description may constitutionally be conferred on a Secretary as well as on a Commissioner, but is not judicial in either case in the sense in which judicial power is granted by the Constitution to the Courts of the United States."

In U. S. *vs.* Yale Todd, 13 Howard, 52 note, the court treated of this question. An Act of Congress, I Statute at Large, p. 243, provided that the United States Circuit Courts

should determine the nature of the disability of certain applicants for a pension and the meritoriousness of their claims and report the same to the Secretary of War, together with an opinion upon the amount of a pension each applicant should receive.

This honorable Court held: "That the power proposed to be conferred on the Circuit Court of the United States by the Act of 1792 was not judicial power, within the meaning of the Constitution, and was, therefore, unconstitutional, and could not be lawfully exercised by the courts."

In Gordon *vs.* U. S., 2 Wall, 561 (opinion given in 117 U. S., 697), Ch. J. Taney says: "Congress may absolutely establish tribunals with special powers to examine testimony and decide in the first instance upon the validity and justice of any claim for money against the United States subject to the supervision and control of Congress or a head of any of the Executive Departments. In this respect the authority of the Court of Claims is like to that of the Auditor or Comptroller, with this difference only, that in the latter case the appropriation is made in advance upon estimates, furnished by the different Executive Departments, of their probable expenses during the ensuing year. * * * But in principle there is no difference between these two special jurisdictions created by Acts of Congress for special purposes, and **neither of them possess judicial power in the sense in which these words are used in the Constitution.** The circumstance that one is called a court and its decisions called judgments cannot alter its character nor enlarge its powers."

In People *vs.* Ulster & Delaware Ry., 12 N. Y. Sup., 303, similar pertinent statements were made. In that case a statute providing for the reorganization of railways did not

require the extension of a railroad in case the board of railroad commissioners should, after hearing and determining, certify that the public interests do not require such extension; and further provided, that this certificate should be a bar to any proceedings to compel such an extension, and should be final and conclusive upon all courts, in any proceeding to annul the charter of the corporation for failure to make such extension. It was maintained that this act was unconstitutional, because conferring judicial powers upon an administrative board.

The court said: "Administrative duties often require an administrative officer to decide upon the proper cause of action, and for that purpose to decide what are the facts before him. But he is not, therefore, exercising judicial functions."

In Hartford Insurance Company *vs.* Raymond, 36 N. W. Rep., 474 (Mich.), the Insurance Company as relator sought by mandamus to compel the State insurance commissioner to reverse his decision, and restore to the relator its certificate of compliance with the insurance laws of the State, so that it could carry on its business therein.

It claimed that the authority to grant and revoke, and determine the sufficiency of the cause therefor, by a hearing before him, exercised by the commissioner of insurance was void as an exercise of judicial power by an executive officer, and hence the law vesting that authority in him was unconstitutional.

The court said: "It is claimed that the act is unconstitutional, because it attempts to confer judicial power upon the commissioner of insurance, who is a member of the Executive Department. The power of the Commissioner, however, * * * is but ministerial in its nature and not the exercise of judicial functions."

In re Kain, 14 Howard, at 119, Mr. Justice Curtis, speaking of the functions and power of a United States Commissioner, said: "Not only has the law made no provision for the revision of his acts by this court, but strictly speaking, he does not exercise any part of the judicial power of the United States. That power can be exercised only by judges appointed by the President by and with the consent of the Senate, holding their offices during good behavior, and receiving fixed salaries."

Mr. Justice Field said, *in re* Pacific Railway Commissioner, 32 Fed. Rep., 242, at p. 258, when speaking of Hayburn's case:

"Plainly, the power exercised by them (judges) in determining the extent to which invalids were entitled to the pensions provided upon the proof produced was in its nature judicial, for it required an examination of evidence and judgment thereon; but it was not judicial in the sense of the Constitution under which judicial power can be exercised only in the cases enumerated in that instrument."

In re Pacific Railway Commission, 32 Fed. Rep., 255, Justice Field, speaking of Sec. 2 of Article III of the Constitution, said:

"As thus modified, the section states all the cases and controversies in which the judicial power of the United States can be exercised, except those arising on a petition for a writ of *habeas corpus*, which is regarded as a suit for one's personal freedom. This judicial power of the United States is therefore vested in the courts, and can only be exercised by them in the cases and controversies enumerated, and in petitions for *habeas corpus*. In no other proceedings can that power be invoked from it and it is not competent for Congress to require its exercise in any other way. Any act providing for such exercise would be a direct invasion of the rights reserved to the States or to the people; and it would be the duty of the court to declare it null and void.

Story says, in his Commentaries on the Constitution, that 'the function of judges of the Courts of the United States are strictly and exclusively judicial. They cannot, therefore, be called upon to advise the President in any executive measure, or to give extrajudicial interpretations of law, or to act as commissioners in cases of pension or other like proceedings.' Section 1777."

It plainly appears from the reasoning of the courts in these decisions that power and authority like that vested in the Commissioner of Patents does not constitute him a judge, or his office a court, in the sense in which those terms are used in the Constitution. The functions of his office are of the same nature as those required of a Commissioner of Internal Revenue. Neither of said officers can properly be regarded a judge. Nor are their duties judicial, though they hear evidence and a high order of judgment and discretion is required of them in estimating values and making proper appraisements, or determining on evidence other questions affecting the rights of persons and property. Both of said offices are executive, as is the office of Commissioner of Patents. The discretion and judgment which any proper system of rating requires, so far as revenue or rate of pension is concerned, is merely incidental to the main purpose of collecting the revenue or deciding what amount shall be allowed and paid as pension.

We submit that neither upon principle nor authority can the Commissioner of Patents be held to be other than an executive officer, or that his quasi-judicial duties are anything more or other than may devolve upon any executive or ministerial officer.

We further submit that appellate jurisdiction over the Commissioner of Patents cannot be constitutionally vested in

the Court of Appeals, for the reason that no duties can be required of that Court that are not judicial, and appeals and writs of error to that Court for review must be from judicial tribunals,—in other words, from courts established by law under the Constitution. And there is not even a pretense that the Commissioner of Patents is a judge, or that his office is a court.

And not only is there a mingling and confusing of the departmental powers of government, but it results in a complete subordination, to the extent that this appellate jurisdiction is exercised by one Department over another; and we may pertinently ask if in the case at bar an appeal for review will lie from the act of the executive officer known and designated by the law as Commissioner of Patents, where is the line of demarkation between those Executive acts which require the exercise of judicial faculties—that is, to hear evidence and pass upon questions affecting rights of property and persons from which an appeal may be prosecuted, and those Executive acts from which *no* appeal may be allowed?

The former cases cannot be limited to those in which official action hinges on conclusions reached after hearing evidence in order to apply the law, for if that was so there would be very few, if any, acts of any one of the Executive Departments which would not be reviewable by the Court on appeal.

It goes without saying that there is not an officer in any branch of the Executive Department who is not required every day to hear evidence and decide what the legal rights of a petitioner or applicant are. But nobody will claim that such officers are judges or that in discharging their duties they act as courts inferior to the Supreme Court.

The Constitution Does Not Permit a Confusion of the Powers of Government.

An appeal to the Court of Appeals from the Commissioner of Patents being limited, as we have already stated, to the evidence as presented to the Commissioner and the reasons for his action, is a confusion of the powers of government which the Constitution does not permit. Obviously the statute in question provides for a review, as upon petition in error, by said Court of the action of this executive officer.

The Constitution contemplates and provides for a complete division and separation of the powers of sovereignty. This is plain from a consideration of the sections apportioning the powers of sovereignty. These sections are as follows:

"Art. I, Sec. 1. All legislative powers herein granted shall be vested in a Congress of the United States," &c.

"Art. II. The executive power shall be vested in a President of the United States of America."

"Art. III. The judicial power of the United States shall be vested in one Supreme Court and in such inferior courts as the Congress may from time to time ordain and establish."

The affirmative words and provisions in these sections are to be taken as exclusive in the interpretation of these sections. When the Constitution says, "All legislative powers herein granted shall be vested in a Congress," it disposes of the whole legislative power, and none of it is left to be exercised by either of the other Departments because of peculiar exigency which suggests that such exercise of legislative power would be convenient or useful.

Article II in the same manner makes a complete disposition of the Executive power, and creates the depository of it. It gives the President executive power, and gives him noth-

ing else. All power other than executive conferred upon the President is given him by express provision.

Article III creates and provides for the establishment of courts that shall constitute our judicial system, and vests in those courts the judicial powers of the Government. It gives the Department of the Judiciary the *judicial power* of the Government. No part of the executive or legislative power is conferred upon it. These three articles constitute a brief, concise classification of governmental functions, and the affirmative words are to be taken as exclusive against the grant of other powers.

Cooley, in his Constitutional Limitations, 6th Ed., at pp. 104 and 106; Foster on the Constitution, p. 302, sec. 44, and Hare on the Constitution, Vol. I, pp. 173, 174, all support our contention that neither of the three Departments can exercise powers belonging in their nature to either of the others, and that this applies to each Department alike.

Madison, writing in "The Federalist," No. 48, says:

"It is agreed on all sides that the powers properly belonging to one of the Departments ought not to be directly or completely administered by either of the other Departments. It is generally evident that neither of them ought to possess, directly or indirectly, an overruling influence over the others in the respective powers. It will not be denied that power is of an encroaching nature, and that it ought to be effectually restrained from passing the limits assigned to it."

Again, in the same number, he says:

"The conclusion which I am warranted in drawing from these observations is, that a mere demarkation on parchment of the constitutional limits of the several Departments is not sufficient guard against those encroachments which lead to

a tyrannical concentration of all powers of government in the same hands."

Brown on Jurisdiction, pp. 39–41, Sec. 15, after commenting on the distribution of governmental powers, says in conclusion:

"Therefore, **while these co-ordinate branches of the Government are acting within their respective fields, no other power or branch can interfere with their method of acting; or direct the manner** of performing their respective duties, and **hence all acts either executive or administrative, legislative or judicial,** belonging to the several departments, **are independent of the control of the other branches.** Where the duty to be performed embraces administrative legislation **or judicial discretion,** it is a prerogative right **that the courts cannot control** and **this rule applies to and is inherent in every member or head of each separate department."**

And again, Sec. 17, pp. 43–44:

"Courts have no power to compel the Executive Department to enforce the collection of revenue, or to prevent its so doing; or to dictate the kind, sufficiency, or character of the evidence necessary under an enabling statute to authorize administrative action. They have no control over national boundaries, for it is a purely political question, nor power to give force to a law that is not constitutional, nor to pass upon the justness or policy of a statute that is within legislative jurisdiction—in a word, they have no power to interfere with the action or policy of any other Departments of government."

In Osborn *vs.* Bank of U. S., 9 Wheat., 255, the court said:

"All governments which are not extremely defective in their organization must possess within themselves the means of expounding as well as enforcing their own laws. If we examine the Constitution of the United States, we find that its framers kept this great political principal in view.

"*The second article vests the whole executive power in the President.*"

This honorable Court in Kilbourn *vs.* Thompson, 103 U. S., 190, said:

"It is believed to be one of the chief merits of the American system of written constitutional law, that **all the powers intrusted to government,** whether State or National, **are divided into three grand departments,** the executive, the legislative and the judicial. That the functions appropriate to each of these branches of government shall be vested in a separate body of public servants, and that **the perfection of the system requires that the lines which separate and divide these departments shall be broadly and clearly defined.** It is also essential to the successful working of this system that the **persons intrusted with power in any one of these branches shall not be permitted to encroach upon the powers confided to the others,** but that each shall by the law of its creation be limited to the exercise of the powers appropriate to its own department and no other."

Chief Justice Waite in the Sinking Fund cases, 99 U. S., 718, says:

"One branch of the Government cannot encroach on the domain of another without danger. The safety of our institutions depends in no small degree on a strict observance of this salutary rule."

"*They (framers of the Constitution) regarded the independence of the executive hardly less important than that of the judiciary and the legislative,* and meant that each department should be a check on the others."

In Smith *vs.* Adams, 130 U. S., 173, Field, J., speaking of the power of a court to entertain a case concerning the designation of a county seat, said:

"By those terms ('cases and controversies' in Art. III, Sec. II, of the Constitution) are intended claims and conten-

tions of litigants brought before the courts for adjudication by regular proceedings established for the protection or enforcement of rights or the prevention, redress, or punishment of wrongs."

Fontain *vs.* Ravenel, 17 H., 369, is also in point.

The facts were that a testator had died leaving a will in which he made bequests to such charities as should be specified by the executors after the death of his widow. The widow survived the executors, so there was no specification of the charities, and it was desired to have the Circuit Court of United States for Eastern District of Pennsylvania administer the estate and the bequests on the doctrine of *cy pres*. It was held that it could not do so on the ground that such administration was an executive and not a judicial duty, and that the court had only judicial powers and not those executive powers exercised by the English Court of Chancery as the representative of the King.

Taney, C. J.:

"Whether or not the bequest is valid according to Pennsylvania law and would be carried into effect by the courts of that State, yet, United States Court had no jurisdiction. Though English court of chancery would carry into execution a bequest of this kind it would be carried out by the Chancellor as a branch of the prerogative power of the King as *parens patriæ*. The power of the Chancellor over donations to charitable uses so far as it differs from the power he exercises in other cases of trust, does not belong to the court of chancery as a court of equity, nor is it a part of its judicial power and jurisdiction."

"The Constitution declares that the judicial power shall extend, &c. These words obviously confer judicial power and nothing more, and cannot upon any fair construction be held to embrace the prerogative powers which the King as *parens patriæ* in England exercised through the courts.

And the chancery jurisdiction of courts of the United States as granted by the Constitution extends only to cases over which the court of chancery had jurisdiction in its judicial character as a court of equity. The wide discretionary power over infants, idiots and insane or charities exercised by the chancellor of England has not been conferred."

"The Constitution of the United States grants only judicial power at law and in equity to its courts—that is, the powers at that time understood and exercised as judicial in the courts of common law and equity in England. And it must be construed according to the meaning which the words used conveyed at the time of its adoption."

HAYBURN CASE, 2 DALLAS, 409.

This was a motion for a mandamus to the Circuit Court of the District of Pennsylvania, commanding the court to proceed in a certain petition of Hayburn, to be put on the pension list under the statute of March 23, 1792, 1 Statute at Large, 243. The act provided that all disabled officers of the Revolutionary War should be entitled to be placed on the pension list of the United States whom the circuit court of the district in which they resided should think fit, and at the rate recommended by the court, provided that certain rules and regulations were complied with.

The court refused to grant the mandamus at the time of the motion made, and held it over for consideration. In the meantime and before any decision was ever pronounced the matter was disposed of by Congress providing another way for the relief of pensioners in the ascertainment of their rights.

In a note to this case, however, the opinion of the Circuit Court for the District of New York is given as follows:

"That by the Constitution of the United States the government thereof is divided into three distinct and inde-

pendent branches, and that it is the duty of each to abstain from and to oppose encroachments on either; that neither the legislative nor the executive branches can constitutionally assign to the judicial any duties but such as are properly judicial, and to be performed in a judicial manner; that the duties assigned to the circuit courts by this act are not of that description, and that the act itself does not appear to contemplate them as such; inasmuch as it subjects the decisions of these courts, made pursuant to those duties, first to the consideration and suspension of the Secretary of War, and then to the revision of the legislature; whereas by the Constitution, neither the Secretary of War nor any other executive officer, nor even the legislature, are authorized to sit as a court of errors on the judicial acts or opinions of this court.

"As therefore the business assigned to this court, by the act is not judicial, nor directed to be performed judicially, the act can only be considered as appointing commissioners for the purposes mentioned in it, by official instead of personal descriptions; that the judges of this court regard themselves as being the commissioners designated by the act, and therefore as being at liberty to accept or decline that office; that as the objects of this act are exceedingly benevolent, and do real honor to the humanity and justice of Congress; and as the judges desire to manifest, on all proper occasions and in every proper manner their high respect for the National Legislature, they will execute this act in the capacity of commissioners," &c., &c.

U. S. vs. YALE TODD, 13 HOW., 52, IN NOTE TO FERREIRA CASE.

In this case the question came squarely before the court whether the action of Ch. J. Jay, and Cushing, J., which they took under the act of 1792 mentioned in Hayburn's case and before its repeal, was legal, and it was the unanimous decision of the Supreme Court that it was not, Chief-Justice Jay and Justice Cushing seeming to have changed their minds since the proceedings on the circuit.

"It must be admitted that the justice of the claims and the meritorious character of the claimants would appear to have exercised some influence on their judgments in the first instance, and to have led them to give a construction to the law which its language would hardly justify upon the most liberal rules of interpretation.

The result of the opinions expressed by the judges of the Supreme Court of that day in the note to Hayburn's case, and in the case of the United States *vs.* Todd, is this:

1. That the power proposed to be conferred on the circuit courts of the United States by the act of 1792 was not judicial power within the meaning of the Constitution, and was, therefore, unconstitutional, and could not lawfully be exercised by the courts.

2. That as the act of Congress intended to confer the power on the courts as a judicial function, it could not be construed as an authority to the judges composing the court to exercise the power out of court in the character of commissioners.

3. That money paid under a certificate from persons not authorized by law to give it, might be recovered back by the United States."

In re Pacific Railway Commission, 32 Fed. Rep., at p. 254. Field, J., said:

"Be that as it may, the Federal courts cannot, upon that concession, aid the commission in ascertaining how the moneys were expended. Those courts cannot become the instruments of the commission in furthering its investigation. Their power, its nature and extent, is defined by the Constitution. The government established by that instrument is one of delegated powers, supreme in its prescribed sphere, but without authority beyond it. No department of it can exercise any powers not specifically enumerated or necessarily implied in those enumerated. Such is the teaching of all of our great jurists, and the Tenth Amendment declares that 'the powers not delegated to the United States by the Constitution, nor prohibited by it to the States, are reserved to the States respectively, or to the people.' Any legislation of Congress beyond the limits of the powers

delegated is an invasion of the rights reserved to the States or to the people, and is necessarily void. The first Section of the third Article of the Constitution declares that 'the judicial power of the United States shall be vested in one Supreme Court and such inferior courts as Congress may, from time to time, ordain and establish.' "

These views are also confirmed by the constitutions of the States, in all of which the powers of sovereignty are carefully divided and apportioned to appropriate depositories. This is done by different language, most of them using simply the concise division of power used in the Constitution of the United States. In many, however, the division is insured by a clause forbidding the exercise by any one of the powers of either of the others. In New Hampshire, for instance, it is provided that "no person or collection of persons exercising the functions of one department shall assume or discharge the functions of any other." Similar prohibitory sections are found in the constitutions of Massachusetts, Maine, Vermont, New Jersey, Indiana, Illinois, Michigan, Louisiana, Minnesota, Pennsylvania, Maryland, Virginia, West Virginia, Kentucky, Tennessee, Missouri, Alabama, Arkansas, Texas, California, Oregon, Colorado, South Carolina, Georgia, Mississippi, Florida. Other States, however, not having this provision in their constitutions, support the strict division of governmental power.

The decisions under these and other State constitutions are numerous and they uniformly recognize the principle of the separation of the powers of government, regardless of whether that principle is expressly stated in the Constitution. From them we cite the following cases:

IN RE SPLANE, 16 ATL., 481.

Petition for mandamus to compel admission of an attorney to practice law.

Held, to be a judicial act which cannot be compelled by the legislature on certain conditions precedent.

"If there is anything clear in the Constitution, it is that the legislature cannot exercise judicial powers. They are lodged exclusively in the judiciary. The legislative and executive departments can no more encroach upon the judiciary than the latter can encroach upon them."

"Each department in our beautiful system of government has its own appropriate spheres, and so long as it confines itself to its orbit the machinery of government moves without friction. We have too much respect for the legislature to suppose it would ever intentionally step over the line which divides the respective departments, but slight encroachments may sometimes occur by inadvertence. In such cases it is the province of the jury to correct them." Petition dismissed.

TITUSVILLE IRON WORKS vs. KEYSTONE OIL CO., 15 A, 917 (PA., 1888).

Act of 1887 directed the courts to hereafter construe the mechanics' lien act so as to extend the lien to all laborers and material men, which was at variance with a long line of decisions.

Held unconstitutional:

"The Legislature can no more exercise judicial powers than the courts can arrogate to themselves legislative powers. The legislative and judicial departments of the Government are independent and co-ordinate.

"The Act of 1887 is in no respect a legislative declaration of rights and privileges of the class of persons to whom it relates, but it is a judicial order or decree directed to the courts. It undertakes to give a new and final interpretation to the Acts of 1836 and 1845 and directs the courts to adopt that interpretation in all cases that may be before them. This is a clear case of the exercise of judicial power by a department that does not possess it."

TERRITORY VS. STEWART, 23 PAC. REP., 405.

An act of the legislature providing that when a majority of the inhabitants of a town or village present a petition to the district judge, setting forth the area to be included in such village and praying to be incorporated, such judge shall order its incorporation and decide upon its metes and bounds, is unconstitutional for mixing the powers of government.

Held:

"It is with us in America a legislative function to draw the line separating the limits of a place to be incorporated, and the people thereof. (1 Dill Municipal Corporation, Sec. 183, 3d Ed.). * * *

We hold that a judicial court cannot exercise legislative functions and that the legislature cannot impose such power upon it."

GREGONG VS. STATE EX REL. W. H. GUDGEL, 94 IND., 384,

holds that fixing bail is a judicial act and a clerk of court cannot be vested with the power to do it, because the Constitution in strong terms declares that judicial powers shall be vested in courts and not in ministerial officers.

TILLMAN VS. COCKE, 68 TENN., 429.

The general rule in Tennessee is that all parties to suits can testify. One statute says, however, that in all actions by or against executors and administrators neither party shall be allowed to testify unless called by the other party or required to do so by the court. Held unconstitutional for vesting courts with legislative powers regarding each particular case.

"This is not to adjudge what the law is but to make it a power which cannot be conferred on the court by the legislature."

See also—

Board of Commissioners *vs.* Gwin, 36 N. E. Rep., 242.

Shaultz *vs.* McPheeters, 79 Ind., 373.

Re Sims, 37 Pac. Rep. 135 (Kan., 1894).

Galesburg *vs.* Hawkins, 75 Ill., 152.

This construction of the language of these articles is in harmony with the ideas current at the period of the adoption of the Constitution, with the principles upon which the Constitution was formed.

Chief Justice Taney, in Gordon *vs.* U. S., said (117 U. S. Rep., at p. 706) when speaking of the acceptance of this principle by the framers of the Constitution:

"These cardinal principles of free government had not only been long established in England, but also in the United States from the time of their earliest colonization, and guided the American people in framing and adopting the present Constitution. And it is the duty of this Court to maintain it unimpaired as far as it may have the power. And while it executes firmly all the judicial powers entrusted to it, the Court will carefully abstain from exercising any power that is not strictly judicial in its character, and which is not clearly confided to it by the Constitution."

One of the most important characteristics of the English constitution was the substantial independence of the three departments of governments. It had been secured by centuries of controversy, and was regarded as a precious political heritage.

The independence of Parliament from the King, the limitations set to the royal prerogative and the absolute independence of the judiciary from either was the result of a long and bitter struggle which had cost one sovereign his head.

It was the object of the framers of the Constitution to carry this separation of the powers still farther and to fix this principle firmly in the Constitution.

This appears in their making the heads of executive departments entirely independent of Congress in contradistinction to the English custom which permits cabinet officers to take part in legislative proceedings.

It is plain, then, that it was the object of the framers to firmly fix the principle of the separation of powers of sovereignty in the new government.

This policy of our Government has always been recognized to be in operation in our constitutional jurisprudence from the earliest decisions to the present time. The opinions are as clear in the Sinking Fund cases in 99 U. S. and Kilbourn *vs.* Thompson, 103 U. S., as in Hayburn's case in Dallas.

An Appeal from the Executive Department to the Judicial Department.

Mr. Justice Matthews, in Butterworth *vs.* Hoe, 112 U. S., 50, speaks of this proceeding as "in aid of" the proceedings in the Patent Office. This proceeding, however, is not in aid of, but absolutely controls the action in the Patent Office and the result of its proceedings. A proceeding having such an effect cannot be properly said to be merely *in aid of.*

It is exactly what Madison, writing in "The Federalist" (No. 48, which we have quoted elsewhere), was treating of when he said:

"It is agreed on all sides that the powers properly belonging to one of the departments ought not to be directly or completely administered by either of the other departments.

It is generally evident that neither of them ought to possess directly or indirectly an overruling influence over the others in their respective power. It will not be denied that power is of an encroaching nature and that it ought to be effectually restrained from passing the limits assigned to it."

We fortunately have abundance of authorities upon the question of the illegality of such an appeal, and also upon the illegality of making the judiciary such aids to the other departments.

U. S. vs. RITCHIE, 17 HOWARD, 525.

Appeal from a decree from the District Court of California.

The proceedings were originally commenced before the board of commissioners to settle private land claims in California, under the Act of Congress of 1851, March 3rd. The petition was filed before that board by Ritchie against the United States, setting forth a claim to a tract of land known by the name of "Suisun," praying that the title might be confirmed.

The commissioners after hearing the proofs, ordered the title confirmed to claimant.

A transcript of the proceedings before the board with their decision was filed in the U. S. district court. Further testimony was taken and heard by the court, and the decision of the board of commissioners was confirmed.

On appeal from that decree to this Court objection was taken to the jurisdiction of the district court to hear and determine the cause.

The statute under which the appeal was taken provides that a transcript of the proceedings before the Commissioners shall be filed in the district court, and the evidence on which the same was founded, which filing should operate as an appeal.

The Court said (italics ours):

"It is also objected, that the law prescribing an appeal to the district court from the decision of the board of commissioners is unconstitutional; as this board, as organized, is not a court under the Constitution, and cannot, therefore, be invested with any of the judicial powers conferred upon the General Government.

"But the answer to the objection is that *the suit in the district court is to be regarded as an original proceeding*, the removal of the transcript, papers and evidence into it from the board of commissioners being but a mode of providing for the institution of the suit in that court. The transfer, it is true, is called an appeal. We must not, however, be misled by the name, but look to the substance and intent of the proceeding. The district *court is not confined to a mere re-examination of the case as heard and decided by the board of commissioners*, but hears the case *de novo* upon the papers and testimony which had been used before the board, they being made evidence in the district court; and also upon such further evidence as either party may see fit to produce."

In the case at bar the Statutes conferring the right of appeal provide that (italics ours)—

"the court, on petition, shall hear and determine such appeal and reverse the decision appealed from in a summary way *on the evidence produced before the Commissioner* * * * *and the revision shall be confined to the points set forth in the reasons of appeal.* (Section 4914 Revised Statutes.)

U. S. vs. FERREIRA, 13 How., 40.

(Cited and quoted above, also.)

In this case the Supreme Court of the United States declined to entertain an appeal from the Circuit Court for the District of Florida, in its determination of certain claims of individuals against the United States under a treaty with Spain. The Supreme Court held that the Circuit Court had

acted as a commissioner, and no appeal to the courts lay from its award. The question of the legality of the action of the Circuit Court was not before the Supreme Court, and they decline to pass upon it, but hint that it might be questioned.

GORDON vs. UNITED STATES, 2 WAL., 561; 117 U. S., 697. (Cited above.)

This was an appeal from a decision by the Court of Claims unfavorable to the appellant. The court held that the Constitution gave no appellate jurisdiction to the Supreme Court of the United States from the Court of Claims.

The courts have been equally prompt to decline to be made adjuncts or auxiliary instruments to the other departments, or to commissions and bureaus of those departments. They have insisted that their functions are limited not only to what may be abstractly judicial, but to the concrete and practical duties which the experience of governments has determined to be the proper province of a court of justice. They have repeatedly decided that they are confined to questions judicial in their nature, but that that fact alone is not enough to give them jurisdiction. The question must be presented in the form of a case or controversy, and must be one which pertains to the administration of justice by a court rather than incident to legislative or executive duties. They have steadily refused not only to revise the decision of other branches of the Government or intrude upon their proper domain of action, or to stop by injunction or compel by mandamus the action of other departments, but they have also refused their assistance by process, when called upon merely to aid another department or arm thereof to carry out some object properly within the functions of that

department. Upon this point we cite the cases of *re* Interstate Commerce Commission, *re* McLean, *re* Pacific Railway Commission, Taylor *vs.* Commonwealth.

RE INTERSTATE COMMERCE COMMISSION, CIRCUIT COURT N. D. ILL., 1892; 53 FED. REP., 476.

Application by the Interstate Commerce Commission for orders to compel certain persons to produce papers and testify before the Commission.

Gresham, J.:

"The Interstate Commerce Commission is an administrative and not a judicial body, and the important question presented for determination is, can the process of this Court be exercised in aid of an investigation before such tribunal. The jurisdiction of the United States Courts is limited, and it is not competent for Congress to confer upon them authority which is not strictly judicial, and *clearly within* the grant found in the 3rd Article of the Constitution.

* * * The application of an administrative body to a judicial tribunal for the exercise of its functions in aid of the execution of nonjudicial duties does not make a 'case' or 'controversy' upon which the judicial power can be brought to bear. It is not a contention between litigants brought before a court by regular proceedings for the protection or enforcement of rights, or the prevention, redress or punishment of wrongs. The Commission was engaged in investigating charges of unlawful discrimination against certain railway companies and this Court is simply asked to aid that body in obtaining evidence, which, it is claimed, will tend to support the charge. The subject of the inquiry is not brought here for adjudication and this Court can exercise no discretion beyond deciding whether the evidence demanded is pertinent to the charge and within the general scope of Sec. 12 of the Act.

"Congress cannot make the judicial department the mere adjunct or instrument of either of the other departments of Government."

IN RE PACIFIC RAILWAY COMMISSION, 32 FED. REP., 242.

Act constituting this commission provided that the Circuit or District Court of the United States, in case of refusal to testify before the commission, may issue an order, requiring such person to appear and testify. This is a request from such commission to the circuit court for such an order directed against Senator Stanford.

Held, per Field, J.:

"The Pacific Railway Commission is not a judicial body; it possesses no judicial powers; it can determine no rights of the Government or of the companies whose affairs it investigates. Those rights will remain the subject of judicial inquiry and determination as fully as though the commission had never been created, and in such inquiry its report to the President of its action will not be even admissible as evidence of any of the matters investigated." * * *

"The provisions of the act authorizing the courts to aid in the investigation in the manner indicated must be adjudged void. **The Federal Courts under the Constitution cannot be made aids to any investigation by a commission or committee into affairs of any one."**

In the matter of the application of the Senate, 10 Minn., 78. The following resolution was adopted by the Senate of Minnesota:

"*Resolved*, That the Supreme Court be, and hereby are, respectfully requested to furnish to the Senate their opinion upon the following questions:" * * *

Whereupon the Court returned the following answer:

"The resolution, we presume, was passed in view of Sec. 15, Ch. 4, Comp. Stat., which provides that either House may by resolution request the opinion of the Supreme Court or any one or more of the judges thereof. The Constitution not only prevents an assumption by either department of power not properly belonging to it, but also prohibits the imposi-

tion by one of any duty upon either of the others not within the scope of its jurisdiction; and 'it is the duty of each to abstain from and to oppose the encroachments on either.' Any departure from these important principles must be attended with evil." * * *

IN RE MCLEAN, 37 FED. REP., 648.

The Commissioner of Pensions requested the United States Court for the Eastern District of New York to issue a subpœna to one Callahan to appear at a certain place and time for examination by a special examiner of the Pension Bureau.

Benedict, J.:

"The request shows that the subpœna was desired for the purpose of enabling the Bureau of Pensions to make an examination into the facts bearing on a certain claim for a pension. * * * For such purpose the aid of this court cannot, in my opinion, be invoked. The proceeding in aid of which the process of this court is asked is an executive examination pending in an executive department of the Government, not a judicial inquiry pending before a court. In cases of controversy pending before the courts of the United States those courts have power to compel the attendance of persons as witnesses, but, in my opinion, Congress is not authorized to permit that power to be invoked in aid of an executive examination pending in an executive department. Request denied."

TAYLOR VS. COMMONWEALTH, 3 J. J. MARSHALL (KY.), 401.

A county court issued an order to effect that its clerkship was vacant, and appointing a new clerk. Plaintiff, the ousted clerk, brought a writ of error.

Held:

"The appointment of a clerk is not strictly speaking a judicial act, but is intrinsically executive. And although

the Constitution has confided to courts the appointment of their own clerks, still the nature of the power is not changed. It is essentially executive whensoever and by whomsoever it is exercised. It is as much executive when exercised by a court as by the Government. It is the prerogative of appointing to office, and is of the same nature, whether it belong to a court or to a governor. The appellate jurisdiction of this court is judicial. We can revise only what is judicial. Neither writ of error nor appeal would lie to this court to reverse or nullify any executive appointment or other executive act. If the governor make an illegal appointment, or if any other depositary of any portion of the executive functions of government act irregularly or illegally in the exercise of the appointing power, the appointment cannot be set aside by the direct appeal to this court; nor can an incumbent who may have been illegally or unjustly supplanted by the unauthorized appointment of a successor rectify the error and procure his reinstatement by writ of error or appeal to this court to reverse the order appointing the successor or superseding himself. * * *

"And we are of opinion that we cannot take cognizance of this writ of error because its direct object is to nullify an executive act, and not to reverse a judicial decision of the county court, it is not only unnecessary but improper to express any opinion on the various points presented in the range of the arguments of counsel."

In addition to those we have already cited we have a large class of cases on the general point of the independence of the departments so far as controlling the judgment and discretionary action of those departments is concerned.

These are cases, both State and National, in which the extraordinary remedies of mandamus and injunction have been asked against the executive department and refused by the courts. The effect of these cases is to hold that this

independence is always to be respected, and that a court will not interfere with an executive officer's exercise of discretion, nor will they inquire into the wisdom or justice of his decision or course of action.

This principle of constitutional law is fundamental and so well established as to need no argument. It lies at the foundation of our system of government. If it can be set aside whenever convenience suggests that it be done, that is an end of it as a principle of law.

We find as matter of actual experience that the courts have steadily refused to examine the justice of the individual case, or the degree of political danger that would be incurred by the violation of this principle of Government.

Such was the case in U. S. *vs.* Ferreira. The lower court had entertained jurisdiction, but the Supreme Court refused to hear an appeal from their decision. They expressed no opinion regarding the legality of the action of the inferior court, as that matter was not before them, and simply held that the action of the lower court was not judicial.

The early pension cases (Hayburn's case and U. S. *vs.* Yale Todd) are conspicuous examples of the adherence of the courts to the principle of independence and inaction. While realizing the benevolent motives which prompted Congress to enact the statute and the worthiness of the claimant's case, they still refused to violate this principle of our public law, and took great pains to state that, owing to the benevolent character of the proceeding, they would endeavor to find in the peculiar wording of the Act authority to act individually as commissioners.

There was no greater occasion to apprehend public danger from the court taking cognizance of that case than there is in the case at bar. The considerations of humanity were far more appealing than in the present case. Owing to the

paucity of executive officers, and the incomplete organization of the Government at that time, the plea of convenience was doubly powerful. There is certainly less cogent reason for the mingling of the powers of government in this instance than there was in that case. But the court refused to violate this fundamental principle. This fidelity of the courts to the law has marked their decisions all through our history.

In Miss. *vs.* Johnson, Georgia *vs.* Stanton, Cherokee Nation *vs.* State of Georgia, Commr. of Patents *vs.* Whitely and U. S. *ex rel. vs.* Black, the courts have refrained from interfering with the executive departments.

In the cases of *in re* Pacific Railway Commission, *in re* Interstate Commerce Commission, in the matter of the application of McLean, and in the opinion of the Supreme Court of Minnesota, in the Matter of the Application of the Senate, and other cases, *supra*, the courts have maintained their independence and dignity by declining to be made aids to the other departments.

They have recognized that "power is an aggressive thing," as Madison said, and must be confined and curtailed according to fixed principles or it will assume proportions dangerous to our system of government. This disregard of constitutional limitation in times of security, for harmless or even worthy purposes, will constitute a precedent for the consolidation of arbitrary power in an hour of danger, when great exigencies may furnish a seeming justification.

U. S. EX REL. DUNLAP VS. BLACK, 128 U. S., 40.

Application for a mandamus directing the Commissioner of Pensions to increase the pension of the relator under a certain construction of a statute. The Supreme Court of the District of Columbia refused the writ and the relator appealed to the United States Supreme Court.

It was held on the authority of Marbury *vs.* Madison, and later cases, that the writ would not lie:

"Whether if the law were properly before us for consideration, we should be of the same opinion or of a different opinion is a matter of no consequence. We have no appellate power over the Commissioner and no right to review his decision."

DECATUR VS. PAULDING, 12 PET., 513.

Paulding, as Secretary of the Navy, decided upon an application of Mrs. Decatur for a pension, that she must choose whether to take under a general pension act or one passed for her special benefit, and that she could not take under both, as she claimed the right to do. She brings a petition for mandamus.

Taney, Ch. J.:

"The court could not entertain an appeal from the decision of one of the Secretaries, nor revise his judgment in any case where the law had authorized him to exercise judgment or discretion. Nor can it by mandamus act directly upon the officer and guide and control his judgment and discretion in the matters committed to his care." Mandamus denied.

STATE OF GEORGIA VS. STANTON, 6 WALL., 50.

This was a bill for a restraining order against Stanton, Secretary of War *et al.*, to prevent these officers carrying into effect the Reconstruction Acts. The bill was filed in the United States Supreme Court, and the defendants made a motion for its dismissal for want of jurisdiction. It was urged that the subject-matter of the bill was of a political and not judicial nature.

Nelson, J., delivered the opinion of the court:

"This distinction (concerning the nature of the subject-matter of the suit) results from the organization of the Government into three great departments—executive, legislative, and judicial—and from the assignment and limitation of the powers of each by the Constitution. The judicial power is vested in the Supreme Court and such inferior courts as Congress may ordain and establish; the political power of the Government in the other two departments.

"The distinction between judicial and political power is so generally acknowledged in the jurisprudence of both England and this conntry that we need do no more than refer to some of the authorities on the subject. They are all in one direction. * * *"

The justice then considers the question of the character of the subject-matter, and concludes that it is political rather than judicial and hence the Court has no jurisdiction.

STATE EX REL. VS. STONE, 25 S. W. REP., 376, (MO.)

Mandamus to compel the Governor of the State to carry out a contract. Held, it would not lie because the executive was independent of and not controllable by the courts.

Sherwood, J.:

"In this instance, we, constituting a portion of the judicial department of the government, are called upon to exercise, or what amounts to the same thing, to control the exercise of the powers belonging exclusively to the Executive Department of that government. To such action on our part the law interposes an insuperable barrier.

"The Constitution provides that, the powers of government shall be divided into three distinct departments—the legislative, executive, and judicial—each of which shall be confined to a separate magistracy, and no person, or collection of persons, charged with the exercise of powers properly belonging to any one of these departments shall exercise

any powers properly belonging to either of the others, except in the instances in this constitution expressly directed or permitted."

U. S. vs. GUTHRIE, 17 HOWARD, 284.

Petition for a mandamus to compel the Secretary of the Treasury to pay the relator a portion of his salary claimed as judge of the territory of Minnesota.

Daniel, J.:

"The only legitimate question for our determination upon the case before us is this: Whether, under the organization of the Federal Government, or by any known principle of law, there can be asserted a power in the Circuit Court of the United States for the District of Columbia, or in this court, to command the withdrawal of a sum or sums of money from the Treasury of the United States to be applied in satisfaction of disputed or controverted claims against the United States? * * * The Government under such a *regime*, or rather under such an absence of all rule, would, if practicable at all, be administered not by the great departments ordained by the Constitution and laws, or guided by the modes therein prescribed, but by the uncertain and perhaps contradictory action of the courts in the enforcement of their views." Mandamus refused.

GAINS VS. THOMPSON, 7 WALL, 347.

This is a motion for an injunction to restrain the Secretary of the Interior from cancelling an entry in the Land Office whereby the plaintiff would be deprived of his title to land.

The Court held, per Miller, J.:

"That no such action could be maintained as it was controlling the Secretary in a *discretionary* duty, and not merely in a *ministerial* function." The cases of Decatur *vs.* Paulding and Marbury *vs.* Madison, etc., were regarded as controlling.

BRASHEAR VS. MASON, 6 HOW., 99.

Application for a mandamus by Brashear against John G. Mason, Secretary of the Navy, to compel him to pay the relator his salary as an officer of the United States Navy. There was a dispute as to the legality of his claim, which depended on the construction of the treaty of annexation of Texas. This court held the claim unlawful, and then proceeded to say that, though it had been lawful, yet a mandamus would not have lain to enforce payment, holding the case of Decatur *vs.* Paulding decisive of this one.

CHEROKEE NATION VS. STATE OF GEORGIA, 5 PETERS, 183, 184, 190.

A bill was filed to restrain the State of Georgia from enforcing its laws in the territory of the Cherokee tribe of Indians. Marshall, Ch. J., held that the court had no jurisdiction, because the Cherokee Nation was not a foreign state, and then proceeded:

"The bill requires us to control the legislature of Georgia, and to restrain the exertion of its physical force. The propriety of such an interposition by the court may be well questioned. It savors too much of the exercise of political power to be within the proper province of the judicial department. But the opinion on the point respecting parties makes it unnecessary to decide this question."

COM'R OF PATENTS AGAINST WHITELY, 4 WALL., 522.

Whitely, the assignee of a sectional interest in a patent, applied to the Commissioner of Patents for a reissue. The Commissioner decided that the applicant was not entitled to the reissue asked for. Whitely petitioned the Supreme Court of the District of Columbia for a mandamus, directing the Commissioner to send the application to an examiner to be acted upon as though made by the patentee. The

Supreme Court of the District of Columbia issued the writ and the Commissioner appealed to the Supreme Court of the United States.

Swayne, J.:

"The principles of law relating to the remedy by *mandamus* are well settled.

"It lies where there is a refusal to perform a ministerial act involving no exercise of judgment or discretion.

"It lies, also, where the exercise of judgment and discretion are involved and the officer refuses to decide, provided that, if he decided, the aggrieved party could have his decision reviewed by another tribunal.

"It is applicable only in these two classes of cases. It cannot be made to perform the functions of a writ of error.

* * * * * * *

"This case, as presented to the court below, was within neither of the categories above mentioned. The court, therefore, erred in making the order to which the Commissioner objected."

The Appeal is to a Court.

The statute in question vests the appellate power over an executive officer in the COURT OF APPEALS. There is no intention to constitute the *judges* of that Court a commission for the discharge of executive duties. The language purports to confer appellate power upon that Court as a court, and indicates no intention to confer other power. In fact, the authority vested in them is peculiarly described to be that which was previously vested in the Supreme Court of the District of Columbia, *sitting in banc.*

That act purported to confer nothing but appellate judicial power upon the Supreme Court, and that is the character of power transferred to the Court of Appeals. The language of that act is only applicable to a *court* sitting as

a judicial tribunal. It purports to convey authority for purely judicial action.

Gordon *vs.* U. S. and Ferreira *vs.* U. S. *supra*, are considered authorities that such an act is unconstitutional.

But even if the act did not purport to convey such judicial authority, but purported to convey power upon the court to act in an executive capacity, that construction would invalidate the act for attempting to place upon the courts duties other than judicial. Such an attempt has been decided over and over to be unconstitutional. On this point we cite the cases of U. S. *vs.* Gale Todd, 13 How.. 52, note, and U. S. *vs.* Ferreira, 13 How., 52, which are conclusive.

The question we submit is pivotal, and is this; is the Act of Congress which *in form* confers upon the Court of Appeals of the District of Columbia authority to finally and conclusively review, modify, reverse, or annul the action of an officer of the Executive Department of the Government, to wit, the Commissioner of Patents, acting in the discharge of his official duty, confessedly within the realm and scope of his jurisdiction, such officer not being a judge, and his office forming no part of the judicial system of the United States, but a part of the Executive or Administrative Department of the Government, constitutional?

First, that there is no question that Congress is authorized to select such means or agency as may be deemed fit and appropriate for carrying out, and into effect, the powers delegated to the Government by the people in the written Constitution, always provided the means and agency so selected are not in contravention of the letter or spirit of the Constitution itself.

Confessedly, this is a government of *delegated* powers, and no department of the Government may exercise any authority or power not expressly delegated or *necessarily* implied

from such delegated powers in order to carry out and into effect the powers expressly conferred.

It is obvious that the legislative power which finds expression in the act complained of was not expressly conferred by the Constitution, nor is it a necessary implication to give full effect to the clause which confers upon Congress the power "to promote science and the useful arts," since obviously no such necessity exists; so it is that in the exercise of this jurisdiction the Court invades the domain of another department of the Government and dominates it to the extent that it changes, modifies, or annuls the action of that Department.

It may be urged that the proceedings in relation to the granting of a patent are essentially judicial in their character.

That is undoubtedly true, but the Supreme Court of the United States and the courts of the States have decided over and over again that the fact that the functions of an office are judicial in their character does not determine the character or quality of the tribunal. In other words, it does not follow, because some of the officers of the Government, either in the Legislative or Executive Departments, must, in the discharge of their duties, hear evidence and determine upon that evidence what the law is and what their actions shall be, that they are thereby discharging the functions of a judicial office in the sense of the Constitution, or that such officer is a judge or his office a court.

The cases we have cited, we submit, from the Supreme Court and from the courts of the States, clearly sustain our contention, and, we, therefore, urge most respectfully that on reason and authority the jurisdiction we assail cannot be sustained.

And with due submission we may add that the disposition

and tendency of the several departments to cross departmental lines and to exercise power and authority not conferred by the Constitution has reached the limit consistent with public safety, and we are justified in the hope and belief that the disposition of the Court will be in the direction of conservatism.

The Court of Appeals laid much stress on the decision of this Court in Butterworth *vs.* Hoe, *supra.*

In that case, however, the question at bar was not raised nor discussed, and so far as that case may appear to point in the direction of maintaining this jurisdiction it is at war with every case where the question has been directly raised and decided. Moreover, other decisions of the Supreme Court and of the State courts, in marking the limitations of the legislative, judiciary and executive power, have all been against the soundness of the suggestion contained therein, viz: that the action of the Supreme Court of the District, in case of an appeal from the Commissioner of Patents, is "in aid of" the Patent Office.

The Court will observe that in Butterworth *vs.* Hoe it is expressly decided that the "appeal" was not, in the sense of the Constitution, a judicial one, either according to the forms and practice of the common law or proceedings in equity.

The only question that *was* raised or decided was whether, *in view of the acts of Congress then in force,* the Secretary of the Interior, as the head of the Department, had power to revise and reverse the decisions of the Commissioner disallowing an application for a patent; and your Honors held that he had not. This determination does not in any way preclude your Honors from, nor ought it to influence you against, deciding the question now before you; for the question of the constitutionality of the acts conferring the jurisdiction in appeal upon the courts was not there raised or considered.

Your Honors made the decison *upon the supposition that all the statutes on the statute books were in full force and effect.*

Moreover, so far as appeals in interference cases are concerned, the act of Congress (Feb. 9, 1893, which established said Court of Appeals) conferring the right of appeal in *them* was not yet passed; and, of course, was not considered in said decision.

On the other hand, as above stated, Butterworth *vs.* Hoe itself *admits without question* (what cannot be questioned, we submit) that the Commissioner of Patents is an *executive* officer, under the Secretary, and a part of a regular executive department of the Government. It was upon this ground, and upon the ground that an appeal lay to him from the Land Office, that the defendants in error maintained that an appeal lay to him from the *Commissioner of Patents;* but Mr. Justice Matthews says that, in determining *that* question, you must consider the acts of Congress which bear upon the respective powers of the Secretary and of this particular bureau—the Patent Office—and that, having considered them (p. 61):

"The inference is that an appeal is allowed from the decision of the Commissioner refusing a patent, not for the purpose of withdrawing that decision from the review of the Secretary, under his power to direct and superintend, but because, without that appeal, it was intended that the decision of the Commissioner should stand as the final judgment of the Patent Office, and of the Executive Department, of which it is a part."

We cite this language especially because it shows that, even if your Honors now hold as we believe you should, *Butterworth vs. Hoe would still stand as the law in regard to an appeal to the Secretary* from the Commissioner of Patents; for you there hold that you deny the right of appeal to the Secretary because the provisions of law conferring power

over the issuance of patents upon the Commissioner make his judgment final so far as the *executive* is concerned and *not* because of the existence of the laws (those here in question) which give an appeal to the courts.

The *right* of Congress to confer jurisdiction in appeal upon a *court*, or upon the Court of Appeals in particular, was not considered or passed upon in Butterworth *vs.* Hoe.

Therefore, notwithstanding this decision, *if* the judicial and executive departments of our Government are independent and coequal, as we submit they are, your Honors ought not to allow this jurisdiction in appeal to stand ; for, so far as the allowance or disallowance of applications for *patents*, at least, is concerned, the acts of Congress in question make the judicial the *final resort over the executive.* The "decision * * * shall govern the further proceedings in the case," says Sec. 4914, R. S. Thus, what is *in its nature executive ;* what, when Congress *first* exercised its power under Art. 1, Sec. 8–8 "to promote the Progress of Science and the useful Arts" was *placed in the executive ;* what was found there when Congress first gave an appeal to a court, and when (in 1893) Congress first gave an appeal in interference cases also ; and what is found there now (except as controlled by this appeal, which we submit is unconstitutional) is transferred, in its ultimate control, to the *judiciary ;* and the separate powers of our Government are no longer independent and coequal, but the one is enabled to tyrannize over, supersede and destroy the other.

If the boundary may be overstepped at all, where is the limit? What we anticipate will be the main defence itself brings us to this conclusion. Supposing that the power conferred by Art. 1, Sec. 8–8 "to promote the Progress of Science and the useful Arts," etc., is a *special grant* of power to Congress, and that, therefore, Congress may use any means, *either executive or judicial, or both,* that it sees fit ; then

it follows as a matter of course that Congress may give a right of appeal to the Court of Appeals of the District of Columbia (and probably to any other court) from the final action of the officers of the Post Office, Navy or War Departments, etc., for the power "To establish Post Offices and Post roads" (Art. 1, Sec. 8–7), "To raise and support Armies," etc. (Sec. 8–12), and "To provide and maintain a Navy" (Sec. 8–13), are *equally special grants of power to Congress.*

ANOTHER POINT OF VIEW.

Let us now look at the laws in question from a point of view not heretofore taken.

We submit that the Courts of the District of Columbia have always been considered, and are in fact, *United States* Courts, and that the Court of Appeals of the District of Columbia was established by Congress under the authority of Art. 3, Sec. 1, and Art. 1, Secs. 8–9, of the Constitution as one of the so-called "inferior courts," and *not* under Art. 1, Secs. 8–17, which gives Congress exclusive jurisdiction over the District of Columbia. This is so, we submit, because (speaking generally; and, as to patent appeals, specifically,) the Court of Appeals exercises the jurisdiction of the old General Term of the Supreme Court of the District of Columbia, which Court was formerly known as the *United States* Circuit Court for the District of Columbia. And the Supreme Court of the United States has already determined that the Supreme Court of the District of Columbia is a court of the United States (Cochrane *vs.* Deener, 94 U. S., 780; Embry *vs.* Palmer, 107 U. S., 3). Moreover, the Attorney-General of the *United States* provides the accommodations for the Court of Appeals (Sec. 12, Act of Feb. 9, 1893); its process is issued in the name of the President; its pro-

cess is served by "the marshal of the *United States* for the District of Columbia" (Sec. 13); and it has been judicially determined (Noerr *vs.* Brewer, 1 Mc. Ar., 507) that Section 858 of the R. S. U. S., which relates to evidence and which begins "*In the Courts of the United States,*" applies to the Courts of the District of Columbia.

But, even admitting that the Court of Appeals of the District of Columbia was established *partly* under the sections authorizing the establishment of "inferior courts" and *partly* under the section conferring exclusive jurisdiction over the District of Columbia, it is very evident that *that part of its jurisdiction which relates to appeals from the Commissioner of Patents could not have been conferred under the authority of the last section;* for the *subject-matter* is not connected with the District within the meaning of that section, nor are the *parties* generally, and certainly not necessarily, *residents of the District.*

As an United States court, therefore, the jurisdiction of the Court of Appeals of the District of Columbia is limited by the Constitution (Art. III, Sec. 2) to "*cases* in law and equity, arising under * * * the laws of the United States."

Is, then, an appeal, under the acts in question, a "case"?

There can be no doubt that Congress can confer upon the courts of the District of Columbia (as they have done—act of February 9, 1893, Sec. 8), as well as upon *other* Federal courts, jurisdiction over cases arising under the patent laws: that is, involving *patents.* But this "appeal" to the Court of Appeals takes place *before the patent has issued* and involves *not a patent* but *merely the refusal by the Commissioner to allow an application* or one of two or more applications therefor.

In other words, these appeals, since the law of 1893, are permitted in two instances: where there is but one application for a patent and this is denied by the Commissioner;

and where there are two or more applicants (interference cases) and the appeal is taken by that applicant (or by one of two or more) whose application has been refused by the Commissioner.

In *either*, the Commissioner of Patents has not only exercised his discretion (or, in other words, acted quasi-judicially) as an executive officer, but has exercised his discretion *adversely to the party* who takes the appeal. If the appeal, under these circumstances, is a "case," it is one of a very peculiar nature; for we do not recall any time in the history of the English law, since "the white doe slacked her thirst in the blue waters of the Thames," when an executive officer could be reached in his actions by a court except by *mandamus* and to compel a *ministerial* act only, and that has been the uniform ruling of the Supreme Court of the United States.

But aside from the questions whether a *mandamus* is the only proceeding yet recognized in the courts to reach the acts of an executive officer and whether your Honors desire now to recognize an *appeal* also, let us consider whether this so-called "appeal" is a "case" in other respects.

In Piqua Bank *vs.* Knoup, 6 O. St., 357, Bartley, C. J., says (italics his):

"A *case* in law or equity is a suit or proceeding in court, invoking the exercise of judicial power, and consisting as well of the parties as of their rights. There is a manifest distinction between a *question in law or equity*, and *a case in law or equity*. Although every *case* in law or equity involves a *question*, yet many questions may arise seriously affecting the rights of persons, which do not constitute a case in law or equity. It appears that Chief Justice Marshall, when a member of Congress, in a debate in relation to the famous case of Jonathan Robbins, gave an exposition of the term

'*a case* in law,' as used in the Constitution, in the following words:

"'By the Constitution, the judicial power of the United States is extended to *all cases* in law and equity arising under the Constitution, laws and treaties of the United States; but the resolutions declare the judicial power to extend to *all questions* arising under the Constitution, laws and treaties of the United States. The difference between the Constitution and the resolutions was material and apparent. *A case in law or equity was a term well understood, and of* **limited signification.** It was a controversy between parties that had taken a shape for judicial decision. If the judicial power extended to every *question* under the Constitution, it would involve almost every subject proper for legislative discussion and decision; if to every *question* under the laws and treaties of the United States, it would involve almost every subject upon which the executive could act. The division of power, which the gentleman had said could exist no longer, and the *other departments* would be *swallowed up by the judiciary.* By extending the judicial power to all cases in law and equity, the Constitution had never been understood to confer upon that department any political power whatever. To come within this description, a *question* must assume a legal form for forensic litigation and judicial decision. *There must be parties to come into court who can be* reached by its process, and bound by its power; whose rights admit of ultimate decision by a tribunal to which they are bound to submit. 5 Wheat. Rep., Appendix.'

"This interpretation is unquestionable."

Turning to the Annals of Congress (6th Cong., 1799–1801, 605), we find that this quotation is correct and we find also that, just preceding the quotation, is the following:

"This, Mr. M. said, led to his second proposition, which was:

"That the case was a case for Executive and not Judicial decision. **He admitted implicitly the division of powers,** stated by the gentleman from New York, **and that**

it was the duty of each department to resist the encroachments of the others."

It is very evident, therefore, that, in order to be a "case," the so-called "appeal" must be *an appeal in a "case"*—in which event there must have been a "case" in the Patent Office, or it must be (though called an "appeal" by Congress) *a "case" originally instituted in the Court of Appeals.*

We must inquire then:

1. Is it an *appeal* in a "case"?

It would seem to be so, if a "case" at all; for the acts expressly call it an "appeal," and, moreover, the Court passes upon only "the evidence produced before the Commissioner" (Sec. 4914, R. S.), except that "at the request of any party interested, or of the court, the Commissioner and the examiners may be examined under oath, in explanation of the principles of the thing for which a patent is demanded" (Sec. 4913, R. S.).

But unless your Honors care to deny what seems to be self-evident and what has already been recognized in Butterworth *vs.* Hoe, and care to hold that the Commissioner is a part of the *judiciary* and not of the executive, then there cannot have been a "case" *in the Patent Office;* for in the language of Bartley, C. J., *supra*, "a case in law or equity is a suit or proceeding *in a court.*"

Aside from this, however, the inquiry will be treated under two heads (A and B):

A. Cases in which there is but a *single applicant* for a patent and the Commissioner refuses such application. This, of course, is not the case at bar.

Does the filing of an application for a patent, or even its prosecution in the Patent Office, make it a "case" within the meaning of the Constitution? We think not. It is merely

an *ex-parte* application to the Commissioner, asking that a patent be issued to the applicant, if, in the exercise of his discretion as an executive officer, he shall think the applicant entitled thereto under the law. A "*case*" is a question *contested* before a court of justice (*Ex-parte* Towles, 48 Tex., 413, 433); and "A case in law and equity consists of the right of the *one* party as well as of the *other*, and may truly be said to arise, etc.," says Chief Justice Marshall in Cohens *vs.* Virginia, 6 Wheat., 264, 379.

But here there is clearly *no contestant*—no opposing party—unless it be the Commissioner of Patents. In one sense, of course, the *United States* is an interested party, but it is not a nominal party and could not be sued anyway. And, as to the Commissioner, we find that he has already been judicially determined not to be an opposing party, as we know that he could not be. These cases arose, it is true, under Sec. 4915, R. S., giving relief by bill in equity; but, upon the point in question, they are in every sense precedents.

In The Mergenthaler Linotype Co. *vs.* Seymour, Commissioner of Patents, The Rogers Typographic Company, and Jacob W. Shuckers (January 20, 1894), 66 O. G., 1311, upon a *demurrer to the bill for misjoinder of parties*, Mr. Justice Hagner, of the Supreme Court of the District of Columbia, said:

"Notwithstanding the careful argument of complainant's counsel, I think the Commissioner of Patents was *neither* a *necessary* party *nor* a *proper* party to this bill.

"The complainant insists that the Commissioner should, or at least may, be sued in this case for the reason that he is an adverse party to the present application.

"But I think *the Commissioner can no more*, in any just sense, *be considered as occupying such a relation* to the application, within the meaning of the law, *than the Supreme Court of the District of Columbia* could be so considered. True, the Commissioner has affirmed a decision of his official subordinates which was unfavorable to the pretensions

of the complainant; but his decision was a judicial act [an exercise of discretion, or what is decided in Butterworth *vs.* Hoe to be *quasi*-judicial] just as the ruling of the Supreme Court of the District of Columbia would be when it should affirm or reverse the Commissioner's ruling. It would be a strange proceeding to summon the Court to appear and answer a bill like the present upon the pretense that it was an adverse party."

In Graham *vs.* Teter, 25 F. R, 555, *upon objections for want of parties*, Mr. Justice Bradley, said:

"It is further ordered that the objection that the Commissioner of Patents is not made a party be overruled."

B. Cases in which there are two or more applicants for a similar patent, or for one or more similar claims, and in which an interference has been declared and a decision rendered by the Commissioner in favor of *one* of them. This is the case at bar.

These applications are filed separately. No claim at any time is made *by one applicant against the other;* and, especially, since neither has anything that he can give. *The interference* is *declared* by a *subordinate under the Commissioner* (Sec. 4904, R. S.); and it may afterwards be dissolved by a subordinate, if, in his opinion, the two or more applications, or claims, do not cover the same subject-matter. The interference is not a "case," we submit, within the meaning of Art. III, Sec. 2, but is *declared* and is *put in the form of a case* only for the *convenience* of the Patent Office.

But, supposing that your Honors, despite these arguments and despite the fact that the Commissioner is not a court, should decide that an interference *in the Patent Office* is a "case," even then there is another and entirely distinct objection that arises to the constitutionality of the law of February 9, 1893.

The Fifth Amendment to the Constitution says: "No

person shall * * * be deprived of * * * property without due process of law."

If there is a "case" *in the Patent Office, each* of the parties to it ought to be *cited on the appeal,* and by the officers of the Court of Appeals; and there ought to be some return showing service. "A *citation,* with *due return,* or waiver by general appearance or otherwise, is *indispensable to jurisdiction on appeal*" (Alviso *vs.* U. S., 5 Wall., 824); also, Mead, Ex. *vs.* Platt, Assignee, 17 F. R., 509; Stuart *vs.* Palmer, 74 N. Y., 191, and Witherbee *vs.* Supervisors, 74 N. Y., 234.

Under the law as it now stands, however, the *only notice* of *appeal* which the appellant is required to give is to the *Commissioner* (Sec. 4912, R. S. U. S.); and by *implication* only does the requirement to give *him* notice relate to *interference* cases, because, when this section was enacted, the courts did not have jurisdiction in appeal in such cases.

The only regard paid to the rights of the opposing party or parties to the interference upon the appeal is embodied in Sec. 4913, R. S., viz:

"The court shall, before *hearing* such appeal, give notice to the Commissioner of the time and place of the hearing, and on reciving such notice the Commissioner shall give notice of such time and place in such manner as the court may prescribe, to all parties who appear to be interested therein";

and in Rule XX–4 of the Rules of the Court of Appeals, viz:

"* * * it shall be the duty of the Clerk of this Court to give special notice to the said *Commissioner* at least *fifteen days* immediately preceding the times thus respectively *fixed for the hearing* of said cases; * * * and thereupon the Commissioner shall give notice to the parties interested or concerned by notice addressed to them severally by *mail.*"

It will thus be seen that the opposing parties to the interference have *no notice whatever of the appeal;* and the notice

of the *hearing even* is given by the Clerk to the Commissioner only fifteen days before the hearing, and he is to *mail* the notice to the parties interested. If the parties interested happen to live in California, how much time is thus given them, after receiving notice of the hearing, to engage an attorney, perhaps to send that attorney by rail to Washington, or to engage by mail an attorney in Washington and for that attorney to prepare his argument?

And this is the law as laid down by Congress despite the fact that the appeal is always taken by the applicants, or one of them, who has been *defeated* in the interference proceeding. Whether there is or is not a "case" at all, or whether the so-called "appeal" is an *appeal* from a "case" or a "case" *originally instituted in the Court of Appeals*, the party who was *successful* before the Commissioner in the interference proceeding should be *cited* on the appeal, and not simply given a notice indirectly by mail (or perhaps not given it at all, and certainly not a reasonable time before) of the hearing.

This is so, because a patent has often been decided to be property; and, though, when the appeal is taken, no patent has yet been issued to that patent-applicant whom we claim should be cited on the appeal, invariably and necessarily at that time *his* application for a patent has been *allowed* by the Commissioner and his right thereto settled to such an extent that he has become *vested with property* the deliverance of the evidence of which he can enforce by mandamus (Butterworth *vs.* Hoe). And that Bernardin did have a hearing in the Court of Appeals cannot affect our position, we submit, if the *acts* in question do not, *of themselves, protect* the rights of the *successful* party to the interference in the appeal.

2. Is the so-called "appeal" a "case" originally instituted in the Court of Appeals of the District of Columbia?

The language of the act itself in calling it an "appeal" would seem to answer this question in the negative; and, we submit, that the fact that the parties are limited to the record in the Patent Office *absolutely establishes it.* But, let us inquire further, and under two heads (A and B):

A. Cases in which there is but a single applicant.

We have seen that the Commissioner cannot be considered a proper party, nor is he made so on the record. Yet, of this appeal he only is given notice and it is his attorney who appears to oppose the appellant. He, as seen (Sec. 4913, R. S.), may even be called upon to testify before the court as to the "principles of the thing for which a patent is demanded." What a peculiar situation! Certainly this is not a case within the meaning of the Constitution. In support of our view, we cite *ex-parte* Towles *et al.*, 48 Tex., 413, the syllabus of which reads as follows:

"An *ex parte* proceeding in the district court, by a voter who invokes its jurisdiction, to review the proceedings of a Commissioner's Court in passing upon a contested election for the selection of a county seat of his county, is wanting in all the attributes of a case or suit cognizable in the district court. Such a proceeding has neither subject-matter or *parties* conformable to its jurisdiction."

B. Interference cases.

That these are not "cases" originally instituted is shown by the arguments already made; and, above all, because no *citation*, or *other process*, is issued or served upon the opposing party to and the successful party in the interference in the Patent Office, or *to anybody else*—except the notice of the appeal to the Commissioner. They are not "cases" *de novo*, because the *parties* are bound by the record of the interference in the Patent Office. And they are not "cases" because the parties to the interference may be and usually

are, citizens of the States; and, therefore, the " appeal" does not come within the language, already quoted, of Marshall: "There must be *parties* to come into court who can be *reached by its process* * * *"

Nor, as already submitted, is the Court *acting as a court* within the language of Marshall, *supra:*

"There must be parties to come into court who can be reached by its process and *bound by its power;* whose rights admit of *ultimate decision* by a tribunal to which they are bound to submit."

Along this line, let us call your Honors' attention to what you are doubtless already aware of, viz; that, in the Circuit Courts and Circuit Courts of Appeals of the United States, in infringement cases, though the patent in suit be issued by the Commissioner after an appeal to and a reversal of his decision by the Court of Appeals of the District of Columbia, the questions passed upon by the Commissioner and said Court on appeal are considered *de novo* and *the decision of the Court of Appeals of the District of Columbia considered to be in no way binding upon them.* And this would be so, though the same prior patents, and those only—against the priority of which the Court of Appeals of the District of Columbia may have decided—be cited in defence. Indeed, it is very evident that the *same persons* who have been parties to an interference, although it has been decided in favor of one on appeal by the Court of Appeals of the District of Columbia, may after patent issues, become parties—and the *sole* parties—to an infringement proceeding, and that the *testimony* which was used in the Patent Office previously and on the appeal, and upon which the Court of Appeals of the District of Columbia declared the one person entitled to a patent, may, by stipulation, become the *only testimony* in the infringement suit (except, perhaps, as to the fact of infringement and the

amount of damages or profits); and yet the decision of the Court of Appeals of the District of Columbia *upon that very testimony, taken by the same parties,* will *not be final*—will not be *res judicata.* In like manner, the United States Courts, under a bill in equity (Sec. 4915, R. S.), may, *between the same parties* and *upon the same record* that was passed upon by the Court of Appeals of the District of Columbia, decide the case as if the questions involved, or that record, had never been passed upon by a *court.*

That this is so appears from the law itself (Sec. 4914, R. S.):

"But no opinion or decision of the court in any such case shall preclude *any person* interested from the right to contest the validity of such patent in *any court* wherein the same may be called in question."

The consequence of this is that it must be admitted that, in these so-called "appeals"—whether there be a single application for a patent or two or more (interference cases)—the Court of Appeals of the District of Columbia acts *not as a court* but merely as a *reviewing board* over the acts of an executive officer of the Government.

Mr. Justice Matthews, in Butterworth *vs.* Hoe (though speaking only of appeals where there was but *one* applicant for the patent), himself says (p. 60):

"It is evident that the appeal thus given to the Supreme Court of the District of Columbia [the Court of Appeals was established since this decision] from the decision of the Commissioner, is not the exercise of ordinary jurisdiction at law or in equity on the part of that court, but is one step in the statutory proceeding under the patent laws whereby that tribunal is interposed in aid of the Patent Office, though not subject to it. Its adjudication, though not binding upon any who choose by litigation in courts of general jurisdiction to question the validity of any patent thus awarded, is, nevertheless, conclusive upon the Patent Office itself, * * *."

The learned judge there recognizes that this so-called "appeal" "*is not the exercise of ordinary jurisdiction at law or in equity on the part of that court;*" and what does the language mean if not that the court is *not acting as a court?* It certainly implies that, and to that extent it should be considered by your Honors in arriving at your decision in the case at bar. That Mr. Justice Bradley so recognized, and that, at the same time, he recognized that the acts of Congress gave the judiciary the final "say" over the executive, and yet did not, on those accounts, go further and hold, as we maintain your Honors should *now* hold, that the acts conferring jurisdiction in appeal are unconstitutional, *is of no moment;* because your Honors were not called upon in that case to determine this question, nor did you consider it.

And *if*, in these appeals, the Court of Appeals of the District of Columbia *does not act as a court*, then the power conferred upon it is clearly unconstitutional under the decisions already rendered by your Honors. As expressed by Cooley, in his principles of the Constitution: "Upon judges as such no functions can be imposed except those of a *judicial nature.*"

CONCLUSION.

The conclusion based on the foregoing propositions and authorities is that—

(1) The Constitution of the United States does not permit mingling of the departmental powers of government, but provides for their separation.

This is manifest from the language of the instrument interpreted in the light of the State Constitutions of that

period, as well as from the manifest intention conveyed by the language of the Constitution itself.

(2) The courts have always maintained this distinction regardless of the merits of the case presented.

(3) An appeal from an executive officer to a court is such a mingling of these functions as to be unconstitutional.

(4) The Commissioner of Patents is an executive officer, and his decisions on executive matters are the determinations of an executive officer and not judicial decisions.

The appeal given by the Revised Statutes, sections 4911, 4912, 4913, 4914, and by the ninth section of the Act of Congress, approved February 9, 1893, creating the Court of Appeals of the District of Columbia, is in violation of the constitutional principle contended for, and those Acts which provide for such an appeal are consequently unconstitutional, null and void; and therefore said court is without jurisdiction to hear an appeal from the Commissioner of Patents.

It is admitted that the Commissioner of Patents would issue the patent to the applicant Bernardin, if not restrained and controlled by the finding and decision of the Court of Appeals.

As in the case of Butterworth *vs.* Hoe, Commissioner, so here the Commissioner admits that in his judgment Bernardin is entitled to receive a patent on his application, and that the only reason he refuses to issue the patent is, because the Court of Appeals on the appeal set aside the award and reversed the decision of the Commissioner.

If, as we protest, the Court of Appeals was and is without jurisdiction to review the action of the Commissioner of Patents, the proceeding is void, and the objection urged by

the Commissioner, and his reason for withholding the patent, which he admits Bernardin is entitled to have, and would have but for the action of said Court of Appeals, cannot avail, and we are entitled to the writ ordering the performance of that merely ministerial duty.

All of which is respectfully submitted.

JULIAN C. DOWELL,
GEORGE C. HAZELTON,
Attorneys for Plaintiff in Error.

No. 444.

Appx to Brf. for C. C.

Filed Nov. 21, 1898.

In the Supreme Court of the United States.

In re United States Ex Rel. Alfred L. Bernardin vs. Charles H. Duell, Commissioner of Patents, October Term, 1898, No. ~~164~~ 444.

In Error to the Court of Appeals of the District of Columbia.

OPINION OF COURT OF APPEALS

IN

BERNARDIN vs. SEYMOUR,

10 App. Cas. D. C., 294.

THE UNITED STATES, ex rel. ALFRED L. BERNARDIN, appellant, vs. JOHN S. SEYMOUR, Commissioner of Patents. } No. 603.

1—This is an appeal from a judgment of the Supreme Court of the District of Columbia dismissing a petition for a writ of *mandamus* to the Commissioner of Patents.

The relator, Bernardin, and William H. Northall were parties to an interference proceeding in the Patent Office declared on their respective applications for a patent for an improvement in bottle sealing devices.

The Commissioner of Patents, being of the opinion that Bernardin was the first inventor, rendered a decision in his favor. On appeal to this court, by Northall, the decision of the Commissioner was reversed. Bernardin, denying the jurisdiction of this court to entertain an appeal from the decision of the Commissioner, demanded the patent to which he was entitled thereunder. This demand was refused because of the reversal of that decision by this court and the award of priority to Northall.

The sole question to be determined is, the jurisdiction of this court to entertain appeals from the Commissioner of Patents; for, without setting out the pleadings, it is sufficient to say that they make a case in which the *mandamus* ought to issue, if Congress had not the power to confer that jurisdiction, under the rule laid down in Butterworth v. Hoe 112 U. S. 50.

The argument against the constitutionality of the act of Congress is founded in the complete separation and independence of the powers of government declared in the Constitution.

In the language of Mr. Justice Miller: "It is believed to be one of the chief merits of the American system of written constitutional law, that all the powers intrusted to government, whether State or National, are divided into the three

grand departments, the executive, the legislative and the judicial. That the functions appropriate to each of these branches of government shall be vested in a separate body of public servants, and that the perfection of the system requires that the lines which separate and divide these departments shall be broadly and clearly defined. It is also essential to the successful working of this system that the persons intrusted with power in any one of these branches shall not be permitted to encroach upon the powers confided to the others, but that each shall, by the law of its creation, be limited to the exercise of the powers appropriate to its own department and no other". After noting several exceptions to the general rule expressly provided in the constitution, he says again: "In the main, however, that instrument, the model on which are constructed the fundamental laws of the States, has blocked out with singular precision, and in bold lines, in its three primary articles, the allotment of power to the executive, the legislative and the judicial departments of government. It also remains true, as a general rule, that the powers confided by the Constitution to one of these departments can not be exercised by another". Kilbourn v. Thompson 103 U. S. 168, 190.

The contention on behalf of the appellant is, therefore, that the Commissioner of Patents is an officer of the executive department, clothed with functions and charged with duties executive in their character; and that the exercise of his judgment and discretion therein is beyond the control of the judiciary and can not be conferred thereon by act of the legislative department with the approval of the President.

The question, as presented, is one of importance and its rightful determination is a matter of grave doubt. If resolved against the exercise of the jurisdiction there will doubtless be some embarrassing, if not injurious, consequences; for it has been constantly exercised by the courts of this District since the year 1839, and, of late years especially, many decisions of the courts, upon appeal from the Commissioner of Patents, have been carried into effect and accepted as conclusive and final. Notwithstanding the grave doubt that we entertain of the soundness of our judgment, we are not convinced that it is our duty to declare against the validity of the statute conferring the jurisdiction.

The very fact that we entertain doubt is, of itself, sufficient ground for our action in upholding the power of Congress to enact the law.

"It is our duty, when required in the regular course of judicial proceedings, to declare an act of Congress void if not within the legislative power of the United States; but this declaration should never be made except in a clear case. Every possible presumption is in favor of the validity of a statute, and this continues until the contrary is shown beyond a reasonable doubt. One branch of the government can not encroach on the domain of another without danger. The safety of our institutions depends in no small degree on a strict observance of this statutory rule." Sinking Fund Cases 99 U. S. 700, 718. See also Powell v. Pennsylvania 127 U. S. 678, 684.

The concluding sentences of the foregoing quotation show that the rule therein enounced is founded on the very same principle that lies at the base of the appellant's contention here.

The first act conferring jurisdiction on the court of this District, of appeals from the Commissioner of Patents was approved March 3, 1839 and the same has been exercised, with some changes in procedure only, continuously since that time. During nearly sixty years of existence the validity of the law remained unassailed and unquestioned. Moreover, the validity of this legislation was unmistakably assumed by the Supreme Court of the United States in the very case of Butterworth v. Hoe *supra*, wherein it was held that the express grant of an appeal from the decisions of the Commissioner to the Courts, precluded the exercise of the appellate jurisdiction claimed by the head of the department to which the Patent Office is attached, namely, the Secretary of the Interior.

In consideration of the importance of the question and the points made in the able argument upon which it has been submitted, we think it proper to offer some additional reasons in support of our conclusion.

The Constitution of the United States confers upon Congress the power, "to promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and

discoveries". Art. 1, Sec. VIII. Vested with this power it became the duty of Congress to carry it into execution by appropriate legislation. To that end it was vested with discretion to adopt any means or plan suitable for the purpose not inconsistent with the letter or spirit of the Constitution. McCulloch v. Maryland 4 Wheat 316; Interstate Commerce Com. v. Brimson 154 U. S. 447, 472, 473.

The first act of Congress (A. D. 1790) conferred the power to issue patents upon the Secretaries of State and War and the Attorney General, or any two of them. The act of 1793 authorized them to issue by the Secretary of State upon the certificate of the Attorney General that they conformed to the act; and the parties, in cases of interference, were authorized to select arbitrators for the determination of the controversy. By the act of 1836 the Patent Office was created, in the department of state, and given in charge of an officer called the Commissioner of Patents. Appeals from him were given to a board of examiners. And by section 16 of the same act a remedy by bill in equity was given, as now provided in R. S. sections 4915, 4918.

By the act of March 3, 1839 an appeal was given from the Commissioner to the Chief Justice or either of the Associate Judges of the Circuit Court of the District of Columbia. By the act of 1849 the Patent Office was transferred to the Department of the Interior. Amendments were, from time to time, made in the law, and several tribunals were provided in the office for examination and inquiry into the merits of claims for inventions, with appeal from one to another and then finally to the Commissioner. The appeal from the Commissioner in all cases of refusal of patent was continued in the Courts of the District of Columbia, with such changes as were necessary through the changes made in the judicial system thereof. Finally, by the act approved February 9, 1893, (27 Stat. at Large 434) creating the Court of Appeals of the District of Columbia, the determination of appeals from the Commissioner of Patents as formerly vested in the General Term of the Supreme Court of the District was vested therein and, in addition, it was provided that "any party aggrieved by a decision of the Commissioner of Patents in any interference case may appeal therefrom to said Court of Appeals".—(sec. 9.) It was under

this clause that the appeal was taken in Northall v. Bernardin that is now the subject of discussion.

Under the law, the functions of the Commissioner of Patents are both executive, or administrative, and judicial; the latter preponderating in importance. In matters administrative merely he is under the supervision of the Secretary of the Interior; but when acting judicially, so to speak, his decisions can only be reviewed by the court. Butterworth v. Hoe 112 U. S. 50, 66, 67. In that case Mr. Justice Matthews, after a review of the provisions of the patent law, said: "It thus appears, not only that the judgment and discretion of the Commissioner, as the head of the Patent Office, is substituted for that of the head of the department, but also, that that discretion and judgment are not arbitrary, but are governed by fixed rules of right, according to which the title of the claimant appears from an investigation for the conduct of which ample and elaborate provision is made; and that his discretion and judgment, exercised upon the material thus provided, are subject to review by judicial tribunals whose jurisdiction is defined by the same statute. * * * * * * * It is not consistent with the idea of judicial action that it should be subject to the action of a superior, in the sense in which that authority is conferred upon the head of an executive department in reference to its subordinates. Such a subjection takes from it the quality of a judicial act. That it was intended that the Commissioner of Patents, in issuing, or withholding patents, in re-issues, interferences and extensions, should exercise quasi-judicial functions, is apparent from the nature of the examinations and decisions he is required to make, and the modes provided by law, according to which, exclusively, they may be reviewed".

In the cases of issuing or withholding patents, re-issues, and extensions the judicial function is exercised in investigating the proofs and determining the right as between the claimant, on one hand, of what may be a valuable right of property, and the public, on the other, interested in defeating what may be an unlawful monopoly. In interference cases the proceeding is distinctly judicial. The controversy is waged between adverse claimants of the same right of property and the public has no interest therein. It contains

"all the elements of a civil case—a complainant, a defendant and a judge-*actor, reus et judex*". Fong Yue Ting v. U. S. 149, U. S. 698, 729.

In this view of the most important of the duties developed upon the Commissioner of Patents, there would seem to be no convincing reason why Congress might not have established the Patent Office as a separate and independent, special, judicial tribunal for the investigation of the claims of inventors, and the adjudication of their rights as against the public at large, or adverse claimants of the same invention. Had it seen proper so to do it might then have given, or denied, the right of review to any of the courts of general jurisdiction created by or under Section 1, of Article 3 of the Constitution. In Murray v. Hoboken Land & Imp. Co. 18 How. 272, 284, which was a case involving the validity of a sale of land made by a United States Marshal, under a distress warrant issued by the Solicitor of the United States Treasury against a Collector of Customs, for a debt due the United States, Mr. Justice Curtis, speaking for the entire court, said: "To avoid misconstruction upon so grave a subject, we think it proper to state that we do not consider Congress can either withdraw from judicial cognizance any matter which, from its nature, is the subject of a suit at the common law, or in equity, or admiralty; nor, on the other hand, can it bring under the judicial power a matter which, from its nature, is not a subject for judicial determination. At the same time there are matters, involving public rights, which may be presented in such form that the judicial power is capable of acting on them, and which are susceptible of judicial interpretation, but which Congress may or may not bring within the cognizance of the courts of the United States, as it may deem proper".

The Court of Private Land Claims established, for a limited period, by the Act of March 3, 1891 (26 Stat. 854) is a special tribunal of the kind referred to above; and the act creating it and giving the right of appeal therefrom to the Supreme Court of the United States has been up-held by that court. U. S. v. Coe 155 U. S. 76, 85. In that case it was said by the Chief Justice: "It must be regarded as settled that Section 1 of Article III does not exhaust the power of Congress to establish courts".

Before the creation of the Court of Claims in 1855 there was no way in which the justice of a claim or demand against the United States could be judicially ascertained and established. Congress might recognize and pay them, or not, according to its own view of justice and legality in the premises. It could, and did, also, submit claims to investigation, allowance and payment by the officers of the executive department. Recognizing the justice and expediency of providing a regular tribunal wherein claims against the United States might be investigated, heard and determined, in accordance with the forms of law, the Court of Claims was created and vested with jurisdiction in certain cases of the kind, the scope of which has been increased from time to time. The claims submitted to adjudication were such as no court could take jurisdiction of without the express consent of Congress, because the controversy was with the government. The forms of procedure excluded trial by jury. Appeals taken to the Supreme Court of the United States were determined upon questions of law arising on the findings of fact made by the court. At the same time, by special enactment, any appeal could be made determinable upon both facts and law as in equity cases. Harvey v. U. S. 105 U. S. 671, 691.

Referring to a provision of the act of March 3, 1863, conferring power on the Court of Claims to render judgment against a claimant upon any plea of set-off, counter claim, and so forth, offered by the United States, without trial by jury, Mr. Justice Harlan said: "There is nothing in these provisions which violates either the letter or spirit of the Seventh Amendment. Suits against the government in the Court of Claims, whether reference he had to the claimants demand, or to the defence, or to any set-off, or counter claim which the government may assert, are not controlled by the Seventh Amendment. They are not suits at common law within its true meaning. The government can not be sued, except with its own consent. It can declare in what court it may be sued, and prescribe the forms of pleading and the rules of practice to be observed in such suits. It may restrict the jurisdiction of the court to a consideration of only certain classes of claims against the United States". McElrath v. U. S. 102 U. S. 426, 440.

In Gordon v. U. S. 2 Wall. 561; S. C. 117 U. S. (Appendix) 697, which is one of the cases strongly relied on by the appellant, the majority of the court refused to entertain an appeal from the Court of Claims. The appeal was dismissed on the ground that Congress could not authorize or require the Supreme Court "to express an opinion on a case where its judicial power could not be exercised, and where its judgment would not be final and conclusive upon the rights of the parties, and process of execution awarded to carry it into effect". *In re* Sanborn, also, (148 U. S. 222, 226) the Court held that it had no jurisdiction to entertain an appeal from the Court of Claims because the act authorizing the transmission of the claim for investigation by that court, required its report to be made to the head of the department transmitting the claim, for his information, without being binding upon him. Finding this to be the meaning of the act, the court said: "We regard the function of the Court of Claims, in such a case, as ancillary and advisory, merely. The finding or conclusion reached by that court is not enforceable by any process of execution issuing from the court, nor is it made, by the statute, the final and indisputable basis of action either by the department or by Congress. It is therefore within the scope of the decision of Gordon v. United States". After referring to the cases of U. S. v. Yale Todd and U. S. v. Ferreira, 13 How. 52; wherein the action required of the District Judge, in certain cases, amounted, not to a judgment, but to a mere award, subject to be reviewed by the Secretary of the Treasury, Mr. Justice Shiras, speaking for the court in the same case, (p. 225) said: "Afterwards, and perhaps in view of the conclusion reached by the court in those cases, on March 17, 1866, Congress passed an act giving an appeal to the Supreme Court from judgments of the Court of Claims, and repealing those provisions of the act of March 3, 1863, which practically subjected the judgments of the Supreme Court to the re-examination and revision of the departments, and since that time no doubt has been entertained that the Supreme Court can exercise jurisdiction on appeal from final judgments of the Court of Claims. U. S. v. Alire 6 Wall. 573; U. S. v. O'Grady 22 Wall. 641; U. S. v. Jones 119 U. S. 477".

In an article by Mr. Edward B. Whitney in the Yale Law Review (October 1896) entitled—Federal Judges and Quasi Judges, to which we are much indebted, the various phases of this vexed question, as suggested in the acts of Congress and decisions thereunder, are discussed in an interesting and instructive manner. After quoting from the opinion of Chief Justice Taney in Gordon v. U. S. he says: "A hearing and decision by such a court is strictly judicial in its nature when Congress does permit the United States to be sued; and when its decision is unreviewable by the executive it may be made reviewable by the Supreme Court. Hence, although the Chief Justice rightly said that the Supreme Court's power "is exclusively judicial, and it cannot be required or authorized to exercis any other", nevertheless that court for thirty years past has had and constantly exercised power to review decisions of the Court of Claims when appealed; and by the recent Tucker Act (March 3, 1887) the Circuit and District Courts of the United States now exercise a jurisdiction concurrent with that of the Court of Claims". Turning to later legislation concerning controversies between the government and private persons he says: "Another *quasi*-judicial tribunal, passing upon questions as to which the United States are parties interested, is the Board of General Appraisers sitting at New York. The decisions of this Board as to the valuation of imported goods are final; upon questions of classification they are subject to review by the courts. Their opinions are printed in the Treasury publication entitled Synopsis of Decisions".

In the recent case of Interstate Commerce Commission v. Brimson (154 U. S. 447), where the majority of the court sustained the validity of the 12th section of the Interstate Commerce Act authorizing the Circuit Courts to use their process in aid of inquiries before that Commission, the question as to how far Congress, in the execution of other express powers, can go in imposing upon the Courts of the United States duties in aid of an executive or administrative body, was again exhaustively discussed in both the opinion of the court and the dissenting opinion of Mr. Justice Brewer. Mr. Justice Harlan delivering the opinion for the majority, after a careful statement of the doctrine of the cases of Hay-

burn, Yale Todd, Ferreira and Gordon, upon which the appellant here relies, said: "The views we have expressed in the present case are not inconsistent with anything said or decided in those cases". 154 U. S. p. 485. Again he says, referring to the aid of the court as therein invoked, (p. 487), "The present proceeding is not merely ancillary and advisory. It is not as in *Gordon's case*, one in which the United States seek from the Circuit Court of the United States an opinion that "would remain a dead letter and without any operation upon the rights of the parties". The proceeding is one for determining rights arising out of specified matters in dispute that concern both the general public and the individual defendants". Discussing the nature of this determination he says: "It is none the less the judgment of a judicial tribunal dealing with questions judicial in their nature, and presented in the customary forms of judicial proceedings, because its effect may be to aid an administrative or executive body in the performance of duties legally imposed upon it by Congress in execution of a power granted by the Constitution".

Under the authority of that case a District Judge has been compelled by *mandamus* to compel the attendance of witnesses before special examiners of the Pension Bureau in aid of an investigation of a claim therein. *In re* Lochren 163 U. S. 692.

It can not be claimed that the decision invoked by appeal from the Commissioner of Patents to this Court is not final and conclusive in the matter. "The Commissioner can not question it. He is bound to record and obey it. His failure or refusal to execute it by appropriate action would undoubtedly be corrected and supplied by suitable judicial process. The decree of the court is the final adjudication upon the question of right; every thing after that dependent upon it is merely in execution of it; it is no longer matter of discretion, but has become imperative and enforceable. It binds the whole department, the Secretary as well as the Commissioner, for it has settled the question of title, so that a demand for the signatures necessary to authenticate the formal instrument and evidence of grant may be enforced". Butterworth v. Hoe 112 U. S. p. 60.

Then, if Congress, which seems clear, could have created

a distinct, special tribunal, proceeding after the manner of a court of law or equity, for the adjudication of claims to patents to inventions, there would seem to be no convincing reason why it could not, without violating the Constitution, make it a branch or bureau of an executive department, subject to supervision, in matters administrative only, by the head of that department, and subject to review, in matters judicial in their nature, by a court of competent jurisdiction.

The Constitution simply declares that: "The executive power shall be vested in a President of the United States of America". By Act of Congress, certain executive departments have been created to aid the President in the performance of his duties and to act by his authority. That there may be a distinct line of separation between the duties with which an executive department is charged is clearly stated by Chief Justice Marshall in Marbury v. Madison (1 Cranch 137, 166) from whom we quote: "In such cases their acts are his acts; and whatever opinion may be entertained of the manner in which executive discretion may be used, still there exists, and can exist, no power to control that discretion. The subjects are political. They respect the nation, not individual rights, and being intrusted to the executive, the decision of the executive is conclusive * * * But when the legislature proceeds to impose on that officer other duties; when he is directed peremptorily to perform certain acts; when the rights of individuals are dependent on the performance of those acts; he is so far the officer of the law; is amenable to the laws for his conduct; and can not at his discretion sport away the vested rights of others. The conclusion from this reasoning is, that where the heads of departments are the political or confidential agents of the executive, merely to execute the will of the president, or rather to act in cases in which the executive possesses a constitutional or legal discretion, nothing can be more perfectly clear than that their acts are only politically examinable. But when a specific duty is assigned by law, and individual rights depend upon the performance of that duty, it seems equally clear that the individual who considers himself injured, has a right to resort to the laws of his country for a remedy". The pro-

priety then of judicial interference seems determinable "not by the office of the person, but the nature of the thing to be done". Idem p. 170. It was in view of such a distinct division between the two classes of duties imposed upon the Commissioner of Patents by the Acts of Congress that the conclusion was reached in Butterworth v. Hoe. The supervision of the Secretary of the Interior was held in that case to be limited to matters purely administrative; matters judicial in their investigation and determination were declared to be under the supervision of the courts. "It is not consistent", said Mr. Justice Matthews, "with the idea of judicial action that it should be subject to the direction of a superior, in the sense in which that authority is conferred upon the head of an executive department in reference to his subordinates."

Without further prolonging the discussion of this interesting question and admitting that we are not without doubt in respect of the soundness of our judgment, we repeat that we have not been able to see our way to the conclusion urged upon us; namely, that the act conferring the right of appeal to this court from the decisions of the Commissioner of Patents is beyond the power of Congress to enact, for the reason that it oversteps the boundaries erected by the Constitution between the three great departments of the government.

The judgment will therefore be affirmed with costs; and it is so ordered.

Affirmed.

SETH SHEPARD,
Associate Justice.

Endorsed: No. 603. The U. S. ex rel. Alfred L. Bernardin, appellant vs. John S. Seymour, Commissioner of Patents. Opinion of the Court per Mr. Justice Shepard. Court of Appeals, District of Columbia, Filed Mar. 1, 1897, Robert Willett, Clerk.

A true copy
Test: ROBERT WILLETT
[SEAL] Clerk.

No. 444.

FILED
DEC 1 1898
JAMES H. McKENNEY,
Clerk

Reply Brf. of Dowell & Hazelton for

In the Supreme Court of the United States. O. C.

Filed Dec. 1, 1898.

THE UNITED STATES *ex rel.*
ALFRED L. BERNARDIN,
Plaintiff in Error,

vs.

CHARLES H. DUELL, Commissioner of Patents.

October Term, 1898.
No. 444.

IN ERROR TO THE COURT OF APPEALS OF THE DISTRICT OF COLUMBIA.

Reply to Brief for Assignee of William H. Northall.

JULIAN C. DOWELL,
GEORGE C. HAZELTON,
Attorneys.

BYRON S. ADAMS, PRINTER.

IN THE SUPREME COURT OF THE UNITED STATES.

THE UNITED STATES *ex Rel.*
ALFRED L. BERNARDIN,
Plaintiff in Error,
vs.
CHARLES H. DUELL, Commissioner of Patents.

October Term, 1898.
No. 444.

REPLY TO BRIEF FOR ASSIGNEE OF WILLIAM H. NORTHALL.

We beg to submit the following reply to the brief of counsel for the assignee of William H. Northall.

Said brief is in substance the same and the authorities cited therein are the same as those cited in the brief for Northall filed in the Court of Appeals of the District of Columbia, and the propositions presented are in the main answered by our main brief.

That the Commissioner of Patents is not a judge, nor his office a court, but that he is an officer of the executive department, charged with duties which are executive in their character and which are not judicial in the sense of the Constitution under which judicial power can be exercised by the courts only in the cases enumerated in that instrument, is shown by the authorities cited in our main brief, more particularly following pages 11, 23, 42 and 56.

"The secretary of state is, in the act of making out patents, a mere ministerial officer, and can exercise no power which is not expressly given." (Grant *vs.* Raymond, 6 Pet., 241.)

Our brother Wilson has fallen into the error of supposing that we have overlooked Section 8 of the Constitution, which provides that "Congress shall have power to promote the progress of science and useful arts," &c. (see page 2 of Brief

for assignee of Northall), and he suggests that it is left entirely with Congress to designate or appoint the *means* or instrumentalities to which it will resort in the exercise of the power granted by said section of the Constitution.

As stated at page 57 of our main brief, there is no question that Congress is authorized to select such means as may be deemed fit and appropriate for carrying out and into effect such power, *always provided the means and agency so selected are not in contravention of the letter or spirit of the Constitution itself.* (See Brief for Plaintiff in Error, pp. 57, 58, and 61.)

We do not desire to add anything further to what has already been said in our main brief, in answer to the brief for the assignee of Northall, except in respect to the contention that another remedy is afforded by section 4915 of the Revised Statutes, and that therefore the petition for mandamus cannot be entertained.

This same question was raised, and the same authorities cited by our brother Wilson in his brief on the appeal to the Court of Appeals. In disposing of the question the court said:

* * * "Without setting out the pleadings, it is sufficient to say that they make a case in which the *mandamus* ought to issue if Congress had not the power to confer that jurisdiction." * * * (Bernardin *vs.* Seymour, 10 App. Cases D. C., 294.)

Moreover, in the case of Butterworth *vs.* Hoe, 112 U. S., 50, the writ of mandamus was granted, although the same remedy existed that is now urged against the case at bar.

The rule of law as settled does not sustain our brother Wilson's contention. That point was made in the case of Butterworth *vs.* Hoe, but this Court said, No; that the legal right of the petitioner was to have issued to him a patent, and the Commissioner was without excuse in refusing to issue it. There remained only the administrative act to prepare the patent, and the excuse for not doing so was that an *appeal* had been taken as in this case. But there was no

jurisdiction to entertain an appeal, and hence the reason given by the Commissioner for refusing to issue the patent was not tenable and the mandamus was granted.

In the case at bar, if the appellate tribunal was and is without jurisdiction it follows, of course, that the Commissioner has not offered any legal excuse for his refusal to perform the administrative act demanded, and therefore this Court will direct that he issue the patent.

Furthermore, the prerequisities which counsel for the assignee of Northall contends, at page 14 of his brief, are essential to warrant a court in granting the mandamus, are present in the case at bar, assuming, of course, that the Act of Congress conferring the right of appeal to the Court of Appeals of the District of Columbia from the decisions of the Commissioner of Patents is unconstitutional, as we respectfully submit it is, for in that event the relator has "a clear legal right to the performance of the particular act or duty at the hands of the respondent," and second, "the law affords no other adequate or specific remedy to secure the enforcement of the right and the performance of the duty which it is sought to coerce."

"Where the right is clear and specific and public officers or tribunals refuse to comply with their duty, a writ of mandamus issues for the very purpose of enforcing specific relief. It is the inadequacy and not the mere absence of all other legal remedies and the danger of a failure of justice without it that must usually determine the propriety of this writ, and it is not excluded by other legal remedies which are not adequate to secure the specific relief needed nor by the existence of a specific remedy in equity." (Am. & Eng. Encyclopædia of Law p. 102; citing LaGrange *vs.* State Treasurer, 24 Mich. 469; People *vs.* New York, 10 Wend. (N. Y.), 395; People *vs.* State Treasurer, 23 Mich. 499; Klokke *vs.* Stanley, 109 Ill., 192; Tawas, etc., R. Co. *vs.* Iosco Circuit Judge, 44 Mich, 479.)

"The mere fact that the statute provides a remedy does not, however, supersede the remedy by mandamus. The relator must not only have a specific, adequate and legal remedy, but it must be one competent to afford relief upon

the very subject-matter of his application; and if it be doubtful whether such statutory remedy will afford him a complete remedy, the writ should issue." (Encyclopædia of Law, Vol. 14, pp. 101–102; citing Freement *vs.* Crippen, 10 Cal., 211; State *vs.* Wright, 10 Nev., 167; Etheridge *vs.* Hall, 7 Port. (Ala.), 47; *In re* Trustees of Williamsburgh, 1 Barb. (N. Y.), 34; Babcock *vs.* Goodrich, 47 Cal., 488; People *vs.* State Treasurer, 24 Mich., 469.)

"By a remedy at law such as will operate as a bar to mandamus is understood such a remedy as will enforce a right or the performance of a duty, and unless it reaches the end intended and actually compels a performance of the duty in question, it is not an adequate remedy within the meaning of the rule. High on Extraordinary L. Rem., Par. 17; Overseers of Porter Twp. *vs.* Overseers of Jersey Shore, 82 Pa. St., 275." (*Ibid.*, p. 102.)

We respectfully submit that our brother's contention in regard to the equity proceeding is untenable and not sustained by the authorities, and that the writ of mandamus is the proper and only adequate remedy afforded for the enforcement of the duty sought to be enforced.

"A court of equity is sometimes resorted to as ancillary to a court of law in obtaining satisfaction of its judgments. But no court having proper jurisdiction and process to compel the satisfaction of its own judgments can be justified in turning its suitors over to another tribunal to obtain justice. **It is no objection, therefore, to the use of this remedy, that the party might possibly obtain another by commencing a new litigation in another tribunal.**" (Board of Comm. of Knox County *vs.* Aspinwall, 24 How., 385; 4 U. S., 186.)

And on the main question we further respectfully submit that the cases we have cited in our main brief, from this Honorable Court and from the Courts of the States, clearly sustain our contention.

Respectfully submitted.

JULIAN C. DOWELL,
GEORGE C. HAZELTON,
Attorneys.

No. 444.

Add'l. Brf. of Dowell & Hazelton for

Filed Dec 7, 1898.

Supreme Court of the United States.

OCTOBER TERM, 1898.

THE UNITED STATES *ex rel.* ALFRED L. BERNARDIN, *Plaintiff in Error*,

vs.

CHARLES H. DUELL, Commissioner of Patents, *Defendant in Error*.

No. 444.

Additional Points for Plaintiff in Error on Oral Argument.

JULIAN C. DOWELL,
GEORGE C. HAZELTON,
Attorneys for Plaintiff in Error.

BYRON S. ADAMS, PRINTER.

IN THE SUPREME COURT OF THE UNITED STATES.

October Term, 1898.

THE UNITED STATES *ex rel.* ALFRED L. BERNARDIN, *Plaintiff in Error*,

vs.

CHARLES H. DUELL, Commissioner of Patents, *Defendant in Error.*

No. 444.

Additional Points for Plaintiff in Error on Oral Argument.

I.

Can the plaintiff in error, having had and not availed himself of the opportunity, by motion to dismiss, upon the appeal by Northall from the Commissioner's decision, to question the constitutionality of that "appeal," question it now in a mandamus proceeding in the Supreme Court of the District?

This point was not raised by either the court or opposing counsel at any of the hearings before the Supreme Court of the District or the Court of Appeals; and this is the reason it has not heretofore been considered.

The failure to raise the question of the constitutionality of this "appeal" at the time the "appeal" was taken and the submission by the plaintiff in error to the jurisdiction of the

Court of Appeals upon that "appeal," did not, of course, *confer* jurisdiction upon the Court of Appeals; for, if a court has no jurisdiction over the *subject matter*, the *appearance* of the *parties* can not confer it.

Moreover, such failure and submission would not have been considered a *waiver* of the right to raise that question *at any stage* of the proceedings, had it been possible to carry that "appeal," and had in fact that "appeal" been carried to a higher Court (the Supreme Court). (See Parker *vs.* Ramsby, 141 U. S., 81 and Mex. R. R. Co. *vs.* Davidson, 157 U. S., 201.)

Nor were such failure and submission a *waiver* of the right to raise that question *in other than the same proceedings*, or, in other words, *collaterally*. (See Rose *vs.* Himely, 4 Cr., 241; Elliot *vs.* Piersol, 1 Pet., 328; Hickey *vs.* Stewart, 3 How., 750; Christmas *vs.* Russell, 5 Wall., 290; Thompson *vs.* Whitman, 18 Wall., 457; and Bissell *vs.* Briggs, 9 Mass., 462.)

In Rose *vs.* Himely, in passing upon the jurisdiction of a foreign court, inquired into in a circuit court, Chief Justice Marshall said:

> "Upon principle, then, it would seem that, to a certain extent, the capacity of the court to act upon the thing condemned, arising from its being within, or without, their jurisdiction, as well as the constitution of the court, may be considered by that tribunal which is to decide on the effect of the sentence."

In Elliott *vs.* Piersol, the jurisdiction of a county court was inquired into in the circuit court. Trimble, J., said:

> "But if it act without authority, its judgment and orders are regarded as nullities. They are not voidable, but simply void. * * *
>
> "* * * The jurisdiction of any court exercising authority over a subject may be inquired into in every court, where the proceedings of the former are relied on and brought before the latter by the party claiming the benefit of such proceedings."

In Hickey *vs.* Stewart, the original decision had been rendered by the Supreme Court of Mississippi, and it was questioned in

the Circuit Court for the Southern District of Mississippi. The Court said:

> " * * * That Court had no jurisdiction over the subject-matter, and * * * the whole proceeding is a nullity."

In Christmas *vs.* Russell, the Circuit Court of Mississippi inquired into the jurisdiction of a State court in Kentucky.

In Thompson *vs.* Whitman, the Circuit Court in New York inquired into the jurisdiction of a New Jersey court.

In Bissell *vs.* Briggs, the Supreme Judicial Court of Massachusetts inquired into the jurisdiction of the Superior Court of Judicature of New Hampshire.

This leaves us to inquire only whether, considering the relationship which exists between the Supreme Court of the District and the Court of Appeals *as its appellate court*, this question of the jurisdiction of the Court of Appeals may be passed upon by the Supreme Court of the District under the circumstances *of the case at bar.*

We are willing to admit that, had the question of the constitutionality of this "appeal" *been raised* in the Court of Appeals upon the "appeal" from the Commissioner and *been passed* upon, its decision upon that point would have been final, so far as *the Supreme Court of the District* is concerned, so that we could not have raised the same question afterwards upon a mandamus proceeding instituted in the Supreme Court of the District. This would be so, because, if not so, the lower court, under such circumstances, would have an opportunity primarily to overrule its superior court, while, at the same time, the decision of the lower court would be subject on appeal to the review of the upper court; and the presumption of the law being that a court will reaffirm its own previous holdings, this would be *useless litigation.*

The Court of Appeals did not, however, pass upon its jurisdiction on the appeal from the Commissioner; so that, when the petition for mandamus was filed, *there was no decision of the Court of Appeals upon that question.* The only points passed

upon by that Court were those contained in the record transmitted from the Patent Office.

Under such circumstances, even had the Supreme Court of the District (as it did not), upon the petition for mandamus, held that the Court of Appeals had no jurisdiction over the appeal from the Commissioner, its decision would not have been an attempt to overrule, and would not have even primarily overruled, any decision of the Court of Appeals, its superior court; because, first, the Court of Appeals had not passed upon the constitutionality of the "appeal," and secondly, because, *so far as this jurisdicton on "appeal" is concerned*, the Court of Appeals is not an appellate court over the Supreme Court of the District.

That our position is sound, we refer your Honors to People *vs.* Clark, 1 Park. Cr. C. (N. Y.), 360, wherein Justices Edwards, Mitchell and Roosevelt sat. It appears that the trial court found the defendant guilty; that a new trial was awarded by the Supreme Court; and that this order was vacated by the Court of Appeals. The defendant was not present in the Court of Appeals when they heard the argument; and that court did not pass upon the question whether they had jurisdiction over him under such circumstances. This question, however, was raised in the Supreme Court after the decision had been rendered by the Court of Appeals; and Mitchell, J., said:

> "The prisoner's counsel very properly refrained from addressing to the court a single argument against the decision of the higher court, on the point on which the court and this differed. If the appellate court had jurisdiction, its decision became the law of the case; * * *. But the question whether the Court of Appeals had jurisdiction, was very properly argued before us. * * * In this case, the question now presented, whether in a criminal case, where the punishment is to be corporeal, any court has jurisdiction over the prisoner unless he be brought before it, was never brought before that court, and so that court did not 'decide upon its own jurisdiction in that respect.' The question, therefore, remains open."

Along the same line, though not directly in point, is Davis *vs.* Packard, 8 Pet., 312.

That we have not been able to find any other case directly in point than People *vs.* Clark is not strange; because usually no case reaches a superior court except as it comes from an inferior court; and under such circumstances, it is usually the jurisdiction of the lower court which is inquired into, or, if not, the superior court passes *directly* upon its own jurisdiction.

And we submit that, upon principle, there can be no objection to the Supreme Court of the District in the case at bar passing upon the jurisdiction of the Court of Appeals. As already shown, it has been repeatedly held that an United States court, either of the same or of a different State, may inquire into the jurisdiction of a State court, or a State court into the jurisdiction of a court of another State. In these cases no opportunity is given to the court whose jurisdiction is inquired into to vindicate that jurisdiction; while, in the case at bar, even had the Supreme Court of the District upon the petition for mandamus determined that the Court of Appeals had no jurisdiction on the "appeal," the Court of Appeals, upon an appeal, would have had the final "say" (as it did, except for the writ of error now before the Supreme Court) as to its own jurisdiction.

The foregoing arguments are based upon the supposition that, had the question of the constitutionality of this "appeal" been raised by a motion to dismiss at the time of the "appeal," that question could have been carried to the Supreme Court. Still more ought the mandamus to be sustained, if it could not; for, if the question could not have been carried to the Supreme Court at that time, then it is clear that this mandamus afforded and affords the only chance to bring the question before the Supreme Court.

II.

A mandamus will not lie if there is another adequate remedy.

We fully recognize this principle. It means, however, if there is another adequate remedy at the time the petition for mandamus is filed. It does not mean, if there *was* a remedy at a *previous time.* And it is certain that the petition for man-

damus in the case at bar was not filed until after the "appeal" by Northall to the Court of Appeals had been determined.

As to whether we had any other adequate remedy at the time the petition for mandamus was filed, so that the mandamus will not lie, we refer to our brief in reply to that of Mr. Wilson, and also to Section V of the "Additional Points by the Solicitor General on Oral Argument," which is as follows:

"V.

"If any section is open to the objection that it does not provide sufficiently for carrying into effect the decision of the court, it is section 4915, which simply provides that 'such adjudication, if it be in favor of the right of the applicant, shall *authorize* the Commissioner to issue such patent on the applicant's filing in the Patent Office a copy of the adjudication and *otherwise complying with the requirements of law.*'

"My information from the Patent Office is that an adjudication under section 4915 is not recognized as being a final and conclusive determination that a patent shall and must issue to the successful applicant before the court. After a copy of the adjudication is filed in the Patent Office, there still remains in the Commissioner the discretion to pass upon the question whether the applicant has otherwise complied with the requirements of law."

III.

On the hearing, counsel for plaintiff in error stated, in answer to a question of Mr. Justice White, that, though a decision be rendered by the Court of Appeals of the District of Columbia in favor of a party to an interference and a patent be issued to such party in accordance with the decision of that Court, the question of priority of invention may nevertheless be raised and determined in a subsequent proceeding between the same parties; and (if the defendant is a citizen of the District) even in the Supreme Court of the District, though a court inferior to the Court of Appeals.

This is evident from Secs. 4914 and 4915 R. S., and from Cochrane *vs.* Deener, 94 U. S., 780, and The Mergenthaler Linotype Co. *vs.* Seymour, etc., 660 O. G., 1311.

"The statute is not ambiguous. It gives a court of equity power to decide between interfering patents, **with-**

out any exception or limitation." (Machine Co. *vs.* Crane, 1 Ban. & A., 494, Fed. Cas. No. 14,388; Wheaton *vs.* Kendall, 85 Fed. Rep., 671.)

More than this, questions which might have been raised but were not raised in the interference proceeding, may be raised in the proceeding in equity.

> "The failure of a party in an interference proceeding in the Patent Office to raise the question whether his opponent's invention includes the issue declared in the interference does not estop such party to raise that question in an equity suit under Rev. St., Sec. 4915, to determine his right to a patent." (Christy *vs.* Seybold, 55 Fed. Rep., 69.)

The latter case was an appeal from the Circuit Court of the United States for the District of Kentucky to the Circuit Court of Appeals for the Sixth Circuit. J. Taft, Circuit Court Judge, said:

> "The interference issue is drawn up by the Patent Office Examiner and the interference is declared before either party has access to the specifications of the other and the claims made with respect to the issue are submitted before the specifications are disclosed. Subsequently, perhaps, the question (whether an opponent's invention includes the issue declared in the interference) might be raised, but we do not think that failure to raise it in the Patent Office prevents its being brought to the attention of the court in a proceeding like this by independent bill."

> "In a suit between interfering patentees under Rev. St., Sec. 4918, the decision of the Patent Office in favor of one of the parties is not *res adjudicata* upon the question of priority of invention between them, and a bar to further litigation in the Circuit Court." (Hubel *vs.* Tucker *et al.*, 24 Fed. Rep., 701.)

IV.

In the preface to McArthur's Patent Cases, Vol. I, p. V, the author, in commenting on appeals from the decisions of the

Commissioner to the Supreme Court of the District of Columbia, sitting in general term, says:

> "In their anomalous relations with an executive department the judges do not exercise the purely judicial functions of a court of record. The judgment is recorded in the Patent Office and controls the further proceedings of the Commissioner, but does not preclude any person interested from renewing the contest in another forum."

All of which is respectfully submitted.

JULIAN C. DOWELL,
GEORGE C. HAZELTON,
Attorneys for Plaintiff in Error.

In the Supreme Court of the United States.

OCTOBER TERM, 1898.

THE UNITED STATES EX REL. ALFRED L. Bernardin, plaintiff in error,
v.
CHARLES H. DUELL, COMMISSIONER OF Patents, defendant in error.
} No. 444.

BRIEF FOR THE DEFENDANT IN ERROR.

STATEMENT.

THE CASE.

The question arose in this way. In an interference proceeding in the Patent Office between Bernardin and Northall, the Commissioner decided in favor of Bernardin. Northall, under sections 4911 et seq., Revised Statutes, appealed to the court of appeals for the District of Columbia, which reversed the decision of the Commissioner, finding in favor of Northall. Bernardin then insisted

that the provisions for an appeal to the court are void and inoperative because repugnant to the Constitution, and instituted this proceeding in mandamus to compel the Commissioner to issue a patent to him.

It is to be noted that since the decision of the court of appeals of the District in the interference case, Bernardin has filed a bill in equity in the circuit court of the United States for the district of Indiana, under section 4915, Revised Statutes, to secure the patent, despite the reversal of the decision of the Commissioner based upon the action of the court of appeals. (Record, pp. 42–48).

THE QUESTION.

The question is, has Congress power to authorize the court of appeals of the District of Columbia to review the action of the Commissioner of Patents in an interference case?

The appellant contends that the Commissioner of Patents is an executive officer, and that his action in determining which of two claimants is entitled to a patent is an executive act, which can not be reviewed by a judicial tribunal.

The Government concedes that the Commissioner of Patents is an executive officer, but denies that his action in the case stated is of a purely administrative or executive character, insisting, on the contrary, that it is essentially of a judicial nature, involving the exercise of judgment and discretion upon questions of law and fact, in matters of right, which affect the individuals concerned, as well as the public, and may therefore be properly subjected, on appeal, to the review of a court.

THE STATUTES.

The following are the statutes involved in this case:

Sections 4911 to 4914, inclusive, provide for an appeal from the decision of the Commissioner, in patent cases, except where an interference is declared, to the supreme court of the District of Columbia.

Section 4915 provides the remedy by bill in equity where an application for patent is refused.

Section 780 is the general provision in the statutes relating to the District of Columbia, which gives the supreme court of the District, sitting in banc, jurisdiction of appeals from the Commissioner.

Section 9 of the act creating the court of appeals for the District vests in that court the jurisdiction on appeal from the decisions of the Commissioner formerly exercised by the supreme court of the District, sitting in banc, *and also provides for an appeal in interference cases.*

> SEC. 4911. If such party [an applicant for a patent or reissue, or a party to an interference, see section 4909], except a party to an interference, is dissatisfied with the decision of the Commissioner, he may appeal to the supreme court of the District of Columbia, sitting in banc.
>
> SEC. 4912. When an appeal is taken to the supreme court of the District of Columbia, the appellant shall give notice thereof to the Commissioner, and file in the Patent Office, within such time as the Commissioner shall appoint, *his reasons of appeal*, specifically set forth in writing.
>
> SEC. 4913. The court shall, before hearing such appeal, *give notice to the Commissioner* of the time

and place of the hearing, and on receiving such notice *the Commissioner shall give notice of such time and place* in such manner as the court may prescribe, *to all parties who appear to be interested therein.* The party appealing shall lay before the court certified copies of all the original papers and evidence in the case, and the Commissioner shall furnish the court with the grounds of his decision, fully set forth in writing, touching all the points involved by the reasons of appeal. And *at the request of any party interested,* or of the court, *the Commissioner and the examiners may be examined under oath,* in explanation of the principles of the thing for which a patent is demanded.

SEC. 4914. The court, on petition, shall hear and determine such appeal, and revise the decision appealed from in a summary way, on the evidence produced before the Commissioner, at such early and convenient time as the court may appoint, and the revision shall be confined to the points set forth in the reasons of appeal. After hearing the case the court shall return to the Commissioner a certificate of its proceedings and decision, which shall be entered of record in the Patent Office, *and shall govern the further proceedings in the case.* But no opinion or decision of the court in any such case shall preclude any person interested from the right to contest the validity of such patent in any court wherein the same may be called in question.

SEC. 4915. Whenever a patent, on application is, refused, either by the Commissioner of Patents or by the supreme court of the District of Columbia, upon appeal from the Commissioner, the applicant may have remedy by bill in equity; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge

that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim, or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the Commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication and otherwise complying with the requirements of law. In all cases, where there is no opposing party, a copy of the bill shall be served on the Commissioner, and all the expenses of the proceeding shall be paid by the applicant, whether the final decision is in his favor not.

SEC. 780 (Revised Statutes relating to District of Columbia, etc.). The supreme court, sitting in banc, shall have jurisdiction of, and shall hear and determine, all appeals from the decisions of the Commissioner of Patents, in accordance with the provisions of sections forty-nine hundred and eleven to section forty-nine hundred and fifteen, inclusive, of chapter one, Title LX, of the Revised Statutes (Patents, Trade-marks, and Copyrights).

(27 Stat., p. 436, act creating court of appeals for the District of Columbia.)

SEC. 9. That the determination of appeals from the decision of the Commissioner of Patents, now vested in the general term of the supreme court of the District of Columbia, in pursuance of the provisions of section seven hundred and eighty of the Revised Statutes of the United States, relating to the District of Columbia, shall hereafter be and the same is hereby vested in the court of appeals created by this act; and in addition, any party aggrieved by a decision of the Commissioner of Patents *in any interference case* may appeal therefrom to said court of appeals.

ARGUMENT.

I.

WHERE THE CONSTITUTIONALITY OF A LAW IS INVOLVED, EVERY POSSIBLE PRESUMPTION IS IN FAVOR OF ITS VALIDITY, AND THIS CONTINUES UNTIL THE CONTRARY IS SHOWN BEYOND A REASONABLE DOUBT.

"Every possible presumption," said Mr. Chief Justice Waite, speaking for the court in the *Sinking Fund Cases* (99 U. S., 700, 718), "is in favor of the validity of a statute, and this continues until the contrary is shown beyond a reasonable doubt. One branch of the Government can not encroach on the domain of another without danger. The strength of our institutions depends in no small degree on a strict observance of this salutary rule."

In *Powell* v. *Penna.* (127 U. S., 678, 684), the court, speaking by Mr. Justice Harlan, quotes this language with approval, and cites also *Fletcher* v. *Peck* (6 Cranch, 87, 128); *Dartmouth College* v. *Woodward* (4 Wheat., 518, 625); *Livingston* v. *Darlington* (101 U. S., 407).

II.

THE CONSTITUTION CONFERS UPON CONGRESS POWER TO PROVIDE FOR THE ISSUE OF PATENTS TO INVENTORS.

Section 8 of Article I of the Constitution, the same section which empowers Congress to regulate commerce with foreign nations and among the several States, provides expressly that Congress shall have power:

> To promote the progress of science and useful arts by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries.

III.

CONGRESS MAY MAKE ALL LAWS WHICH SHALL BE NECESSARY AND PROPER FOR CARRYING INTO EXECUTION THE FOREGOING POWER.

Under the last clause of section 8 of Article I of the Constitution, Congress is given power "to make all laws which shall be necessary and proper for carrying into execution the foregoing powers," etc. Thus Congress has power to do whatever is necessary, or seems to it necessary, to carry into effect an express power.

In the great case of *McCulloch* v. *Maryland* (4 Wheaton, 316, 421), Mr. Chief Justice Marshall laid down the rule, which has been followed ever since:

> The sound construction of the Constitution must allow to the national legislature that discretion, with respect to the means by which the powers it confers are to be carried into execution, which will enable that body to perform the high duties assigned to it in the manner most beneficial to the people. *Let the end be legitimate, let it be within the scope of the Constitution, and all means which are appropriate, which are plainly adapted to that end, which are not prohibited, but consistent with the letter and spirit of the Constitution, are constitutional.*

IV.

THE SELECTION OF THE MEANS RESTS WITH CONGRESS. UNLESS THESE MEANS ARE FORBIDDEN BY THE CONSTITUTION, THE COURTS WILL NOT INTERFERE.

In the case of *McCulloch* v. *Maryland*, already cited, Mr. Chief Justice Marshall said (page 423):

> *Where the law is not prohibited, and is really calculated to effect any of the objects intrusted to the Gov-*

ernment, to undertake here to inquire into the degree of its necessity would be to pass the line which circumscribes the judicial department, and to tread on legislative ground. This court disclaims all pretensions to such a power.

This language was quoted with approval by Mr. Justice Gray, speaking for the court in the recent case of *Fong Yue Ting* v. *U. S.* (149 U. S., 698, 712), and also by Mr. Justice Harlan, who delivered the opinion of the court in the later case of the *Interstate Commerce Commission* v. *Brimson* (154 U. S., 447, 472), with the following additional language (p. 473):

> It is a settled principle of constitutional law that "the Government which has a right to do an act, and has imposed upon it the duty of performing that act, must, according to the dictates of reason, be allowed to select the means; and those who contend that it may not select any appropriate means, that one particular mode of effecting the object is excepted, take upon themselves the burden of establishing that exception." (4 Wheat., 316, 409.) The test of the power of Congress is not the judgment of the court that particular means are not the best that could have been employed to effect the end contemplated by the legislative department. The judiciary can only inquire whether the means devised in the execution of a power granted are forbidden by the Constitution. It can not go beyond that inquiry without intrenching upon the domain of another department of the Government. That it may not do with safety to our institutions. (*Sinking Fund Cases*, 99 U. S., 700, 718.)

V.

HOW CONGRESS HAS EXERCISED ITS DISCRETION IN PROVIDING, AND CHANGING FROM TIME TO TIME, THE MEANS FOR ISSUING PATENTS.

In the case of *Butterworth* v. *Hoe* (112 U. S., 51), which will be discussed later, Mr. Justice Matthews, speaking for the court, gives the following account of patent legislation (page 64):

> The first statute on the subject of patents, act of 1790, ch. 7, 1 Stat., 109, authorized their issue by the Secretary of State, the Secretary for the Department of War, and the Attorney-General, or any two of them, "if they shall deem the invention or discovery sufficiently useful and important."
>
> The act of 1793, ch. 11, 1 Stat., 318, which next followed, authorized them to be issued by the Secretary of State, upon the certificate of the Attorney-General that they are conformable to the act. The ninth section of the statute provided for the case of interfering applications, which were to be submitted to the decision of arbitrators, chosen one by each of the parties and the third appointed by the Secretary of State, the decision or award of two of whom should be final as respects the granting of the patent.
>
> This continued to be the law until the passage of the act of 1836, chapter 357, 5 Stat., 117, creating in the Department of State the Patent Office, "the chief officer of which shall be called," it says, "the Commissioner of Patents," and "whose duty it shall be, under the direction of the Secretary of State, to superintend, execute, and perform all such acts and things touching and respecting the granting and issuing of patents for new and useful discoveries,

inventions, and improvements as are herein provided for or shall hereafter be by law directed to be done and performed," etc. By that act it was declared to be the duty of the Commissioner to issue a patent if he "shall deem it to be sufficiently useful and important," the very discretion previously vested in the three heads of departments by the act of 1790; and, in case of his refusal, the applicant was (sec. 7) secured an appeal from his decision to a board of examiners, to be composed of three disinterested persons, appointed for that purpose by the Secretary of State, one of whom, at least, to be selected, if practicable and convenient, for his knowledge and skill in the particular art, manufacture, or branch of science to which the alleged invention appertained. The decision of this board being certified to the Commissioner, it was declared that "he shall be governed thereby in the further proceedings to be had on such application." A like proceeding, by way of appeal, was provided in cases of interferences. By section 16 of the act a remedy by bill of equity, as now given in sections 4915, 4918, Revised Statutes, was given as between interfering patents or whenever an application shall have been refused on an adverse decision of a board of examiners. By section 11 of the act of 1839, chapter 88, 5 Statutes, 354, as modified by the act of 1852, chapter 107, 10 Statutes, 75, it was provided that in all cases where an appeal was thus allowed by law from the decision of the Commissioner of Patents to a board of examiners the party, instead thereof, should have a right to appeal to the chief justice or to either of the assistant judges of the circuit court of the United States for the District of Columbia; and by section 10 the provisions of section 16 of the

act of 1836 were extended to all cases where patents are refused for any reason whatever, either by the Commissioner or by the chief justice of the District of Columbia upon appeals from the decision of the Commissioner, as well as where the same shall have been refused on account of or by reason of interference with a previously existing patent.

In this state of legislation the Patent Office, by the act of 1849, chapter 108, 9 Statutes, 395, was transferred to the Department of the Interior, the Secretary of which, it was enacted, "shall exercise and perform all the acts of supervision and appeal in regard to the office of Commissioner of Patents now exercised by the Secretary of State;" which language, so far at least as appeals, strictly so-called, are concerned, was without force, as no appeals had ever been given from any decision of the Commissioner to the Secretary of State, unless that can be called so, which, by section 7 of the act of 1836, 5 Statutes, 120, was to be determined by a board of examiners, appointed, *pro re nata*, by the Secretary of State, and for which, as we have seen, an appeal to the chief justice of the circuit court of the District of Columbia had been substituted by the act of 1839, 5 Statutes, 354. The act of 1861, chapter 88, 12 Statutes, 246, created the office of examiners in chief, "for the purpose of securing greater uniformity of action in the grant and refusal of letters patent," "to be composed of persons of competent legal knowledge and scientific ability, whose duty it shall be, on the written petition of the applicant for that purpose being filed, to revise and determine upon the validity of decisions made by examiners when adverse to the grant of letters patent; and also to revise and determine, in like manner, upon the validity of the decisions of

examiners in interference cases, and, when required by the Commissioner, in applications for the extension of patents, and to perform such other duties as may be assigned to them by the Commissioner; that from their decisions appeals may be taken to the Commissioner of Patents in person, upon payment of the fee hereinafter prescribed; that the said examiners in chief shall be governed in their action by the rules to be prescribed by the Commissioner of Patents."

The act of July 8, 1870, 16 Statutes, 198, revised, consolidated, and amended the statutes then in force on the subject, and the substance of its provisions, material to the present inquiry, have been carried into the existing revision.

It will be observed that the judgment and discretion vested, by the original patent law of 1790, in a majority of the three executive officers—the Secretary of State, the Secretary for the Department of War, and the Attorney-General—who were authorized to cause letters patent to issue "if they shall deem the invention or discovery sufficiently useful and important," was transferred by the act of 1836, section 7, to the Commissioner of Patents, it being made his duty to issue a patent for the invention "if he shall deem it sufficiently useful and important;" and is continued in him by Revised Statutes, section 4893, the language being that he shall cause an examination to be made of the alleged new invention "and if on such examination it shall appear that the claimant is justly entitled to a patent under the law, and that the same is sufficiently useful and important, the Commissioner shall issue a patent therefor."

VI.

IN DETERMINING WHETHER A PATENT SHALL ISSUE OR NOT, AND IF ISSUED TO WHOM, THE COMMISSIONER OF PATENTS ACTS NOT IN A PURELY EXECUTIVE OR ADMINISTRATIVE, BUT IN A QUASI-JUDICIAL CAPACITY.

After giving the history of the legislation on the subject of patents, quoted under the last point from *Butterworth* v. *Hoe*, Mr. Justice Matthews describes the character of the judgment and discretion which, under the statutes, is vested in the Commissioner (112 U. S., p. 66):

> It thus appears, not only that the discretion and judgment of the Commissioner, as the head of the Patent Office, is substituted for that of the head of the Department, but also, *that that discretion and judgment are not arbitrary, but are governed by fixed rules of right, according to which the title of the claimant appears from an investigation, for the conduct of which ample and elaborate provision is made; and that his discretion and judgment, exercised upon the material thus provided, are subject to a review by judicial tribunals whose jurisdiction is defined by the same statute.* In no event could the direction of the Secretary of the Interior extend beyond the terms in which it is vested—that is, to the duties to be performed under the law by the Commissioner. The supervision of the Secretary can not change those duties nor require them to be performed by another, nor does it authorize him to substitute his discretion and judgment for that of the Commissioner, when, by law, the Commissioner is required to exercise his own, and when that judgment, unless reversed, in the special mode pointed out, by judicial process, is by law the condition on which the right of the claimant is declared to depend. *The conclusion can not*

be resisted that, to whatever else supervision and direction on the part of the head of the Department may extend, in respect to matters purely administrative and executive, they do not extend to a review of the action of the Commissioner of Patents in those cases in which, by law, he is appointed to exercise his discretion judicially. It is not consistent with the idea of JUDICIAL ACTION *that it should be subject to the direction of a superior, in the sense in which that authority is conferred upon the head of an executive department in reference to his subordinates. Such a subjection takes from it the quality of* A JUDICIAL ACT. *That it was intended that the Commissioner of Patents, in issuing or withholding patents, in reissues, interferences and extensions, should exercise quasi-judicial functions, is apparent from the nature of the examinations and decisions he is required to make, and the modes provided by law, according to which, exclusively, they may be reviewed.*

The essentially judicial character of the hearing before the Commissioner in a patent case is confirmed by the provisions which Congress has made for the securing by interested parties of the necessary testimony in patent cases through the compulsory process of the courts. The following are the statutes which Congress has passed authorizing the courts, upon the application of any party to a patent case, to issue its process commanding any desired witness to appear and testify before an officer authorized to take depositions, and to enforce the attendance by contempt proceedings if necessary:

SEC. 4906. The clerk of any court of the United States for any district or Territory wherein testimony is to be taken for use in any contested case pending in the Patent Office, shall, upon the appli-

cation of any party thereto, or of his agent or attorney, issue a subpœna for any witness residing or being within such district or Territory, commanding him to appear and testify before any officer in such district or Territory authorized to take depositions and affidavits, at any time and place in the subpœna stated. But no witness shall be required to attend at any place more than forty miles from the place where the subpœna is served upon him.

SEC. 4907. Every witness duly subpœnaed and in attendance shall be allowed the same fees as are allowed to witnesses attending the courts of the United States.

SEC. 4908. Whenever any witness, after being duly served with such subpœna, neglects or refuses to appear, or after appearing refuses to testify, the judge of the court whose clerk issued the subpœna may, on proof of such neglect or refusal, enforce obedience to the process, or punish the disobedience, as in other like cases. But no witness shall be deemed guilty of contempt for disobeying such subpœna, unless his fees and traveling expenses in going to, returning from, and one day's attendance at the place of examination, are paid or tendered him at the time of the service of the subpœna; nor for refusing to disclose any secret invention or discovery made or owned by himself.

VII.

WHILE IT IS TRUE THAT THE COURTS CAN NOT BE SUBORDINATED TO THE EXECUTIVE OR USED IN A MERELY ADVISORY CAPACITY, THE WELL-CONSIDERED DECISIONS OF THIS COURT SUSTAIN THE AUTHORITY OF CONGRESS TO MAKE USE OF THE COURTS IN AID OF AN EXECUTIVE OFFICER OR BODY. THE ONLY RESTRICTION IS, THAT THE ACTION CALLED FOR BY THE COURT SHALL BE OF A JUDICIAL NATURE AND THAT ITS JUDGMENT SHALL BE ENFORCEABLE. CONGRESS MAY, THEREFORE, SUBJECT THE JUDICIAL ACTION OF THE COMMISSIONER IN A PATENT CASE TO THE REVIEW OF A COURT.

1. It is the nature of the action taken, and not the character of the officer who takes it, which determines whether Congress may submit it to the review of the courts. Action which is essentially judicial in its nature may properly be subjected to the revision of a court, no matter if taken originally by an administrative officer or board. It can not be denied that in deciding whether a patent shall issue or not the Commissioner must exercise judicial functions. He hears testimony, he finds the facts, he applies the law, he decides questions of right affecting not only public but private interests. In a case of issue, reissue, or extension the question is between the Government and the claimant; in an interference case, between two contesting claimants. The rights involved in a patent case and the nature of the action required of the Commissioner is well described by Mr. Justice Matthews, speaking for the court, in *Butterworth* v. *Hoe* (112 U. S., p. 58):

> The general object of that system is to execute the intention of that clause of the Constitution,

Article I, Section VIII, which confers upon Congress the power "to promote the progress of science and useful arts by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries." The legislation based on this provision regards the right of property in the inventor as the medium of the public advantage derived from his invention; so that in every grant of the limited monopoly two interests are involved—that of the public, who are the grantors, and that of the patentee. There are thus two parties to every application for a patent, and more when, as in case of interfering claims or patents, other private interests compete for preference. The questions of fact arising in this field find their answers in every department of physical science, in every branch of mechanical art; the questions of law necessary to be applied in the settlement of this class of public and private rights have founded a special branch of technical jurisprudence. *The investigation of every claim presented involves the adjudication of disputed questions of fact upon scientific or legal principles, and is, therefore, essentially judicial in its character*, and requires the intelligent judgment of a trained body of skilled officials, expert in the various branches of science and art, learned in the history of invention, and proceeding by fixed rules to systematic conclusions.

2. While the separation of the Government into three departments—legislative, executive, and judicial—may be conceded, and while the distinction between these departments should be preserved, yet it is not true, as apparently contended by the appellant, that every act of Government may be classified, so as to require its assignment without question to a particular department.

There are certain acts which can be classified and so assigned; there are others which can not be. Under the rule that Congress can not delegate its legislative power, there are certain acts which must be performed by the legislature. Under the rule that the judicial power must be vested in the courts, there are certain duties which must be entrusted to the courts. In accordance with the constitutional provision defining the limits of the Executive, there are acts which can only be performed by it. But there are certain acts which are on the boundary lines, which are difficult of classification, which may be done by Congress itself, or imposed upon the Executive or the judiciary.

Thus, in the States, the legislature may grant divorces or give the courts authority to grant them.

The legislature may change the names of citizens or refer such change to the courts.

The legislature may grant franchises or confer upon the Executive the authority to do so. Modifications or amendments of charters may be made by the legislature, or by the Executive, or the courts, as the legislature may see fit to provide.

Quasi judicial acts requiring the exercise of judgment and discretion may be entrusted to the Executive or to the courts, with an appeal to the courts.

Many illustrations in support of this proposition will suggest themselves to the court. It is only necessary for me now to refer to a few leading cases amply sustaining the authority of Congress to make use of the courts in aid of the Executive.

In *Murray* v. *Hoboken Land and Improvement Company* (18 Howard, 272) was involved the validity of a sale of land made by the United States marshal, under a distress warrant issued by the Solicitor of the Treasury, against a collector of customs, for a debt due the United States. It was contended that the power possessed by the marshal under the distress warrant was judicial power, which the Constitution required to be vested in the courts. The court held, after an examination of the history of similar proceedings in England and in this country, that the act provided due process of law. It was optional with Congress either to proceed for the collection of the amount due the United States from the collector by suit or by summary process of distress. The act did provide for a resort to the courts by the collector through his application to the district court. Such provision was consent by the United States to be sued in the particular matter. With respect to the option reposed in Congress under the Constitution, Mr. Justice Curtis, speaking for the court, said (p. 284):

> To avoid misconstruction upon so grave a subject, we think it proper to state that we do not consider Congress can either withdraw from judicial cognizance any matter which, from its nature, is the subject of a suit at the common law, or in equity, or admiralty; nor, on the other hand, can it bring under the judicial power a matter which, from its nature, is not a subject for judicial determination. *At the same time there are matters involving public rights which may be presented in such form that the judicial power is capable of acting on them, and which are susceptible of judicial determination, but which*

Congress may or may not bring within the cognizance of the courts of the United States, as it may deem proper.

In the case of *Fong Yue Ting* v. *United States*, 149 U. S., 698), the constitutionality of the act of May 5, 1892, providing for the deportation of Chinese unlawfully within this country, came before this court. Among other provisions was one authorizing the officer who had arrested a person of Chinese descent, to bring him before a United States judge, who should summarily determine whether or not he should be deported. It was insisted that this provision was unconstitutional because it imposed upon the courts duties not judicial and made them subservient to the executive department, to which the act entrusted the carrying out of its provisions. This court, Mr. Justice Gray delivering the opinion, held the provision a valid one, taking the view that when the executive officer, acting in behalf of the United States, brings the Chinese laborer before the judge, in order that he may be heard, and the fact upon which depends his right to remain in the country be decided, a case is duly submitted to the judicial power. No formal complaint or pleadings are required.

The broad authority vested in Congress to select the means for executing the powers conferred is thus described (p. 712):

> As long ago said by Chief Justice Marshall, and since constantly maintained by this court: "The sound construction of the Constitution must allow to the National Legislature that discretion, with respect to the means by which the powers it confers are to be carried into execution which will enable

> that body to perform the high duties assigned to it in the manner most beneficial to the people. Let the end be legitimate, let it be within the scope of the Constitution, and all means which are appropriate, which are plainly adapted to that end, which are not prohibited, but consistent with the letter and spirit of the Constitution, are constitutional." "Where the law is not prohibited, and is really calculated to effect any of the objects intrusted to the Government, to undertake here to inquire into the degree of its necessity would be to pass the line which circumscribes the judicial department and to tread on legislative ground. This court disclaims all pretensions to such a power." (*McCulloch* v. *Maryland*, 4 Wheat., 316, 421, 423; *Juilliard* v. *Greenman*, 110 U. S., 421, 440, 450; *Ex parte Yarbrough*, 110 U. S., 651, 658; *In re Rapier*, 143 U. S., 110, 134; *Logan* v. *United States*, 144 U. S., 263, 283.)

The following illustrations of the discretionary power vested in Congress to submit questions not necessarily of judicial cognizance either to the final determination of executive officers, or to their decision in the first instance, with an appeal to the courts, are given (p. 714):

> It is no new thing for the lawmaking power, acting either through treaties made by the President and Senate, or by the more common method of acts of Congress, to submit the decision of questions, not necessarily of judicial cognizance, either to the final determination of executive officers, or to the decision of such officers in the first instance, with such opportunity for judicial review of their action as Congress may see fit to authorize or permit.
>
> For instance, the surrender, pursuant to treaty stipulations, of persons residing or found in this

country and charged with crime in another may be made by the executive authority of the President alone, when no provision has been made by treaty or by statute for an examination of the case by a judge or magistrate. Such was the case of Jonathan Robbins, under article 27 of the treaty with Great Britain of 1794, in which the President's power in this regard was demonstrated in the masterly and conclusive argument of John Marshall in the House of Representatives. (8 Stat., 129; Wharton's State Trials, 392; Bee, 286; 5 Wheat., appx. 3.) But provision may be made, as it has been by later acts of Congress, for a preliminary examination before a judge or commissioner; and in such case the sufficiency of the evidence on which he acts can not be reviewed by any other tribunal, except as permitted by statute. (Act of August 12, 1848, c. 167, 9 Stat., 302; Rev. Stat., secs. 5270–5274; *Ex parte Metzer*, 5 How., 176; *Benson* v. *McMahon*, 127 U. S., 457; *In re Oteiza*, 136 U. S., 330.)

So claims to recover back duties illegally exacted on imports may, if Congress so provides, be finally determined by the Secretary of the Treasury. (*Cary* v. *Curtis*, 3 How., 236; *Curtis* v. *Fiedler*, 2 Black, 461, 478, 479; *Arnson* v. *Murphy*, 109 U. S., 238, 240.) But Congress may, as it did for long periods, permit them to be tried by suit against the collector of customs. Or it may, as by the existing statutes, provide for their determination by a board of general appraisers, and allow the decisions of that board to be reviewed by the courts in such particulars only as may be prescribed by law. (Act of June 10, 1890., c. 407, secs. 14, 15, 25, 26 Stat., 137, 138, 141; *In re Fassett*, 142 U. S., 479, 486, 487; *Passavant* v. *United States*, 148 U. S., 214.)

To repeat the careful and weighty words uttered by Mr. Justice Curtis in delivering a unanimous

judgment of this court upon the question what is due process of law: "To avoid misconstruction upon so grave a subject, we think it proper to state that we do not consider Congress can either withdraw from judicial cognizance any matter which, from its nature, is the subject of a suit at the common law, or in equity, or admiralty; nor, on the other hand, can it bring under the judicial power a matter which, from its nature, is not a subject for judicial determination. *At the same time, there are matters involving public rights which may be presented in such form that the judicial power is capable of acting on them, and which are susceptible of judicial determination, but which Congress may or may not bring within the cognizance of the courts of the United States, as it may deem proper.*" (*Murray* v. *Hoboken Co.*, 18 How., 272, 284.)

The following conclusive disposition is made of the contention that no case was submitted to the judicial power (p. 728):

> When, in the form prescribed by law, the executive officer, acting in behalf of the United States, brings the Chinese laborer before the judge, in order that he may be heard, and the facts upon which depends his right to remain in the country be decided, a case is duly submitted to the judicial power; for here are all the elements of a civil case—a complainant, a defendant, and a judge—*actor, reus et judex.* (3 Bl. Com., 25; *Osborn* v. *Bank of United States*, 9 Wheat., 738, 819.) No formal complaint or pleadings are required, and the want of them does not affect the authority of the judge, or the validity of the statute.

In *Interstate Commerce Commission* v. *Brimson* (154 U. S., 447) it was contended that the twelfth sec-

tion of the Interstate-Commerce act, authorizing the circuit courts to use their process in aid of inquiries before the Commission, was in conflict with the Constitution, because it imposed on the courts duties not judicial in their nature. This court held otherwise. It took the view that a proceding under this section is not merely ancillary and advisory; that the judgment of the court is none the less that of a judicial tribunal dealing with judicial questions, because its effect may be to aid an administrative or executive body in the performance of duties imposed upon it by Congress. In the opinion, delivered by Mr. Justice Harlan, *Hayburn's case*, 2 Dall., 409; *United States* v. *Ferreira*, 13 Howard, 40; *Todd's case*, 13 Howard, 52; *Gordon* v. *United States*, 117 U. S., 697, and *In re* Sanborn, 148 U. S., 222, are examined and distinguished. These are the cases relied upon by the appellant.

The following extracts from the able and interesting opinion in this case show that the power of Congress to call the courts to the aid of the Executive, as provided in the interstate-commerce act, is sustained by the same line of reasoning, upon the same authorities, used in the Chinese deportation cases just cited:

As to the general power of Congress, page 472:

> The general principle applicable to this subject was long ago announced by this court, and has been so often affirmed and applied that argument in support of it is unnecessary, even if it were possible to suggest any thought not heretofore expressed in the adjudged cases. In the great case of *McCulloch* v. *Maryland* (4 Wheat., 316, 421, 423), it was said: "The sound construction of the Constitution must

allow to the National Legislature that discretion, with respect to the means by which the powers it confers are to be carried into execution, which will enable that body to perform the high duties assigned to it, in the manner most beneficial to the people. Let the end be legitimate, let it be within the scope of the Constitution, and all means which are appropriate, which are plainly adapted to that end, which are not prohibited, but consistent with the letter and spirit of the Constitution, are constitutional." Again: "Where the law is not prohibited, and is really calculated to effect any of the objects intrusted to the Government, to undertake here to inquire into the degree of its necessity would be to pass the line which circumscribes the judicial department, and to tread on legislative ground. This court disclaims all pretensions to such a power."

As to what is a case which may be submitted, page 475:

What is a case or controversy to which, under the Constitution, the judicial power of the United States extends? Referring to the clause of that instrument, which extends the judicial power of the United States to all cases in law and equity arising under the Constitution, the laws of the United States, and treaties made or that shall be made under their authority, this court, speaking by Chief Justice Marshall, has said: "This clause enables the judicial department to receive jurisdiction to the full extent of the Constitution, laws, and treaties of the United States when any question respecting them shall assume such a form that the judicial power is capable of acting on it. That power is capable of acting only when the subject is submitted to it by a party who asserts his rights in the form prescribed by law. It then becomes a case, and the Constitution declares that the judicial power shall

extend to all cases arising under the Constitution, laws, and treaties of the United States." (*Osborn* v. *Bank of the United States*, 9 Wheat., 738, 819.) And in *Murray* v. *Hoboken Co.* (18 How., 272, 284) Mr. Justice Curtis, after observing that Congress can not withdraw from judicial cognizance any matter which, from its nature, is the subject of a suit at the common law, or in equity, or admiralty, nor, on the other hand, bring under judicial power a matter which, from its nature, is not a subject for judicial determination, said: "At the same time there are matters involving public rights which may be presented in such form that the judicial power is capable of acting on them, and which are susceptible of judicial determination, but which Congress may or may not bring within the cognizance of the courts of the United States, as it may deem proper.

The particular case described, page 477:

The United States asserts its right, under the Constitution and laws, to have these appellees answer the questions propounded to them by the Commission, and to produce specified books, papers, etc., in their possession or under their control. It insists that the evidence called for is material in the matter under investigation; that the subject of investigation is within legislative cognizance, and may be inquired of by any tribunal constituted by Congress for that purpose. The appellees deny that any such rights exist in the General Government, or that they are under a legal duty, even if such evidence be important or vital in the enforcement of the interstate-commerce act, to do what is required of them by the Commission. Thus has arisen a dispute involving rights or claims asserted by the respective parties to it. And the power to

> determine it directly, and, as between the parties, finally, must reside somewhere. It can not be that the General Government, with all the power conferred upon it by the people of the United States, is helpless in such an emergency, and is unable to provide some method, judicial in form, and *direct in its operation*, for the prompt and conclusive determination of this dispute.

The proceeding not merely advisory. Page 487.

> The present proceeding is not merely ancillary and advisory. It is not, as in *Gordon's Case*, one in which the United States seeks from the circuit court of the United States an opinion that "would remain a dead letter, and without any operation upon the rights of the parties." The proceeding is one for determining rights arising out of specified matters in dispute that concern both the general public and the individual defendants. It is one in which a judgment may be rendered that will be conclusive upon the parties until reversed by this court. And that judgment may be enforced by the process of the circuit court.

None the less a judgment because in aid of the executive. Bottom page 487.

> It is none the less the judgment of a judicial tribunal dealing with questions judicial in their nature, and presented in the customary forms of judicial proceedings, because its effect may be to aid an administrative or executive body in the performance of duties legally imposed upon it by Congress in execution of a power granted by the Constitution.

In *United States* v. *Coe* (155 U. S., 76) the court sustained the constitutionality of the provision in the act establishing the Court of Private Land Claims, which authorizes an appeal to the Supreme Court of the United

extend to all cases arising under the Constitution, laws, and treaties of the United States." (*Osborn* v. *Bank of the United States*, 9 Wheat., 738, 819.) And in *Murray* v. *Hoboken Co.* (18 How., 272, 284) Mr. Justice Curtis, after observing that Congress can not withdraw from judicial cognizance any matter which, from its nature, is the subject of a suit at the common law, or in equity, or admiralty, nor, on the other hand, bring under judicial power a matter which, from its nature, is not a subject for judicial determination, said: "At the same time there are matters involving public rights which may be presented in such form that the judicial power is capable of acting on them, and which are susceptible of judicial determination, but which Congress may or may not bring within the cognizance of the courts of the United States, as it may deem proper.

The particular case described, page 477:

The United States asserts its right, under the Constitution and laws, to have these appellees answer the questions propounded to them by the Commission, and to produce specified books, papers, etc., in their possession or under their control. It insists that the evidence called for is material in the matter under investigation; that the subject of investigation is within legislative cognizance, and may be inquired of by any tribunal constituted by Congress for that purpose. The appellees deny that any such rights exist in the General Government, or that they are under a legal duty, even if such evidence be important or vital in the enforcement of the interstate-commerce act, to do what is required of them by the Commission. Thus has arisen a dispute involving rights or claims asserted by the respective parties to it. And the power to

> determine it directly, and, as between the parties, finally, must reside somewhere. It can not be that the General Government, with all the power conferred upon it by the people of the United States, is helpless in such an emergency, and is unable to provide some method, judicial in form, and *direct in its operation*, for the prompt and conclusive determination of this dispute.

The proceeding not merely advisory. Page 487.

> The present proceeding is not merely ancillary and advisory. It is not, as in *Gordon's Case*, one in which the United States seeks from the circuit court of the United States an opinion that "would remain a dead letter, and without any operation upon the rights of the parties." The proceeding is one for determining rights arising out of specified matters in dispute that concern both the general public and the individual defendants. It is one in which a judgment may be rendered that will be conclusive upon the parties until reversed by this court. And that judgment may be enforced by the process of the circuit court.

None the less a judgment because in aid of the executive. Bottom page 487.

> It is none the less the judgment of a judicial tribunal dealing with questions judicial in their nature, and presented in the customary forms of judicial proceedings, because its effect may be to aid an administrative or executive body in the performance of duties legally imposed upon it by Congress in execution of a power granted by the Constitution.

In *United States* v. *Coe* (155 U. S., 76) the court sustained the constitutionality of the provision in the act establishing the Court of Private Land Claims, which authorizes an appeal to the Supreme Court of the United

States. Reference is made, in the opinion by the Chief Justice, to the cases of *American Insurance Co.* v. *Canter* (1 Peters, 511, 546), and *McAllister* v. *United States* (141 U. S., 174), in which it was held that section 1 of article 3 does not exhaust the power of Congress to establish courts, but that Territorial courts and special tribunals may be created by virtue of control over Territories, and the general right of sovereignty which exists in the Government, and from these appeals may be provided to the Supreme Court of the United States.

Page 86:

> As wherever the United States exercise the power of government, whether under specific grant, or through the dominion and sovereignty of plenary authority as over the Territories (*Shively* v. *Bowlby*, 152 U. S. 1, 48), that power includes the ultimate executive, legislative, and judicial power, it follows that the judicial action of all inferior courts established by Congress may, in accordance with the Constitution, be subject to the appellate jurisdiction of the supreme judicial tribunal of the Government. There has never been any question in regard to this as applied to territorial courts, and no reason can be perceived for applying a different rule to the adjudications of the Court of Private Land Claims over property in the Territories.

In the recent case of *United States* v. *Lies* (170 U. S., 628), the court held that where the Government takes no appeal from the action of the board of general appraisers upon an importer's protest, made under the customs administrative act of June 10, 1890, it is bound by that action; and in case the importer appeals from that action, and subsequently abandons his appeal, the Government can

not claim to be heard, but it is the duty of the court to affirm the decision of the appraisers.

In that case the Government insisted that the application to the circuit court for a review of the questions of law and fact involved in the decision of the board of appraisers was the institution of an original proceeding and not an appeal or a proceeding in error to review a judicial determination made by the board of appraisers. It was urged that the proceeding before the board of appraisers is not a judicial one between private parties respecting property or personal rights, but a matter between the Government acting through its agents and the citizen. In order to afford the citizen every opportunity of being dealt with justly and lawfully, the application for review to the circuit court is provided. The California land-title cases, which are cited in the brief of the appellant, were relied upon in support of this contention. Notwithstanding the fact that it was conceded that the board of appraisers is not a court, but only an administrative body clothed with quasi judicial functions in the determination of questions of fact and law arising between the Government and the citizen in the collection of the revenue, the court held that the application for review to the circuit court is virtually and substantially an appeal to the circuit court from the decision of the board of general appraisers, and that if the Government desired to secure a review by the circuit court, it must file its request for an appeal. The opinion was delivered by Mr. Justice Peckham, who says (p. 636):

> Although the circuit court has, upon the application of the parties, power to take further testimony

after the case is brought before it, and to that extent it may be regarded as something in the nature of a new proceeding, yet the proper procedure in deciding the appeal is in nowise altered thereby, and unless a party has appealed, and filed and served his statement as above mentioned, the court ought not to reverse on his motion.

It is immaterial that the application is not named an appeal. It is such in substance, and the grounds and reasons for the appeal are to be stated. Although the board of general appraisers may not be a court, yet the proceedings to review its determination are pointed out by the statute, and they must be substantially followed and obeyed.

VIII.

THE CASE OF BUTTERWORTH V. HOE (112 U. S., 55) IS DECISIVE IN FAVOR OF THE APPELLEE HEREIN.

I submit that the case of *Butterworth* v. *Hoe*, from which quotations have been made, is decisive of this controversy and conclusive in favor of the validity of the existing law, permitting an appeal to the courts from the decision of the Commissioner of Patents.

Butterworth v. *Hoe* was a suit in mandamus, brought by a claimant of a patent in whose favor the Commissioner had found in an interference case, to compel the Commissioner to issue the patent to him. The Commissioner had refused to do this, on the ground that the defeated party in the interference case before him had appealed to the Secretary of the Interior, who had reversed the Commissioner's action and found in the appellant's favor.

The question, then, was between the action of the Secretary of the Interior, the head of an executive department, and that of his subordinate, the Commissioner of Patents.

In favor of the action of the Secretary, the same argument was made that is made here, namely, that the Commissioner of Patents is simply an executive officer, that his acts are purely executive in nature, and are therefore subject to review and revision by the head of the department of which he is a subordinate.

On the other hand, it was contended that while the Commissioner of Patents is an executive officer and subject in matters administrative or executive to the supervision of the head of the Department, yet, in deciding patent cases (and the case before him was an interference case), his action is essentially judicial in nature and therefore not subject to review by the executive head. In support of this the fact that an appeal is provided to the courts by Congress was relied upon.

This court held in favor of the latter view. It denied authority to the Secretary to review, because the action of the Commissioner is not executive, but judicial, and Congress has properly provided for an appeal to the courts.

The grounds for the contention that the Secretary had the authority to review are stated in the opinion of the court (112 U. S., 55). Among others is this:

> That this general relation of official subordination [of the Commissioner to the Secretary, which has been described], with the accompanying powers of supervision and direction, extends to all the official

> acts of the Commissioner, without regard to any distinction between those which are merely ministerial and those which are judicial in their nature.

The following quotations from the able opinion, delivered by Mr. Justice Matthews, show clearly that the decision was based upon the judicial nature of the action of the Commissioner in determining patent cases. While in executive matters the Secretary, as the head of the Department, has supervisory authority, yet in quasi judicial matters Congress has sufficiently shown that it intended the action of the Commissioner, in the exercise of his judgment and discretion, either to be final or to be reviewable only by the courts. The appeal provided to the courts conclusively showed the essential judicial nature of his action in patent cases.

Page 60:

> It is evident that the appeal thus given to the supreme court of the District of Columbia from the decision of the Commissioner, is not the exercise of ordinary jurisdiction at law or in equity on the part of that court, but is one in the statutory proceeding under the patent laws *whereby that tribunal is interposed in aid of the Patent Office, though not subject to it. Its adjudication,* though not binding upon any who choose by litigation in courts of general jurisdiction to question the validity of any patent thus awarded, *is, nevertheless, conclusive upon the Patent Office itself,* for, as the statute declares (Rev. Stat., sec. 4914), it "shall govern the further proceedings in the case." The Commissioner can not question it. He is bound to record and obey it. His failure or refusal to execute it by appropriate action would undoubtedly be corrected and supplied by suitable

judicial process. *The decree of the court is the final adjudication upon the question of right; everything after that dependent upon it is merely in execution of it;* it is no longer matter of discretion, but has become imperative and enforceable. It binds the whole Department, the Secretary as well as the Commissioner, for it has settled the question of title, so that a demand for the signatures necessary to authenticate the formal instrument and evidence of grant may be enforced. It binds the Secretary by acting directly upon the Commissioner, for it makes the action of the latter final by requiring it to conform to the decree.

Congress has thus provided four tribunals for hearing applications for patents, with three successive appeals, in which the Secretary of the Interior is not included, giving jurisdiction in appeals from the Commissioner to a judicial body, independent of the Department, as though he were the highest authority on the subject within it. And to say that under the name of direction and superintendence, the Secretary may annul the decision of the supreme court of the District, sitting on appeal from the Commissioner, by directing the latter to disregard it, is to construe a statute so as to make one part repeal another, when it is evident both were intended to coexist without conflict.

Page 63:

Thus every case is fully provided for, both when the Commissioner wrongfully refuses to issue a patent, and when, in cases of interference, he erroneously issues one; and that by means of judicial proceedings through tribunals distinct from and independent of the Patent Office, the integrity and force of whose judgments would be annulled if not

regarded as conclusive upon the Commissioner, notwithstanding any power of direction and superintendence on the part of the Secretary, which is therefore necessarily excluded.

Bottom, page 63.

* * * No reason can be assigned for allowing an appeal from the Commissioner to the Secretary *in cases in which he is by law required to exercise his judgment on disputed questions of law and fact*, and in which no appeal is allowed to the courts that would not equally extend it to those in which such appeals are provided, for all are equally embraced in the general authority of direction and superintendence. That includes all or does not extend to any. The true conclusion, therefore, is, that matters of this description, *in which the action of the Commissioner is quasi-judicial*, the fact that no appeal is expressly given to the Secretary is conclusive that none is to be implied.

IX.

THE CONTROVERSY SUBMITTED TO THE COURT ON APPEAL FROM THE DECISION OF THE COMMISSIONER WAS A CASE WHICH MIGHT PROPERLY BE SUBMITTED TO A JUDICIAL TRIBUNAL.

The appellant discusses at some length in his brief the question whether there was "a case" which could be properly submitted to the judiciary. That there was a case is so apparent as hardly to require discussion. In *Fong Yue Ting* (149 U. S., 698, 728) Mr. Justice Gray, speaking for the court, pointed out that when the question was submitted to the court whether or not a Chinese laborer had a right to remain in the country, although no

formal complaint or pleadings were required, all the elements of *a case* existed. On one side the Chinese laborer, on the other the Government—a question of right to be decided, and a judge to determine it.

So in *Interstate Commerce Commission* v. *Brimson* (154 U. S., 447), this court, speaking by Mr. Justice Harlan, pointed out the elements of a case which are present when the Interstate Commerce Commission, under the statute, applies to a court for its aid in compelling an answer to questions propounded by the Commission. On the one side is the Interstate Commerce Commission, on the other the refractory witness. A dispute exists as to the right of the Commission to the information demanded. The determination of this controversy may properly be submitted to the court.

In the present case, wherein an interference was declared, the parties before the court were citizens, adverse private claimants. The question was the right to a patent, more or less valuable, often of great value. The fact that such a controversy may be brought before a court by an original proceeding, in the nature of a bill in equity, is convincing upon the point that there is in it all the elements of a case for judicial determination. Whether such a case should be summarily submitted to the court by direct appeal from the decision of the Commissioner of Patents was for Congress to say.

CONCLUSION.

This case would be an important one if the statute providing for an appeal to the court of the District had

just been passed and no action taken under it. The question involved becomes an exceedingly grave one when it is considered that the jurisdiction to review the decision of the Commissioner in patent cases has been constantly exercised by the courts of the District since the year 1839, and (as stated by Justice Shepard, in his opinion in this case in the court of appeals, bottom page 2, printed copy filed herein) "of late years especially many decisions of the court, upon appeal from the Commissioner of Patents, have been carried into effect and accepted as conclusive and final."

The extent of the confusion which would result from a decision of this court declaring the statute under consideration unconstitutional, and, therefore, all action of the courts under it null and void, may be faintly imagined. In this connection, may it not fairly be suggested that if no appeal lies to the courts, because the act of the Commissioner is not judicial but executive, then an appeal does and will lie to the Secreatry of the Interior, for the same reason, because the act is executive and not judicial; and, the action of the Commissioner not being final, the appellant is not entitled to the writ in this case.

The judgment of the lower court should be affirmed.

JOHN K. RICHARDS,
Solicitor-General.

NOVEMBER 29, 1898.

○

In the Supreme Court of the United States.

OCTOBER TERM, 1898.

THE UNITED STATES EX REL. ALFRED L. Bernardin, plaintiff in error,
v.
CHARLES H. DUELL, COMMISSIONER OF Patents, defendant in error.
No. 444.

ADDITIONAL POINTS BY THE SOLICITOR-GENERAL ON ORAL ARGUMENT.

I.

With the wisdom of the appeal provided by Congress from the action of the Commissioner to the courts of the District, this court of course has nothing to do; but it was insisted in argument that such appeal was in no sense adapted to execute the power conferred on Congress to promote the progress of the useful arts by securing to inventors the exclusive rights to their respective discoveries, and much solicitude was expressed for the poor inventors who are thus compelled to resort to an additional tribunal.

I think the policy of providing this appeal can readily be sustained. The appeal provides for a review in a summary manner of the action of the Commissioner by a court. Difficult questions of law and fact are involved in patent cases. The statute does not require the Commissioner of Patents to be a lawyer. The tenure of a Commissioner is uncertain and at the best short. He changes with changing Administrations. The court of appeals, on the contrary, is composed of judges who hold during good behavior. Its members outlast Administrations. They are likely, in exercising this jurisdiction, to become familiar with patent law, and the questions which arise in issuing patents, and are apt to and do serve as a wise check upon the action of the Commissioners. The proceeding was made summary, so as to make it inexpensive, open to all applicants, however poor, and so as to present to the court the same questions upon the same facts which were before the Commissioner. An original investigation by the court upon new evidence would be slow and expensive, burdensome to the court, and costly to litigants. The appeal provided by statute secures the advantage of the learning and experience of the court upon the precise matters presented to the Commissioner.

II.

The decision of the court of appeals on an appeal from the Commissioner is not a dead letter, because the statute expressly provides that it shall be entered of record in the Patent Office, "*and shall govern the further proceedings in the case.*" Its binding quality is clearly described by Mr. Justice Matthews (112 U. S., 60).

The only exception made in the statute is that it shall not preclude any person interested from "the right to contest the validity of such patent." The appeal to the circuit court is one step in the proceedings terminating in the issue of the patent. Of course the validity of a patent thus issued may be subsequently contested in any court of competent jurisdiction.

III.

Section 4915, providing that whenever a patent is refused, either by the Commissioner of Patents or by the supreme court of the District of Columbia upon appeal from the Commissioner, the applicant may have a remedy by bill in equity, does not provide for a means of contesting "the validity of the patent" (*Durban* v. *Seymour*, 161 U. S., 235, bottom 237), nor for a rehearing, upon equal terms, of the questions adjudicated in the Patent Office, as aided by the court of appeals.

The character of the proceeding under section 4915 is described in *Morgan* v. *Daniels* (153 U. S., 120, 124):

> But this is something more than a mere appeal. It is an application to the court to set aside the action of one of the executive departments of the Government. The one charged with the administration of the patent system had finished its investigations and made its determination with respect to the question of priority of invention. That determination gave to the defendant the exclusive rights of a patentee. A new proceeding is instituted in the courts—a proceeding to set aside the conclusions reached by the administrative department, and to give to the plaintiff the rights there awarded

to the defendant. It is something in the nature of a suit to set aside a judgment, and as such is not to be sustained by a mere preponderance of evidence.

Page 125, top:

Upon principle and authority, therefore, it must be laid down as a rule that where the question decided in the Patent Office is one between contesting parties as to priority of invention, the decision there must be accepted as controlling upon that question of fact in any subsequent suit between the same parties, unless the contrary is established by testimony which in character and quantity carries thorough conviction.

IV.

Mr. Dowell stated to the court that no patent had been issued, the inference being that the Patent Office had not issued the patent in accordance with the direction of the court of appeals because of the filing of the bill in equity under section 4915. It is true no patent has been issued, but this is because of the fact that the constitutional question now submitted to this court was then raised, and so the Commissioners held up the patent awaiting the settlement of this constitutional question. In ordinary cases, I am informed by the Patent Office, it is the rule, when the decision of the court of appeals requires the issue of a patent, for the Commissioner to issue it at once in accordance with the directions contained in the court's decision. Thus immediate effect is given to the decision of the court of appeals. It is treated as governing the further proceedings in the case in the Patent Office, and a patent is issued accordingly.

A reference to the case of *Morgan* v. *Daniels* (153 U. S., 120), just cited, shows that this is true. That was an interference case, in which the patent was issued according to the decision of the Commissioner, whereupon the defeated party resorted to the remedy under section 4915.

V.

If any section is open to the objection that it does not provide sufficiently for carrying into effect the decision of the court, it is section 4915, which simply provides that "such adjudication, if it be in favor of the right of the applicant, shall *authorize* the Commissioner to issue such patent on the applicant's filing in the Patent Office a copy of the adjudication and *otherwise complying with the requirements of law*."

My information from the Patent Office is that an adjudication under section 4915 is not recognized as being a final and conclusive determination that a patent shall and must issue to the successful applicant before the court. After a copy of the adjudication is filed in the Patent Office, there still remains in the Commissioner the discretion to pass upon the question whether the applicant has otherwise complied with the requirements of law.

VI.

A judgment of a court is not to be deemed a dead letter because it can be attacked in a judicial proceeding. A patent is at least *prima facie* proof that the patentee is entitled to the benefit of the invention. It is not, however, absolutely final and conclusive upon that point. It

may be questioned and attacked in various ways. A defeated applicant may attack it by bill in equity under section 4915. A party claiming an infringement may attack it by a suit which contests its validity. The Government may attack it by a suit to cancel the patent. In all these ways the action of the court of appeals and the action of the Commissioner of Patents carrying the decision of the court of appeals into effect may be attacked and possibly overthrown.

VII.

The appeal is a special statutory proceeding in aid of the Patent Office. The binding and important nature of the decision of the court of appeals is recognized by the appellant herein. Otherwise, why should he be so solicitous to have that decision declared null and void? If he could relitigate, under section 4915, upon equal terms with Northall the question of priority of invention, how explain his present action? He knows well enough that, in accordance with the decision of the court of appeals, the Commissioner will issue a patent to Northall, and that it will require him to satisfy a court by testimony, which, in character and amount, carries thorough conviction that the court of appeals and the Commissioner were wrong before he can overthrow their action.

J. K. RICHARDS,
Solicitor-General.

DECEMBER 3, 1898.

○

No. 444.

Brief of Wilson

Filed Nov. 28, 1898.

Supreme Court of the United States.

OCTOBER TERM, 1898.

No. 444

THE UNITED STATES *EX REL.* ALFRED L. BERNARDIN, PLAINTIFF IN ERROR,

vs.

CHARLES H. DUELL, COMMISSIONER OF PATENTS.

WRIT OF ERROR TO THE COURT OF APPEALS OF THE DISTRICT OF COLUMBIA.

BRIEF FOR ASSIGNEE OF WILLIAM H. NORTHALL.

—BY—

JEREMIAH M. WILSON.

JUDD & DETWEILER, PRINTERS, WASHINGTON, D. C. 11-25-'98

IN THE

Supreme Court of the United States.

OCTOBER TERM, 1898.

No. 444.

THE UNITED STATES *EX REL.* ALFRED L. BERNARDIN, PLAINTIFF IN ERROR,

vs.

CHARLES H. DUELL, COMMISSIONER OF PATENTS.

WRIT OF ERROR TO THE COURT OF APPEALS OF THE DISTRICT OF COLUMBIA.

BRIEF IN RESISTANCE OF APPLICATION FOR A WRIT OF MANDAMUS.

The question that is presented in the brief of counsel for plaintiff in error, and which it may be conceded is embraced in the record, is as follows:

Is it within the power of Congress to confer upon the Court of Appeals of the District of Columbia authority to review the action of the Commissioner of Patents in a case

where an interference has been declared?—the contention of the appellant being that the determination of such a case by the Commissioner of Patents is an administrative act, from which no appeal can lie to said court.

Or, to state this differently, the contention of the appellant is, that it is not within the power of Congress to confer upon the Court of Appeals the power to review the action of the Commissioner of Patents, in respect of determining which of two parties contending for a patent, and between whom, or between whose applications or assertion of priority, an interference has been declared, is entitled thereto.

In support of this contention counsel for appellant have cited numerous authorities to establish the propositions:

1. That this Government is divided into three co-ordinate branches—the legislative, executive, and judicial.

2. They cite numerous authorities to establish the proposition that no one of these branches can trespass upon the domain of either of the others as severally defined by the Constitution of the United States.

As to these propositions there is no dispute.

Congress Has the Power under Section 8 of the Constitution to Confer this Authority upon the Court of Appeals.

Counsel for plaintiff in error have, perhaps, inadvertently, overlooked the fact that section 8 of the Constitution provides that "Congress shall have power to "promote the progress of science and useful arts by secur- "ing for limited times to authors and inventors the exclu- "sive right to their respective writings and discoveries." No allusion is made to this provision of the Constitution in brief for plaintiff in error.

The real question in this case is whether Congress, under the provisions of the Constitution above quoted, has the power to use said court as an instrumentality or aid in the matter of securing to inventors the exclusive right to their discoveries, in respect of the securing of which express power is conferred upon Congress by the above-quoted provision of the Constitution. To this question the attention of the court is now invited.

I.

Congress Has the Implied Power to Enact Laws and Prescribe Means for the Carrying Out of Express Powers Conferred by the Constitution, and the Courts Cannot Nullify these Laws unless the Means so Provided are Forbidden by the Constitution Itself.

1. It is, perhaps, unnecessary to mention at this late day that it is beyond controversy that Congress has the *implied* power to do whatever is necessary, or deemed by it to be necessary, to carry into effect an *express* power. In the case of *McCulloch vs. The State of Maryland* (4 Wheat., 316–421), Chief Justice Marshall, in an exhaustive and elaborate discussion of this subject, states the conclusion of the court as follows:

"We think the sound construction of the Constitution must allow to the national legislature that discretion, with respect to the means by which the powers it confers are to be carried into execution, which will enable that body to perform the high duties assigned to it in the manner most beneficial to the people. *Let the end be legitimate, let it be within the scope of the Constitution, and all means which are appropriate, which are plainly adapted to that end, which are*

not prohibited, but consist with the letter and spirit of the Constitution, are constitutional."

See, also—

Prigg vs. State of Pennsylvania, 16 Pet., 539.
Ex parte Yarbrough, 110 U. S., 651.
Gibbons vs. Ogden, 9 Wheat., 1 *et seq.*

In the light of the authorities and in the light of reason it is with great confidence asserted that it is left entirely to Congress to designate or appoint the means or instrumentalities to which it will resort to carry into effect this express power, so granted by the Constitution, to secure to inventors the benefits of their discoveries.

See *Interstate Commerce Com. vs. Brimson, infra.*

2. It is also respectfully submitted that it is not within the power of any court to criticise these means or instrumentalities or to determine that they are in anywise injurious for trenching upon the power of that other co-ordinate branch of the Government, the judiciary. Congress has just as much power to invoke the aid of the judge of any court or any judicial tribunal in the exercise of this expressly conferred power as it has to invoke the aid of any administrative or other officer or department of the Government.

In this connection, this court, in *McCulloch vs. State of Maryland* (4 Wheaton, 423), uses the following language:

"Should Congress, in the execution of its powers, adopt measures which are prohibited by the Constitution * * * it would be the painful duty of this tribunal, should a case requiring such a decision come before it, to say that such an act was not the law of the land. *But where the law is not prohibited, and is really calculated to effect any of the objects intrusted to the Government, to undertake here to inquire into the degree of its necessity would be to pass the line which circumscribes the judicial department, and to tread on legislative ground. This court disclaims all pretensions to such a power.*"

This case is cited and the above extract is quoted with approval by the Supreme Court in the recent case of *Interstate Commerce Commission vs. Brimson* (154 U. S., 472).

3. It can scarcely be doubted that in respect of securing to inventors the exclusive right to their discoveries, Congress could have used the Treasury Department, or the State Department, or the Department of Justice, as well as the Interior Department, or that it could have created a special tribunal for that purpose, as in the cases of the Interstate Commerce Commission and the Court of Claims, which are merely ancillary or advisory tribunals (except where the power to render final judgment is expressly conferred upon the latter by Congress), or that it could determine controversies arising from interferences by its own action through its own committees; and it by no means follows that, having designated any one of these instrumentalities, it is limited to the use of that particular one. It may use any one of these, or it may use any one in connection with any other. It may, in any way that it conceives to be best calculated to carry into effect such express powers, prescribe any means that in its judgment may be most efficient in the performance thereof.

In the said case of *Interstate Commerce Commission vs. Brimson* (*supra*), at page 473, Mr. Justice Harlan says:

"Congress is not limited in its employment of means to those that are absolutely essential to the accomplishment of objects within the scope of the powers granted to it. It is a settled principle of constitutional law that '*the government which has a right to do an act, and has imposed upon it the duty of performing that act, must, according to the dictates of reason, be allowed to select the means, and those who contend that it may not select any appropriate means, that one particular mode of effecting the object is excepted, take upon themselves the burden of establishing that exception*' (4 Wheat., 409). The test of the power of Congress is not the judgment of the courts that particular means are not the best that could have been

employed to effect the end contemplated by the legislative department. *The judiciary can only inquire whether the means devised in the execution of a power granted are forbidden by the Constitution. It cannot go beyond that inquiry* without entrenching upon the domain of another department of the Government. That it may not do with safety to our institutions (*Sinking Fund cases*, 99 U. S., 709–718)."

II.

Congress Can Confer upon the Courts Jurisdiction to Hear and Determine Controversies Relating to the Issuing of Patents in Aid of the Exercise of the Power Conferred upon that Body by the Constitution.

The whole argument of counsel for plaintiff in error in this case rests upon the idea or proposition that as Congress has created a bureau in the Department of the Interior for the determination of questions of this character, it is, by this action, limited to what that bureau may do, and is precluded from going beyond that bureau and invoking the aid of some other instrumentality for the purpose of determining such controversies.

This contention, it is respectfully submitted, is novel, not only in that it is in contravention of what would seem to be elementary law, but because it is in conflict with the established practice of the Government almost from its beginning. In this connection the court is referred to the case of *Butterworth vs. Hoe* (112 U. S., 51), for the purpose of directing attention to the history of the legislation of Congress in respect of the methods provided by it for determining questions of this character.

This legislative history will be found commencing at page 64 of said volume of the United States reports, and from it

it will appear that, in the discharge of said duty to secure to inventors the exclusive benefit of their discoveries, in the year 1790 Congress passed an act (*1 Stats., 109*) authorizing the Secretaries of State and War and the Attorney General, or any two of them, to issue letters patent upon inventions if they should deem the same sufficiently useful or important.

In 1793 (*1 Stats., 318*) such patents were authorized to be issued by the Secretary of State, upon the certificate of the Attorney General, and by this act interfering applications were submitted to arbitrators, etc. By the act of 1836, creating in the Department of State a Patent Office, a Commissioner of Patents was provided for, who, under the direction of the Secretary of State, was to superintend, execute, and perform all such acts and things, touching and respecting the granting and issuing of patents, as are therein provided for, or may be hereafter by law directed to be done. If an applicant was not satisfied with the action of this Commissioner, he had a right to appeal to a board of examiners, to be composed of three disinterested persons, etc.

By section 16 of said act (now secs. 4915 and 4918 of the Revised Statutes), a remedy by bill in equity was provided. In 1839 (*5 Stats., 11*), as modified by the act of 1852 (*10 Stats., 75*), it was provided that in all cases where an appeal thus allowed by law from the decision of the Commissioner of Patents to a board of examiners, the party instead thereof should have a right of appeal to the chief justice or either of the associate justices of the circuit court of the United States for the District of Columbia. By the act of 1849 (*9 Stats., 395*), the Patent Office was transferred to the Department of the Interior.

For the further history of the legislation of Congress in regard to this matter, reference is made to said case of *Butterworth vs. Hoe.* But from what has already been mentioned, and from what will further appear by an examination of said case in respect of the history of such legislation,

it will be seen that from 1790 down to this time Congress has asserted and exercised its right to select, and has selected, the instrumentalities which it desired should be used for the purpose of carrying out the express provision of the Constitution above quoted, and that, since the year 1870, without question, Congress has asserted the power to use the courts of the District of Columbia as an instrumentality or aid in the exercise of such power.

In view of the above authorities, and of the hitherto unquestioned procedure of Congress, argument or illustration in support of the above-stated proposition would seem to be unnecessary. When it is said that "Congress shall have the power to secure," etc., such grant of power necessarily carries with it the power to declare or designate the means or the instrumentalities by which it will secure the objects to be attained.

As one of these instrumentalities Congress has created the office of Commissioner of Patents. He is a *quasi*-judicial officer, created for the purpose of determining which of two parties shall have issued to him a patent, or whether, in the absence of conflict, a patent shall be issued at all. As an incident of this duty, he must receive and consider the evidence submitted to him by the parties and the law applicable to the question in controversy. And now it is gravely asserted by counsel for plaintiff in error that Congress, whose right and duty it is to secure to inventors the benefits of their inventions, cannot go beyond the opinion of this Commissioner of Patents, but must be bound by his judgment alone. In other words, it is asserted that Congress may create a Commissioner of Patents, and may submit such matters to his judgment, but cannot subject his decision or judgment to review by any other tribunal.

It would seem that the mere statement of such a proposition carries with it the answer, to wit, that Congress, having the power to secure these rights, may adopt such methods

of securing them as in its discretion it may consider appropriate.

In the case of *Butterworth vs. Hoe, supra*, the court, in its opinion by Matthews, J., uses the following language, which would seem to be conclusive of the present question:

"It is evident that the appeal thus given to the supreme court of the District of Columbia from the decision of the Commissioner is not the exercise of ordinary jurisdiction at law or in equity on the part of that court, but is one step in the statutory proceeding under the patent laws whereby that tribunal is interposed in aid of the Patent Office, though not subject to it. *Its adjudication, though not binding upon any who choose by litigation in courts of general jurisdiction to question the validity of any patent thus awarded, is, nevertheless, conclusive upon the Patent Office itself*, for, as the statute declares (Rev. Stats., sec. 4914) it 'shall govern the further proceedings in the case.' *The Commissioner cannot question it.* He is bound to record and obey it. His failure or refusal to execute it by appropriate action would undoubtedly be corrected and supplied by suitable judicial process. *The decree of the court is the final adjudication upon the question of right;* everything after that dependent upon it is merely in execution of it; it is no longer matter of discretion, but has become imperative and enforceable. It binds the whole department, the Secretary as well as the Commissioner, for it has settled the question of title, so that a demand for the signatures necessary to authenticate the formal instrument and evidence of grant may be enforced. It binds the Secretary by acting directly upon the Commissioner, for it makes the action of the latter final by requiring it to conform to the decree.

"Congress has thus provided four tribunals for hearing applications for patents, with three successive appeals, in which the Secretary of the Interior is not included; giving jurisdiction, in appeals from the Commissioner, to a judicial body, independent of the department, as though he were the highest authority on the subject within it. And to say that, under the name of direction and superintendence, the Secretary may annul the decision of the supreme court of the District, sitting on appeal from the Commissioner, by directing the latter to disregard it, is to construe a statute

so as to make one part repeal another, when it is evident both are intended to coexist without conflict.

"The inference is that an appeal is allowed from the decision of the Commissioner refusing a patent, not for the purpose of withdrawing that decision from the review of the Secretary, under his power to direct and superintend, but because, without that appeal, it was intended that the decision of the Commissioner should stand as the final judgment of the Patent Office, and of the executive department of which it is a part."

This is a clear and explicit statement of our position in respect of the question now before the court, namely, that what comes within the ordinary jurisdiction of the court is entirely foreign to the matter under discussion, the question being not whether a matter concerning the issuing of a patent is of judicial cognizance in the usual statutory or constitutional sense thereof, but whether Congress may use a judge or a court for the purpose of determining a question of this character.

Congress has not only provided for using the courts for this purpose, but by this opinion of the Supreme Court the right of Congress to use such instrumentality in aid of the discharge of its duty is clearly and distinctly affirmed; and it is, therefore, most respectfully and most confidently submitted that Congress has the power to employ in aid of the exercise of this power said Court of Appeals, as it has expressly done by the act creating it, for the purpose of determining a controversy of this kind, and said court having already on appeal from the Commissioner in this case, determined which of the contesting parties is entitled to this patent, and said court being the last of the instrumentalities provided by statute, the Commissioner is without any power to do anything other than to conform to the decree of said court.

Therefore, the application of appellant to a justice of the supreme court of the District of Columbia to compel the

Commissioner, by writ of mandamus, to award the patent otherwise than as directed by said court had no foundation upon which to rest, and the refusal of the justice to whom that application was made to grant it must be affirmed.

III.

The Act Conferring Jurisdiction upon this Court to Determine Cases of Interference is Clearly within the Constitutional Power of Congress; but, Even if this were Doubtful, that Doubt Must be Resolved in Favor of the Power.

Judge Cooley, in his work on Constitutional Limitations, says that "the constitutionality of a law is to be presumed," and that it should never be declared void unless its nullity and invalidity are beyond a reasonable doubt—that "a reasonable doubt must be solved in favor of the legislative action, and the act be sustained" (side page 182 and note).

This principle is thus stated in 3 American and English Encyclopædia of Law, at pages 673 and 674:

"It is the right, and consequently the duty, of the judicial tribunals to determine whether a legislative enactment drawn in question in a suit pending before them is repugnant to the Constitution of the United States or of the State, and, if so found, to declare it inoperative and void. *But every presumption and intendment is in favor of the constitutionality of an act of the legislature, and the courts will not be justified in pronouncing it invalid unless satisfied beyond a reasonable doubt of its repugnance to the Constitution; and nothing but a clear violation of the Constitution—a clear usurpation of the power prohibited—will warrant the judiciary in declaring an act of the legislative department unconstitutional and void.*"

See, also, cases cited in notes.

In the case of *Cooper vs. Telfair* (4 Dall., 18), Justice Washington, in delivering the opinion of the court, says:

"The presumption, indeed, must always be in favor of the validity of laws if the contrary is not clearly demonstrated."

In *Ogden vs. Saunders* (12 Wheat., 270), the court says:

"It is but a decent respect due to the wisdom, the integrity, and the patriotism of the legislative body by which any law is passed to presume in favor of its validity, until its violation of the Constitution is proved *beyond all reasonable doubt.*"

Same thing, 1 Abb. U. S., 52.
See, also, Sinking Fund cases, 99 U. S., 700, 718, and Powell *vs.* Pennsylvania, 127 U. S., 678, 684.

In *Pollock vs. Farmers' Loan & Trust Co.*, income-tax case (157 U. S., 554), opinion by Fuller, C. J., the court says:

"Necessarily the power to declare a law unconstitutional is always exercised with reluctance; but the duty to do so, in a proper case, cannot be declined, and must be discharged in accordance with the deliberate judgment of the tribunal in which the validity of the enactment is directly drawn in question."

IV.

A Complete Remedy is Afforded by Statute without Resort to Writ of Mandamus.

By section 4915 of the Revised Statutes it is provided that any party who may be aggrieved by the decision of the supreme court of the District of Columbia, or the Commissioner of Patents, may have his rights adjudicated in a proceeding in equity in the proper court; and thus it appears that a full and complete remedy is afforded without resort to the extraordinary remedy of mandamus.

The jurisdiction of the supreme court of the District of Columbia was transferred to the Court of Appeals of the District of Columbia (Act of Congress, February 9, 1893, 27 Stats., 434).

Referring to this section of the Revised Statutes, the Supreme Court of the United States, in said case of *Butterworth vs. Hoe* (*supra*), says as follows:

"It is thereby provided that the applicant may have remedy by bill in equity. This means a proceeding in a court of the United States having original equity jurisdiction under the patent laws, according to the ordinary course of equity practice and procedure. It is not a technical appeal from the Patent Office like that authorized in section 4911, confined to the case as made in the record of that office, but is prepared and heard upon all competent evidence adduced, and upon the whole merits. Such has been the uniform and correct practice in the circuit courts (*Whipple vs. Miner*, 15 Fed. Rep., 117; *Ex parte Squire*, 3 Ban. & A., 133; *Butler vs. Shaw*, 21 Fed. Rep., 321). It is provided that the court having cognizance thereof, on notice to adverse parties, and after due proceedings had, may adjudge that such applicant is entitled according to law to receive a patent for his invention, as specified in his claim, or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the applicant, shall authorize the Commissioner to issue such patent on the applicant filing in the Patent Office a copy of such adjudication, and otherwise complying with the requirements of the law. And in all cases where there is no opposing party, a copy of the bill shall be served on the Commissioner," etc.

Thus it appears that Congress has not only called to its aid the instrumentalities above alluded to, but has expressly conferred upon parties who may consider themselves aggrieved by such decisions the right to go into a court of equity, and there have the whole matter reviewed; and, such being the state of the legislation, it is respectfully submitted that the extraordinary writ of mandamus to compel the Commissioner to disregard the decision of this court and

issue a patent in conformity with his own decision, cannot be resorted to except in total disregard of all the principles underlying the right to such a remedy.

The object of a mandamus is not to supersede a legal remedy, but rather to supply the want of it. Two prerequisites must exist to warrant a court in granting this extraordinary remedy. *First*, it must appear that the relator has a clear legal right to the performance of a particular act or duty at the hands of the respondent; and, *second*, that the law affords no other adequate or specific remedy to secure the enforcement of the right and the performance of the duty which it is sought to coerce In this sense the remedy may be regarded as of *dernier resort*, to be used when the law affords no other adequate means of relief (High's Extraordinary Legal Remedies, p. 13, sec. 10, and cases cited).

In the case of *Kendall vs. Stokes* (3 How., 99), the court, Taney, C. J., speaking of the writ of mandamus, says:

"That a party was entitled to it when there was no other adequate remedy. * * * *Whenever, therefore, a mandamus is applied for, it is upon the ground that he cannot obtain redress in any other form of proceeding.* And to allow him to bring another action for the very same cause after he has obtained the benefit of the mandamus would not only be harassing the defendant with two suits for the same thing, but would be inconsistent with the grounds upon which he asks for the mandamus, and inconsistent also with the decision of the court which awarded it."

In the case of *Knox County, &c., vs. Aspinwall* (24 How., 376–383), the court, Grier, J., states the same thing, as follows:

"It must be admitted, that, according to the well-established principles and usage of the common law, the writ of mandamus is a remedy to compel any person, corporation, public functionary or tribunal to perform some duty required by law, where the party seeking relief has no other legal remedy, and the duty sought to be enforced is clear and indisputable."

In *Ex parte Virginia Commissioners* (112 U. S., 177), the syllabus correctly states what was decided by the court, as follows:

"A writ of mandamus is not ordinarily granted when the party alleging the grievance has another adequate remedy and that remedy has not been exhausted."

In the case of *Bayard vs. White* (127 U. S., 250) the court, Blatchford, J., lays down the same rule, and says that mandamus will only be granted "where the party seeking re-"lief has no other legal remedy, and the duty sought to be "enforced is clear and indisputable. * * * Both requi-"sites must concur in every case."

The same principle is laid down *In re Pennsylvania Co.* (137 U. S., 453), opinion by Bradley, J.

See, also, same thing held in *Morrison, petitioner* (147 U. S., 26).

By referring to the record herein it will be seen that the relator has actually invoked the remedy provided in section 4915, Revised Statutes United States, by filing in the circuit court of the United States for the district of Indiana a bill in equity. (*See* bill, R., pp. 42–48.)

The decisions of the Supreme Court of the United States are entirely harmonious on this rule of law applicable to the granting or denying of writs of mandamus; and, in view of this settled state of the law, it would seem necessarily to follow that another adequate remedy having been provided by statute (sec. 4915, Rev. Stats., U. S.), and the relator, Bernardin, having elected to invoke and pursue the remedy in equity so afforded him, his present petition for mandamus cannot be entertained.

Respectfully submitted.

JEREMIAH M. WILSON.

UNITED STATES *v.* DUELL.

ERROR TO THE COURT OF APPEALS OF THE DISTRICT OF COLUMBIA.

No. 444. Argued December 1, 2, 1898. — Decided January 23, 1899.

An appeal to the Court of Appeals of the District of Columbia from the decision of the Commissioner of Patents in an interference controversy presents all the features of a civil case, a plaintiff, a defendant and a judge, and deals with a question judicial in its nature, in respect of which the judgment of the court is final, so far as the particular action of the Patent Office is concerned; and such judgment is none the less a judgment because its effect may be to aid an administrative or executive body in the performance of duties legally imposed upon it by Congress in execution of a power granted by the Constitution.

In deciding whether a patent shall issue or not, the Commissioner of Patents acts on evidence, finds the facts, applies the law and decides questions

Statement of the Case.

affecting not only public, but private interests; and likewise as to reissues, or extension, or on interference between contesting claimants; in all of which he exercises judicial functions.

Butterworth v. *Hoe*, 112 U. S. 50, held to be directly in point, and the language on page 59 held to be also in point in which the court, speaking of that clause in Article 1, Section 8 of the Constitution, which confers upon Congress the power "to promote the progress of science and useful arts, by securing for limited times to authors and inventors, the exclusive right to their respective writings and discoveries," says: "The legislation based on this provision regards the right of property in the inventor as the medium of the public advantage derived from his invention; so that in every grant of the limited monopoly two interests are involved — that of the public, who are the grantors, and that of the patentee. There are thus two parties to every application for a patent, and more when, as in case of interfering claims or patents, other private interests compete for preference. The questions of fact arising in this field find their answers in every department of physical science, in every branch of mechanical art; the questions of law necessary to be applied in the settlement of this class of public and private rights have founded a special branch of technical jurisprudence. The investigation of every claim presented involves the adjudication of disputed questions of fact upon scientific or legal principles, and is, therefore, essentially judicial in its character, and requires the intelligent judgment of a trained body of skilled officials, expert in the various branches of science and art, learned in the history of invention and proceeding by fixed rules to systematic conclusions."

In an interference proceeding in the Patent Office between Bernardin and Northall, the Commissioner, Seymour, decided in favor of Bernardin, whereupon Northall prosecuted an appeal to the Court of Appeals of the District of Columbia. That court awarded Northall priority and reversed the Commissioner's decision. 7 App. D. C. 452. Bernardin, notwithstanding, applied to the Commissioner to issue the patent to him and tendered the final fee, but the Commissioner refused to do this in view of the decision of the Court of Appeals, which had been duly certified to him. Bernardin then applied to the Supreme Court of the District of Columbia for a mandamus to compel the Commissioner to issue the patent in accordance with his prior decision on the ground that the statute providing for an appeal was unconstitutional and the judgment of the Court of Appeals void for want of jurisdiction. The application was denied, and Bernardin appealed to

the Court of Appeals, which affirmed the judgment. 10 App. D. C. 294.

Seymour resigned as Commissioner and was succeeded by Butterworth, and Bernardin recommenced his proceeding, which again went to judgment in the Supreme Court, and the Court of Appeals. 11 App. D. C. 91. The case was brought to this court, but abated in consequence of the death of Butterworth. *United States* v. *Butterworth*, 169 U. S. 600. Bernardin thereupon brought his action against Duell, Butterworth's successor, and judgment against him was again rendered in the District Supreme Court, that judgment affirmed by the Court of Appeals, and the cause brought here on writ of error.

The following sections of the Revised Statutes were referred to on the argument:

"SEC. 4906. The clerk of any court of the United States, for any District or Territory wherein testimony is to be taken for use in any contested case pending in the Patent Office, shall, upon the application of any party thereto, or of his agent or attorney, issue a subpœna for any witness residing or being within such District or Territory, commanding him to appear and testify before any officer in such District or Territory authorized to take depositions and affidavits, at any time and place in the subpœna stated. But no witness shall be required to attend at any place more than forty miles from the place where the subpœna is served upon him.

"SEC. 4907. Every witness duly subpœnaed and in attendance shall be allowed the same fees as are allowed to witnesses attending the courts of the United States.

"SEC. 4908. Whenever any witness, after being duly served with such subpœna, neglects or refuses to appear, or after appearing refuses to testify, the judge of the court whose clerk issued the subpœna may, on proof of such neglect or refusal, enforce obedience to the process or punish the disobedience, as in other like cases. But no witness shall be deemed guilty of contempt for disobeying such subpœna, unless his fees and travelling expenses in going to, returning from and one day's attendance at the place of examination,

are paid or tendered him at the time of the service of the subpœna; nor for refusing to disclose any secret invention or discovery made or owned by himself.

"SEC. 4909. Every applicant for a patent or for the reissue of a patent, any of the claims of which have been twice rejected, and every party to an interference, may appeal from the decision of the primary examiner, or of the examiner in charge of interferences in such case, to the board of examiners in chief; having once paid the fee for such appeal.

"SEC. 4910. If such party is dissatisfied with the decision of the examiners in chief, he may, on payment of the fee prescribed, appeal to the Commissioner in person.

"SEC. 4911. If such party, except a party to an interference, is dissatisfied with the decision of the Commissioner, he may appeal to the Supreme Court of the District of Columbia, sitting in banc.

"SEC. 4912. When an appeal is taken to the Supreme Court of the District of Columbia, the appellant shall give notice thereof to the Commissioner, and file in the Patent Office, within such time as the Commissioner shall appoint, his reasons of appeal, specifically set forth in writing.

"SEC. 4913. The court shall, before hearing such appeal, give notice to the Commissioner of the time and place of the hearing, and on receiving such notice the Commissioner shall give notice of such time and place in such manner as the court may prescribe, to all parties who appear to be interested therein. The party appealing shall lay before the court certified copies of all the original papers and evidence in the case, and the Commissioner shall furnish the court with the grounds of his decision, fully set forth in writing, touching all the points involved by the reasons of appeal. And at the request of any party interested, or of the court, the Commissioner and the examiners may be examined under oath, in explanation of the principles of the thing for which a patent is demanded.

"SEC. 4914. The court, on petition, shall hear and determine such appeal, and revise the decision appealed from in a summary way, on the evidence produced before the Commissioner, at such early and convenient time as the court may

appoint; and the revision shall be confined to the points set forth in the reasons of appeal. After hearing the case the court shall return to the Commissioner a certificate of its proceedings and decision, which shall be entered of record in the Patent Office, and shall govern the further proceedings in the case. But no opinion or decision of the court in any such case shall preclude any person interested from the right to contest the validity of such patent in any court wherein the same may be called in question.

"SEC. 4915. Whenever a patent on application is refused, either by the Commissioner of Patents or by the Supreme Court of the District of Columbia upon appeal from the Commissioner, the applicant may have remedy by bill in equity; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim, or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the Commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication, and otherwise complying with the requirements of law. In all cases, where there is no opposing party, a copy of the bill shall be served on the Commissioner; and all the expenses of the proceeding shall be paid by the applicant, whether the final decision is in his favor or not."

Section 780 of the Revised Statutes of the District of Columbia reads thus:

"SEC. 780. The Supreme Court, sitting in banc, shall have jurisdiction of and shall hear and determine all appeals from the decisions of the Commissioner of Patents, in accordance with the provisions of sections forty-nine hundred and eleven to section forty-nine hundred and fifteen, inclusive, of chapter one, Title LX, of the Revised Statutes, 'Patents, Trade-marks, and Copyrights.'"

Section nine of the "act to establish a Court of Appeals for the District of Columbia, and for other purposes," approved February 9, 1893, c. 74, 27 Stat. 434, 436, is —

"SEC. 9. That the determination of appeals from the decision of the Commissioner of Patents, now vested in the general term of the Supreme Court of the District of Columbia, in pursuance of the provisions of section seven hundred and eighty of the Revised Statutes of the United States, relating to the District of Columbia, shall hereafter be and the same is hereby vested in the Court of Appeals created by this act; and in addition, any party aggrieved by a decision of the Commissioner of Patents in any interference case may appeal therefrom to said Court of Appeals."

Mr. Julian C. Dowell and *Mr. George C. Hazelton* for plaintiffs in error.

Mr. Solicitor General for defendant in error. *Mr. Jeremiah M. Wilson*, on behalf of Northall's assignee, filed a brief for same.

MR. CHIEF JUSTICE FULLER, after stating the case, delivered the opinion of the court.

The Court of Appeals for the District of Columbia adjudged that Northall was entitled to the patent. By section 8 of the act establishing that court, 27 Stat. 434, c. 74, it is provided that any final judgment or decree thereof may be revised by this court on appeal or error in cases wherein the validity of a statute of the United States is drawn in question. The validity of the act of Congress allowing an appeal to the Court of Appeals in interference cases was necessarily determined when that court went to judgment, yet no attempt was made to bring the case directly to this court, but the relator applied to the District Supreme Court to compel the Commissioner to issue the patent in disregard of the judgment of the Court of Appeals to the contrary, and, the application having been denied, the Court of Appeals was called on to readjudicate the question of its own jurisdiction.

The ground of this unusual proceeding, by which the lower court was requested to compel action to be taken in defiance

of the court above, and the latter court was called on to rejudge its own judgment, was that the decree of the Court of Appeals was utterly void because of the unconstitutionality of the statute by which it was empowered to exercise jurisdiction.

Nothing is better settled than that the writ of mandamus will not ordinarily be granted if there is another legal remedy, nor unless the duty sought to be enforced is clear and indisputable; and we think that, under the circumstances, the remedy by appeal existed; and that it is not to be conceded that it was the duty of the Commissioner to disobey the decree because in his judgment the statute authorizing it was unconstitutional, or that it would have been consistent with the orderly and decorous administration of justice for the District Supreme Court to hold that the Court of Appeals was absolutely destitute of the jurisdiction which it had determined it possessed. Even if we were of opinion that the act of Congress was not in harmony with the Constitution, every presumption was in favor of its validity, and we cannot assent to the proposition that it would have been competent for the Commissioner to treat the original decree as absolutely void, and without force and effect as to all persons and for all purposes.

But as, in our opinion, the Court of Appeals had jurisdiction, we prefer to affirm the judgment on that ground.

The contention is that Congress had no power to authorize the Court of Appeals to review the action of the Commissioner in an interference case, on the theory that the Commissioner is an executive officer; that his action in determining which of two claimants is entitled to a patent is purely executive; and that, therefore, such action cannot be subjected to the revision of a judicial tribunal.

Doubtless, as was said in *Murray* v. *Hoboken Land & Improvement Co.*, 18 How. 272, 284, Congress cannot bring under the judicial power a matter which, from its nature, is not a subject for judicial determination, but at the same time, as Mr. Justice Curtis, delivering the opinion of the court, further observed, "there are matters involving public

rights, which may be presented in such form that the judicial power is capable of acting on them, and which are susceptible of judicial determination, but which Congress may or may not bring within the cognizance of the courts of the United States, as it may deem proper." The instances in which this has been done are numerous, and many of them are referred to in *Fong Yue Ting* v. *United States*, 149 U. S. 698, 714, 715, 728.

Since, under the Constitution, Congress has power "to promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries," and to make all laws which shall be necessary and proper for carrying that expressed power into execution, it follows that Congress may provide such instrumentalities in respect of securing to inventors the exclusive right to their discoveries as in its judgment will be best calculated to effect that object.

And by reference to the legislation on the subject, a comprehensive sketch of which was given by Mr. Justice Matthews in *Butterworth* v. *Hoe*, 112 U. S. 50, it will be seen that from 1790 Congress has selected such instrumentalities, varying them from time to time, and, since 1870, has asserted the power to avail itself of the courts of the District of Columbia in that connection.

The act of April 10, 1790, c. 7, 1 Stat. 109, authorized the issue of patents by the Secretary of State, the Secretary for the Department of War, and the Attorney General, or any two of them, "if they shall deem the invention or discovery sufficiently useful and important," and this was followed by the act of February 21, 1793, c. 11, 1 Stat. 318, authorizing them to be issued by the Secretary of State, upon the certificate of the Attorney General that they were conformable to the act. The ninth section of the statute provided for the case of interfering applications, which were to be submitted to the decision of three arbitrators, chosen one by each of the parties and the third appointed by the Secretary of State, whose decision or award, or that of two of them, should be final as respected the granting of the patent.

Then came the act of July 4, 1836, c. 357, 5 Stat. 117, cre-

ating in the Department of State the Patent Office, "the chief officer of which shall be called the Commissioner of Patents," and "whose duty it shall be, under the direction of the Secretary of State, to superintend, execute and perform, all such acts and things touching and respecting the granting and issuing of patents for new and useful discoveries, inventions and improvements, as are herein provided for, or shall hereafter be, by law, directed to be done and performed." . . . By that act it was declared to be the duty of the Commissioner to issue a patent if he "shall deem it to be sufficiently useful and important;" and, in case of his refusal, the applicant was (sec. 7) secured an appeal from his decision to a board of examiners, to be composed of three disinterested persons, appointed for that purpose by the Secretary of State, one of whom, at least, to be selected, if practicable and convenient, for his knowledge and skill in the particular art, manufacture or branch of science to which the alleged invention appertained. The decision of this board being certified to the Commissioner, it was declared that "he shall be governed thereby in the further proceedings to be had on such application." A like proceeding, by way of appeal, was provided in cases of interference. By section 16 of the act a remedy by bill in equity, still existing in sections 4915, 4918, Revised Statutes, was given as between interfering patents or whenever an application had been refused on an adverse decision of a board of examiners. By section 11 of the act of March 3, 1839, c. 88, 5 Stat. 353, 354, as modified by the act of August 30, 1852, c. 107, 10 Stat. 75, it was provided that in all cases where an appeal was thus allowed by law from the decision of the Commissioner of Patents to a board of examiners, the party, instead thereof, should have a right to appeal to the chief judge or to either of the assistant judges of the Circuit Court of the District of Columbia; and by section 10 the provisions of section 16 of the act of 1836 were extended to all cases where patents were refused for any reason whatever, either by the Commissioner or by the chief justice of the District of Columbia upon appeals from the decision of the Commissioner, as well as where the

same shall have been refused on account of or by reason of interference with a previously existing patent.

By the act of March 3, 1849, c. 108, 9 Stat. 395, the Patent Office was transferred to the Department of the Interior. The act of March 2, 1861, c. 88, 12 Stat. 246, created the office of examiners in chief, "for the purpose of securing greater uniformity of action in the grant and refusal of letters patent," "to be composed of persons of competent legal knowledge and scientific ability, whose duty it shall be, on the written petition of the applicant for that purpose being filed, to revise and determine upon the validity of decisions made by examiners when adverse to the grant of letters patent; and also to revise and determine in like manner upon the validity of the decisions of examiners in interference cases, and when required by the Commissioner in applications for the extension of patents, and to perform such other duties as may be assigned to them by the Commissioner; that from their decisions appeals may be taken to the Commissioner of Patents in person, upon payment of the fee hereinafter prescribed; that the said examiners in chief shall be governed in their action by the rules to be prescribed by the Commissioner of Patents."

The act of July 8, 1870, c. 230, 16 Stat. 198, revised, consolidated and amended the statutes then in force on the subject, and by section 48, an appeal to the Supreme Court of the District of Columbia sitting in banc was provided for, whose decision was to govern the further proceedings in the case (sec. 50); and the provisions of the act material to the present inquiry were carried in substance into the existing revision.

By the act of February 9, 1893, c. 74, 27 Stat. 434, the determination of appeals from the Commissioner of Patents, which was formerly vested in the General Term of the Supreme Court of the District, was vested in the Court of Appeals, and, in addition, it was provided that "any party aggrieved by a decision of the Commissioner of Patents in any interference case may appeal therefrom to said Court of Appeals."

As one of the instrumentalities designated by Congress in

execution of the power granted, the office of Commissioner of Patents was created, and though he is an executive officer, generally speaking, matters in the disposal of which he exercises functions judicial in their nature may properly be brought within the cognizance of the courts.

Now, in deciding whether a patent shall issue or not, the Commissioner acts on evidence, finds the facts, applies the law and decides questions affecting not only public but private interests; and so as to reissue, or extension or on interference between contesting claimants; and in all this he exercises judicial functions.

In *Butterworth* v. *Hoe*, *supra*, Mr. Justice Matthews, referring to the constitutional provision, well said:

"The legislation based on this provision regards the right of property in the inventor as the medium of the public advantage derived from his invention; so that in every grant of the limited monopoly two interests are involved, that of the public, who are the grantors, and that of the patentee. There are thus two parties to every application for a patent, and more, when, as in case of interfering claims or patents, other private interests compete for preference. The questions of fact arising in this field find their answers in every department of physical science, in every branch of mechanical art; the questions of law, necessary to be applied in the settlement of this class of public and private rights, have founded a special branch of technical jurisprudence. The investigation of every claim presented involves the adjudication of disputed questions of fact, upon scientific or legal principles, and is, therefore, essentially judicial in its character, and requires the intelligent judgment of a trained body of skilled officials, expert in the various branches of science and art, learned in the history of invention, and proceeding by fixed rules to systematic conclusions."

That case is directly in point and the *ratio decidendi* strictly applicable to that before us. The case was a suit in mandamus brought by the claimant of a patent in whose favor the Commissioner had found in an interference case, to compel the Commissioner to issue the patent to him. The Commissioner

had refused to do this on the ground that the defeated party had appealed to the Secretary of the Interior, who had reversed the Commissioner's action, and found in appellant's favor. This court held that while the Commissioner of Patents was an executive officer and subject in administrative or executive matters to the supervision of the head of the department, yet that his action in deciding patent cases was essentially judicial in its nature and not subject to review by the executive head, an appeal to the courts having been provided for. And among other things it was further said:

"It is evident that the appeal thus given to the Supreme Court of the District of Columbia from the decision of the Commissioner, is not the exercise of ordinary jurisdiction at law or in equity on the part of that court, but is one in the statutory proceeding under the patent laws whereby that tribunal is interposed in aid of the Patent Office, though not subject to it. Its adjudication, though not binding upon any who choose by litigation in courts of general jurisdiction to question the validity of any patent thus awarded, is, nevertheless, conclusive upon the Patent Office itself, for, as the statute declares, Rev. Stat. § 4914, it 'shall govern the further proceedings in the case.' The Commissioner cannot question it. He is bound to record and obey it. His failure or refusal to execute it by appropriate action would undoubtedly be corrected and supplied by suitable judicial process. The decree of the court is the final adjudication upon the question of right; everything after that dependent upon it is merely in execution of it; it is no longer matter of discretion, but has become imperative and enforceable. It binds the whole Department, the Secretary as well as the Commissioner, for it has settled the question of title, so that a demand for the signatures necessary to authenticate the formal instrument and evidence of grant may be enforced. It binds the Secretary by acting directly upon the Commissioner, for it makes the action of the latter final by requiring it to conform to the decree.

"Congress has thus provided four tribunals for hearing applications for patents, with three successive appeals, in which the Secretary of the Interior is not included, giving jurisdiction

in appeals from the Commissioner to a judicial body, independent of the Department, as though he were the highest authority on the subject within it. And to say that under the name of direction and superintendence, the Secretary may annul the decision of the Supreme Court of the District, sitting on appeal from the Commissioner, by directing the latter to disregard it, is to construe a statute so as to make one part repeal another, when it is evident both were intended to coexist without conflict."

* * * * *

"No reason can be assigned for allowing an appeal from the Commissioner to the Secretary in cases in which he is by law required to exercise his judgment on disputed questions of law and fact, and in which no appeal is allowed to the courts that would not equally extend it to those in which such appeals are provided, for all are equally embraced in the general authority of direction and superintendence. That includes all or does not extend to any. The true conclusion, therefore, is, that in matters of this description, in which the action of the Commissioner is quasi-judicial, the fact that no appeal is expressly given to the Secretary is conclusive that none is to be implied."

We perceive no ground for overruling that case or dissenting from the reasoning of the opinion; and as the proceeding in the Court of Appeals on an appeal in an interference controversy presents all the features of a civil case, a plaintiff, a defendant and a judge, and deals with a question judicial in its nature, in respect of which the judgment of the court is final so far as the particular action of the Patent Office is concerned, such judgment is none the less a judgment "because its effect may be to aid an administrative or executive body in the performance of duties legally imposed upon it by Congress in execution of a power granted by the Constitution." *Interstate Commerce Commission* v. *Brimson*, 154 U. S. 447.

It will have been seen that in the gradual development of the policy of Congress in dealing with the subject of patents, the recognition of the judicial character of the questions involved became more and more pronounced.

Syllabus.

By the acts of 1839 and 1852 an appeal was given, not to the Circuit Court of the District of Columbia, but to the chief judge or one of the assistant judges thereof, who was thus called on to act as a special judicial tribunal. The competency of Congress to make use of such an instrumentality or to create such a tribunal in the attainment of the ends of the Patent Office seems never to have been questioned, and we think could not have been successfully. The nature of the thing to be done being judicial, Congress had power to provide for judicial interference through a special tribunal, *United States* v. *Coe*, 155 U. S. 76; and *a fortiori* existing courts of competent jurisdiction might be availed of.

We agree that it is of vital importance that the line of demarcation between the three great departments of government should be observed, and that each should be limited to the exercise of its appropriate powers, but in the matter of this appeal we find no such encroachment of one department on the domain of another as to justify us in holding the act in question unconstitutional.

Judgment affirmed.